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THE FIFTY-EIGHT PROCEEDINGS: DOMAIN NAME DISPUTES,
KOREAN PARTIES, AND WIPO THREE-MEMBER PANELS

*Ilhyung Lee**

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In *Amazon.com, Inc. v. Sung Hee Cho*,¹ the U.S.-based online retail company filed a claim against a Korean² national who registered and used the domain name <amazoncar.com>. Internet users who resorted to this domain name were directed to a website (with content in Korean text) that offered to rent or lease Hyundai and Kia automobiles.³ Amazon.com, whose own website offered online sales of motor vehicles, in addition to books and other merchandise, argued that users would mistakenly associate the domain name with the U.S. company.⁴ The claim was decided – not in a civil action in a court of law stateside, Korea, or elsewhere, but instead – under the Uniform Domain Name Dispute Resolution Policy (“UDRP” or “Policy”).⁵ Some background is in order.

In 1999, the Internet Corporation for Assigned Names and Numerals (ICANN) adopted the UDRP to provide for an extrajudicial method of resolving disputes stemming from the abusive registration and use of a domain name in

¹ WIPO Case No. D2001-1276 (Dec. 20, 2001). Cho had also registered <amazonecar.com>. *Id.*

² All references to the country herein are to the Republic of Korea, commonly known as South Korea.

³ *Sung Hee Cho*, WIPO Case No. D2001-1276.

⁴ *Id.*

⁵ *Uniform Domain Name Dispute Resolution Policy*, INTERNET CORPORATION FOR ASSIGNED NAMES AND NUMBERS (ICANN) (1999), <https://www.icann.org/resources/pages/policy-2012-02-25-en> [hereinafter UDRP].

violation of protected trademark rights,⁶ or “cybersquatting.”⁷ The Policy is incorporated by reference into every domain name registration agreement between an ICANN-accredited registrar and a registrant, and “sets forth the terms and conditions in connection with a dispute between [the registrant] and any party . . . over the registration and use of an Internet domain name registered by [the registrant].”⁸ Under paragraph 4(a) of the Policy, a registrant is “required to submit to a mandatory administrative proceeding in the event that a third party (a ‘complainant’) asserts . . . that

- (i) [the] domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) [the registrant] ha[s] no rights or legitimate interests in respect of the domain name; and

⁶ See *Second Staff Report on Implementation Documents for the Uniform Dispute Resolution Policy*, ICANN (Oct. 25, 1999), <https://archive.icann.org/en/udrp/udrp-second-staff-report-24oct99.htm> [hereinafter ICANN, Second Staff Report]. ICANN adopted the UDRP on the basis of the World Intellectual Property Organization’s Final Report, *The Management of Internet Names and Addresses: Intellectual Property Issues*, WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO) (Apr. 30, 1999), <http://www.wipo.int/export/sites/www/amc/en/docs/report-final1.pdf> [hereinafter WIPO, Final Report], and the recommendations of others, ICANN, Second Staff Report, *supra*, ¶ 4.1.a.

⁷ *Sallen v. Corinthians Licenciamentos LTDA*, 273 F.3d 14, 16-17 (1st Cir. 2001) (citing S. Rep. No. 106-140, at 4 (1999)).

⁸ UDRP, *supra* note 5, ¶ 1.

- (iii) [the] domain name has been registered and is being used in bad faith.⁹

In order for the complainant (i.e., the party objecting to the registration and use of the domain name) to prevail, it must prove that all of the three elements are present,¹⁰ whereupon an administrative panel of one or three members may order that the domain name be transferred to the complainant or cancelled.¹¹ Of the UDRP proceedings that result in a panel decision, a significant majority (over 80%) are rendered in favor of the complainant.¹²

ICANN does not itself administer the proceedings, nor does it decide any case.¹³ Instead, ICANN assigns the case management to approved dispute resolution service

⁹ *Id.* ¶ 4(a).

¹⁰ *Id.*

¹¹ These are the only remedies permitted under the Policy. *Id.* ¶ 4(i).

¹² As of May 2004, the most recent statistics provided by ICANN, in the decisions that resulted in a panel decision: nearly 81% of the subject domain names were transferred to the complainant (80.5%) or cancelled at the request of the complainant (0.4%); and 14.2% of the domain names stayed with the respondent. The remaining decisions were categorized under “Split decision.” *Archived Statistical Summary of Proceedings Under Uniform Domain Name Dispute Resolution Policy*, ICANN (May 10, 2004), <https://archive.icann.org/en/udrp/proceedings-stat.htm>. The statistics are similar for WIPO-administered UDRP cases as of June 30, 2015: 87.5% in favor of the complainant (85.88% transferred; 1.64% cancelled); and 12.48% in favor of the respondent. *Case Outcome (Consolidated): All Years*, WIPO, [http://www.wipo.int/amc/en/domains/statistics/decision_rate.jsp?year=\[hereinafter WIPO Case Outcomes\]](http://www.wipo.int/amc/en/domains/statistics/decision_rate.jsp?year=[hereinafter%20WIPO%20Case%20Outcomes]).

¹³ UDRP, *supra* note 5, ¶ 4(h); *see id.* ¶ 6.

providers.¹⁴ Each provider maintains a list of panelists from which it appoints panelists to decide cases on the merits.¹⁵ Panel decisions are not necessarily binding, and do not have the force of a judicial ruling. That is, the UDRP does “not prevent either [the respondent] or the complainant from submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded.”¹⁶ Thus, even if the panel decides in favor of the complainant and orders cancellation or transfer of the domain name, ICANN will not implement the panel’s decision if the registrant commences a timely court action against the complainant.¹⁷ In practice, however, most registrants against whom a UDRP claim is brought do not participate in the proceeding,¹⁸ and do not resort to the

¹⁴ The list of currently approved providers includes the Asian Domain Name Dispute Resolution Centre, the National Arbitration Forum, WIPO, the Czech Arbitration Court Arbitration Center for Internet Disputes, and the Arab Center for Domain Name Dispute Resolution. *List of Approved Dispute Resolution Service Providers*, ICANN, <https://www.icann.org/resources/pages/providers-6d-2012-02-25-en>.

¹⁵ *Rules for Uniform Domain Name Dispute Resolution Policy*, ICANN ¶ 6(a), <https://www.icann.org/resources/pages/udrp-rules-2015-03-11-en> [hereinafter UDRP Rules].

¹⁶ UDRP, *supra* note 5, ¶ 4(k).

¹⁷ *Id.*

¹⁸ Professor Sorkin reported in 2001, “Default proceedings are commonplace; domain name registrants do not even file a response in one third to one half of all UDRP cases” David E. Sorkin, *Judicial Review of ICANN Domain Name Dispute Decisions*, 18 SANTA CLARA COMPUTER & HIGH TECH. L.J. 35, 42 (2001). The default rate in WIPO-

courts to challenge the panel's decision.¹⁹ As a result, ICANN's implementation of the panel's decision is the final action in the large majority of UDRP proceedings. Ultimately, the Policy provides for a streamlined, efficient, and inexpensive method of resolving disputes.²⁰

administered proceedings involving Korean parties is over 70%. Ilhyung Lee, *The Korea Database: WIPO-Administered UDRP Decisions, the First Fifteen Years (2000-2014)*, 15 CHI.-KENT J. INTELL. PROP. 261, 309-10 (2015).

¹⁹ For a list of court actions related to UDRP proceedings, see *Selection of UDRP-related Court Cases*, WIPO,

<http://www.wipo.int/amc/en/domains/challenged/>.

²⁰ The rules provide that the panel must forward its decision to the provider within fourteen days after the panel appointment, except in "exceptional circumstances." UDRP Rules, *supra* note 15, ¶ 15(b). As WIPO notes:

The main advantage of the UDRP Administrative Procedure is that it typically provides a faster and cheaper way to resolve a dispute regarding the registration and use of an Internet domain name than going to court. In addition, the procedures are considerably more informal than litigation and the decision-makers are experts in such areas as international trademark law, domain name issues, electronic commerce, the Internet and dispute resolution. It is also international in scope: it provides a single mechanism for resolving a domain name dispute regardless of where the registrar or the domain name holder or the complainant are located.

WIPO Guide to the Uniform Domain Name Dispute Resolution Policy, WIPO ("A. Scope of the Uniform Domain Name Dispute Resolution Policy, What Are the Advantages of the UDRP Administrative Procedure?"), <http://www.wipo.int/amc/en/domains/guide/> [hereinafter WIPO Guide].

The World Intellectual Property Organization (WIPO), based in Geneva, Switzerland, was the provider and case administrator in *Amazon.com, Inc. v. Sung Hee Cho*.²¹ The Policy provisions governed. Regarding procedural rules, ICANN's Rules for Uniform Domain Name Dispute Resolution Policy ("UDRP Rules")²² and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy ("WIPO Supplemental Rules")²³ were in effect. WIPO appointed three panelists to decide the merits of the case: one each from the United States, Korea, and New Zealand. The panel issued a divided decision. The majority concluded that Amazon.com proved the three elements under paragraph 4(a) of the Policy, and ordered the transfer of the domain names to the complainant.²⁴ The Korean panelist dissented, stating that Amazon.com failed to satisfy the bad faith element.²⁵

²¹ WIPO was the first dispute resolution service provider accredited by ICANN and the first to receive cases under the UDRP. WIPO Guide, *supra* note 20 ("C. Preparing and Filing a Complaint, To Which Dispute Resolution Service Provider Do I Submit My Complaint?"). The complainant chooses the provider that will administer the proceeding by submitting the complaint to that provider. UDRP, *supra* note 5, ¶ 4(d).

²² ICANN originally approved the rules on October 24, 1999, and later approved amendments, on October 30, 2009, and September 28, 2013. See UDRP Rules, *supra* note 15.

²³ *World Intellectual Property Organization Supplemental Rules for Uniform Domain Name Dispute Resolution Policy*, WIPO, <http://www.wipo.int/amc/en/domains/rules/supplemental/> [hereinafter WIPO Supp. Rules].

²⁴ *Amazon.com, Inc. v. Sung Hee Cho*, WIPO Case No. D2001-1276 (Dec. 20, 2001).

²⁵ *Id.* (Hwang, Pan., dissenting). The majority's decision and the separate dissenting opinion are discussed *infra* text accompanying notes 382-91.

The decision is an introductory example of an extrajudicial resolution of a domain name dispute in the international setting, and is similar in some respects to an international arbitration matter. The parties are from different countries and are involved in a dispute relating to an economic interest; legal standards and principles apply in the resolution of the claim. Rather than resorting to the courts (in the country of either party or another country), they seek a decision made by a private, neutral tribunal. The administering organization appoints three panelists to decide the case. In such cases, decisions are mostly unanimous, but there are occasional dissents.

The *Amazon.com, Inc. v. Sung Hee Cho* decision is one of fifty-eight WIPO-administered²⁶ UDRP proceedings

Currently, the domain names <amazoncar.com> and <amazonecar.com> both resolve to a link within Amazon.com's main website at <amazon.com>, featuring "Automobile Parts and Accessories." According to information available on <whois.com>, the current registrant of the domain names is listed as "Hostmaster, Amazon Legal Dept." *Whois amazoncar.com*, WHOIS, <http://www.whois.com/whois/amazoncar.com>; *Whois amazonecar.com*, WHOIS, <http://www.whois.com/whois/amazonecar.com>.

²⁶ All WIPO-administered UDRP decisions are publicly available on its Internet site. *Search WIPO Cases and WIPO Panel Decisions*, WIPO, <http://www.wipo.int/amc/en/domains/search/>; *Index of WIPO UDRP Panel Decisions*, WIPO, <http://www.wipo.int/amc/en/domains/search/legalindex.jsp>. In addition, WIPO provides a summary of panel decisions on key procedural and substantive issues that commonly arise. *WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition*, WIPO, <http://www.wipo.int/amc/en/domains/search/overview2.0/> [hereinafter WIPO Overview 2.0]. The consensus or clear majority views on some issues are indicated, as well as other questions that have

involving Korean parties²⁷ decided by a three-member panel, from the beginning of the implementation of the UDRP in 1999 to the end of 2014 ("58 decisions"). This article provides a summary of the 58 decisions and offers analysis of selected cases. This study is an extension of a separate work that surveys all 818 WIPO-administered UDRP proceedings²⁸ that include a party connected to Korea – "one of the world's most-wired countries."²⁹ The decisions of the three-member panels herein reflect the collective deliberations of the (often international) panelists, which decisions elaborate on specific provisions of the Policy and the UDRP Rules, and also occasionally include separate opinions and disagreement within the tribunal. Because any discussion of the UDRP proceeding will remind of the arbitration method as alluded to above, the discussion begins in Part I with a clarification and elaboration: a UDRP matter is *not* one of arbitration, although there are

attracted "a diversity of views." *Id.* WIPO notes that although neither WIPO Overview 2.0 nor prior panel decisions are binding on the panels, "predictability remains a key element of dispute resolution systems." *Id.*

²⁷ For purposes of this study, the nationality of each party is taken from its address as indicated in the text of the decision. There is one caveat. The address of the respondent party is often based on unverified information provided by the registrant at the time of the domain name registration.

²⁸ Lee, *supra* note 18.

²⁹ Sang-Hun Choe, *South Koreans Connect Through Search Engine*, N.Y. TIMES (July 5, 2007),

http://www.nytimes.com/2007/07/05/technology/05online.html?_r=0&pagewanted=print (describing Korea as "one of the world's most-wired countries").

similarities between the two, and indeed, the basics of an international arbitration are reflected in a UDRP proceeding. Part II elaborates on the interpretation and application of various provisions of the Policy that govern the resolution of a UDRP dispute, as indicated by the three-member panels from the 58 proceedings. This part includes a separate discussion devoted to the minority of decisions where the panel denied the complaint, thus allowing the respondent to retain the domain name. Finally, with the characteristics of international commercial arbitration practice in mind, Part III highlights ten of the 58 decisions that yielded separate views by individual panelists. These ten decisions bring to light disagreement among the panelists. A critique is also offered for some separate opinions. An appendix of all 58 decisions completes the article.

I. UDRP AND ARBITRATION

The UDRP drafters considered arbitration as the method to resolve domain name disputes, but decided against it.³⁰ As explained herein, a proceeding under the UDRP is not arbitration; the commentary has affirmed this point.³¹ Moreover, U.S. courts have ruled that for purposes

³⁰ WIPO, Final Report, *supra* note 6, ¶ 234.

³¹ E.g., Ljiljana Biukovic, *International Commercial Arbitration in Cyberspace: Recent Developments*, 22 NW. J. INT'L L. & BUS. 319, 337 (2002); A. Michael Froomkin, *ICANN's "Uniform Dispute Resolution Policy" – Causes and (Partial) Cures*, 67 BROOK. L. REV. 605, 687 (2002); Sorkin, *supra*, note 18, at 41-42; Richard E. Speidel, *ICANN Domain Name Dispute Resolution, the Revised Uniform Arbitration Act, and the Limitations of Modern Arbitration Law*, 6 J. SMALL & EMERGING BUS. L. 167, 171-72 (2002).

of the Federal Arbitration Act,³² a UDRP decision does not qualify as an arbitration award.³³ Yet some commentators,³⁴ courts,³⁵ and UDRP panelists³⁶ have imprecisely referred to

³² 9 U.S.C. §§ 1-16 (2016).

³³ E.g., *Dluhos v. Strasberg*, 321 F.3d 365, 372 (3d Cir. 2003); *Parisi v. Netlearning, Inc.*, 139 F. Supp. 2d 745, 745-46 (E.D. Va. 2001). See *Storey v. Cello Holdings, L.L.C.*, 347 F.3d 370, 381 (2d Cir. 2003) (“Unlike traditional binding arbitration proceedings, UDRP proceedings are structured specially to permit the domain-name registrant two bites at the apple.”).

³⁴ E.g., Jordan A. Arnot, *Navigating Cybersquatting Enforcement in the Expanding Internet*, 13 J. MARSHALL REV. OF INTELL. PROP. L. 321, 329, 330 (2014) (“UDRP is an international arbitration process established by ICANN”; “UDRP arbitration proceeding”); Stephen McJohn, *Top Tens of 2013: Patent, Trademark, Copyright, and Trade Secret Cases*, 12 NW. J. TECH. & INTELL. PROP. 177, 197 (2014) (“arbitration under the UDRP”); Gideon Parchomovsky, *On Trademarks, Domain Names, and Internal Auctions*, 2001 U. ILL. L. REV. 211, 225 (“arbitration under the Uniform Domain Name Dispute Resolution Policy”); Suzanna Sherry, *Haste Makes Waste: Congress and the Common Law in Cyberspace*, 55 VAND. L. REV. 309, 355 (“4,000 arbitrations under the UDRP”); Allan R. Stein, *Parochialism and Pluralism in Cyberspace Regulation*, 153 U. PA. L. REV. 2003, 2012 (2005) (“international arbitration . . . pursuant to the resolution dispute policy of the Internet Corporation for Assigned Names and Numbers”); Jason Vogel & Jeremy A. Schachter, *How Ethics Rules Can Be Used To Address Trademark Bullying*, 103 TRADEMARK REP. 503, 507 (2013) (“(UDRP), which governs domain name arbitrations in the current gTLD domain system”); Recent Cases, *Cyberlaw – Trademark Law – WIPO Arbitrators Uphold Conjunctive View of Bad Faith Under the Uniform Domain Name Dispute Resolution Policy*, 127 HARV. L. REV. 2130, 2130, 2133 (2014) (“(UDRP), a system of international arbitration”; “arbitrations under the UDRP”).

³⁵ E.g., *ISystems v. Spark Networks, Ltd.*, No. 10-10905, 2012 WL 3101672, at *3 n.11 (5th Cir. Mar. 21, 2012) (per curiam) (“arbitration pursuant to the UDRP”; “UDRP arbitrations”); *Calista Enters. Ltd. v. Tenza Trading*

the UDRP process as “arbitration.”³⁷ More precisely, the UDRP provides for an *administrative proceeding*, in contrast to *arbitration*.³⁸

Ltd., No. 3:13-cv-01045-SI, 2014 WL 3670856, at *1 (D. Or. July 23, 2014) (“UDRP arbitration panel”); Parker Waichman Alonso LLP v. Orlando Firm, P.C., No. 09 Civ. 7401(CM), 2010 WL 1956871 at *5 (S.D.N.Y. May 14, 2010) (“Arbitration decisions governed by the UDRP”); Olympic Sports Data Servs., Ltd. v. Maselli, Misc. Action No. 07-117, 2010 WL 310772, at *2 (E.D. Pa. Jan. 22, 2010) (“arbitration under the UDRP”); Bord v. Banco de Chile, 205 F. Supp. 2d 521, 523 (E.D. Va. 2002) (“This arbitration procedure mandated by the accreditation agreement is the Uniform Dispute Resolution Procedure (hereinafter ‘UDRP’).”).

³⁶ E.g., Swarovski Aktiengesellschaft v. Li XiaoLi, WIPO Case No. D2012-1401 (Sept. 5, 2012) (referring to “[m]any UDR arbitration panelists”); Hoffmann-La Roche Inc. v. #1 Viagra Propecia Xenical & More Online Pharm., WIPO Case No. D2003-0793 (Nov. 30, 2003) (“the majority of UDRP arbitration decisions”). See Baltimore Museum of Art, Inc. v. Mo Domains, WIPO Case No. D2005-0720 (Sept. 1, 2005) (“adverse ICANN UDRP arbitrations”); Groupe Industriel Marcel Dassault v. Mr. Minwoo Park, WIPO Case No. D2003-0989 (Feb. 12, 2004) (“the arbitration proceeding will be unduly delayed”); Cognigen Networks, Inc. v. Pharm. Outcomes Research, WIPO Case No. D2001-1094 (Dec. 18, 2001) (“the Complainant’s pursuit of this UDRP arbitration”).

³⁷ Perhaps there is understandable reason for the confusion. All publicly available UDRP decisions administered by WIPO have at the top of the first page the caption, WIPO “Arbitration and Mediation Center.” In addition to UDRP proceedings, WIPO provides administration services for arbitration and mediation. *WIPO Arbitration and Mediation Center*, WIPO, <http://www.wipo.int/amc/en/center/background.html>. Another ICANN-approved dispute resolution service provider is the National Arbitration Forum (NAF). NAF’s Internet site includes a searchable database for its UDRP decisions under various fields, including “Arbitrator.” *Domain Name Dispute Proceedings and Decisions*, NAF, <http://www.adrforum.com/SearchDecisions>.

Black's Law Dictionary reports that "arbitration" in English was first used in the fifteenth century.³⁹ Over time, there have been many meanings. For purposes of discussion herein, this article adopts a definition contained in a previous edition of *Black's*: "The reference of a dispute to an impartial (third) person chosen by the parties to the dispute who agree in advance to abide by the arbitrator's award issued after a hearing at which both parties have an opportunity to be heard."⁴⁰ The elements of the basic

³⁸ Froomkin, *supra* note 31, at 687. Then Circuit Judge Sotomayor emphasized the "administrative proceeding" phrasing, and used it throughout her opinion in *Storey*, 347 F.3d at 376. The Policy specifies that a proceeding brought under it is a "mandatory administrative proceeding" or "administrative proceeding." UDRP, *supra* note 5, ¶¶ 3(c), 4, 4(a), 4(h), 4(k), 5, 8(a), 8(b). The panel that decides the dispute is the "Panel" or "Administrative Panel." *Id.* ¶¶ 3(c), 4(b), 4(c), & (e)-(k). The UDRP Rules further define: "Panel means an administrative panel appointed by a Provider to decide a complaint concerning a domain-name registration"; and "Panelist means an individual appointed by a Provider to be a member of a Panel." UDRP Rules, *supra* note 15, ¶ 1. There are four references to "arbitration" and one to "arbitrator" in the text of the Policy, all directed to a proceeding separate from the UDRP proceeding. UDRP, *supra* note 5, ¶¶ 5, 8(a), 8(b).

³⁹ BLACK'S LAW DICTIONARY xxxi & 125 (10th ed. 2014).

⁴⁰ BLACK'S LAW DICTIONARY 96 (5th ed. 1979). These elements are present in provisions of the Federal Arbitration Act, 9 U.S.C. §§ 1-16 (2016). Section 2 of the Act provides that an arbitration agreement is enforceable; section 4 gives the district court the authority to compel arbitration; section 9 allows the court to issue an order confirming the award; section 10 provides the limited grounds on which a court may vacate the award and which grounds the Supreme Court has ruled are exclusive. *Hall Street Assocs. v. Mattel, Inc.*, 552 U.S. 576, 578 (2008). Section 10 also refers to a "hearing." 9 U.S.C. § 10. *Black's* tenth edition

definition most relevant here are: (i) the agreement by the parties to resort to the extrajudicial procedure and (ii) the binding nature of the impartial panel's award. These essential aspects of arbitration are not present in the UDRP process.

Foremost, "[a]rbitration can only take place if both parties have agreed to it."⁴¹ In a UDRP proceeding, there is no agreement at all between the two parties – the respondent (the registrant of a disputed domain name) and the complainant (who alleges that the registrant's registration of the domain name violates the complainant's trademark rights).⁴² The only operative agreement is between the registrant and the registrar, in which the registrant agrees, *inter alia*, to submit a dispute to an administrative proceeding brought by a complainant that is not known at the time of the agreement. The complainant is not a party to the agreement. Some commentators suggest that the UDRP process triggers a form of "third party beneficiary" arbitration.⁴³ But again, this approach departs from the basic

defines arbitration as follows: "A dispute-resolution process in which the disputing parties choose one or more neutral third parties to make a final and binding decision resolving the dispute. . . . The parties to the dispute may choose a third party directly by mutual agreement, or indirectly, such as by agreeing to have an arbitration organization select the third party." BLACK'S LAW DICTIONARY, *supra* note 39, at 125.

⁴¹ *What Is Arbitration?*, WIPO,

<http://www.wipo.int/amc/en/arbitration/what-is-arb.html>.

⁴² See Speidel, *supra* note 31, at 172-73.

⁴³ A. Michael Froomkin, *Wrong Turn in Cyberspace: Using ICANN To Route Around the APA and the Constitution*, 50 DUKE L.J. 17, 135 (2000) (referring to "UDRP-like mandatory third-party beneficiary clauses that created arbitration rights for any aggrieved trademark holder"). See Benjamin G.

definition of arbitration, which requires an agreement between the principals. Moreover, by agreeing to the arbitration method, the parties waive their right of access to the courts for the resolution of their dispute on the merits,⁴⁴ and in the U.S., the right to a jury trial.⁴⁵ Once the parties agree to resort to arbitration and the arbitration panel issues an award, a court may refuse to recognize the award⁴⁶ or

Davis, *Une Magouille Planetaire: The UDRP Is an International Scam*, 72 MISS. L.J. 815, 862 n.74 (2002) (referring to "the contours of the third party beneficiary relationship for the registry/registrar with the parties to the dispute once a complaint is filed"); Froomkin, *supra* note 31, at 612 (referring to ICANN "requir[ing] registries (and also registrars) to promise to subject all registrants to a mandatory third-party beneficiary clause in which every registrant agrees to submit to ICANN's UDRP upon the request of aggrieved third parties who believe they have a superior claim to the registrant's domain name).

⁴⁴ *Belom v. Nat'l Futures Ass'n*, 284 F.3d 795, 799 (7th Cir. 2002) ("The right to an Article III forum is not absolute and may be waived. Where an individual consents to arbitration, he waives the right to an impartial and independent adjudication.") (citing *Commodity Futures Trading Comm'n v. Schor*, 478 U.S. 833, 848 (1986); *Marsh v. First USA Bank, N.A.*, 103 F. Supp. 2d 909, 921 (N.D. Tex. 2000) ("[A] valid arbitration provision . . . waives the right to resolve a dispute through litigation in a judicial forum . . ."); Cynthia L. Estlund, *Between Rights and Contract: Arbitration, Agreements and Non-Compete Covenants As a Hybrid From of Employment Law*, 155 U. PA. L. REV. 379, 381 (2006) ("Mandatory arbitration agreements . . . waive the right to litigate future legal claims in a judicial forum in favor of arbitration . . .").

⁴⁵ *E.g., Marsh*, 103 F. Supp. 2d at 921; *In re Prudential Ins. Co. of Am.*, 148 S.W.3d 124, 132 (Tex. 2004).

⁴⁶ In the international setting, the New York Convention provides for the seven grounds on which courts of a contracting party may refuse recognition of an arbitration award. Convention on the Recognition and

may vacate the award⁴⁷ only on very limited grounds. Perhaps the consequences of the arbitration method explain the requirement that the effecting arbitration agreement between the parties be in writing.⁴⁸

To emphasize, a UDRP panel's decision on the merits is not binding,⁴⁹ or more technically, there is no agreement between the parties that the decision will be binding. As

Enforcement of Foreign Arbitral Awards, art. V, June 10, 1958, 21 U.S.T. 2517, 330 U.N.T.S. 3 [hereinafter New York Convention].

⁴⁷ For the limited grounds for vacating an award in the U.S., see Federal Arbitration Act, 9 U.S.C. § 10 (2016). See UNCITRAL Model Law on International Commercial Arbitration, G.A. Res. 40/72, art. 34(2), U.N. Doc. A/40/17/Annex I & A/61/17/Annex I (June 21, 1985) (model arbitration law's grounds).

⁴⁸ New York Convention, *supra* note 46, art. II(1) ("Each Contracting State shall recognize an *agreement in writing* under which the parties undertake to submit to arbitration all or any differences which have arisen or which may arise between them in respect of a defined legal relationship, whether contractual or not, concerning a subject matter capable of settlement by arbitration.") (emphasis added); Federal Arbitration Act, 9 U.S.C. § 2 (2016) ("A *written provision* in any maritime transaction or a contract evidencing a transaction involving commerce to settle by arbitration a controversy thereafter arising out of such contract or transaction . . . or an *agreement in writing* to submit to arbitration an existing controversy arising out of such a contract, transaction, or refusal, shall be valid, irrevocable, and enforceable, save upon such grounds as exist at law or in equity for the revocation of any contract.") (emphasis added). The reason for imposing the writing requirement in arbitration agreements "is self-evident. A valid agreement to arbitrate excludes the jurisdiction of the courts and makes arbitration an exclusive method for dispute resolution." Nilanjana Chatterjee, *Arbitration Proceedings under ICANN's Uniform Domain Name Dispute Resolution Policy - Myth or Reality*, 10 VINDOBONA J. INT'L COM. L. & ARB. 67, 84-85 (2006).

⁴⁹ See Sorkin, *supra* note 18, at 42; Speidel, *supra* note 31, at 174-75.

indicated earlier, even if the panel decides in favor of the complainant and orders a transfer or cancellation of the domain name, the respondent may avoid ICANN's implementation of the panel decision by bringing an action in court.⁵⁰ Indeed, either party may ignore the UDRP proceeding altogether and seek resolution in the courts before, during, or after the proceeding.⁵¹

Even though the UDRP procedure does not fit within the traditional definition of arbitration, there are important similarities between a UDRP proceeding and arbitration.⁵² Foremost and fundamentally, both offer an extrajudicial method to resolve a dispute over a commercial interest as an alternative to adjudication in the courts. There is also often an international component in many UDRP and arbitration proceedings, when the parties are of different nationalities, cultures, and languages. The UDRP proceeding (and some

⁵⁰ UDRP, *supra* note 5, ¶ 4(k).

⁵¹ The current edition of *Black's* has an entry for "nonbinding arbitration." BLACK'S LAW DICTIONARY, *supra* note 39, at 126. The phrase has been used to describe a UDRP proceeding, *e.g.*, *Bord v. Banco de Chile*, 205 F. Supp. 2d 521, 523 (E.D. Va. 2002); *Sherry*, *supra* note 34, at 354; Stephen J. Ware, *Domain-Name Arbitration in the Arbitration-Law Context: Consent to, and Fairness in, the UDRP*, 6 J. SMALL & EMERGING BUS. L. 129, 149 (2002). The term is a "misnomer . . . because arbitration is usually intended to result in a final, binding award." BLACK'S LAW DICTIONARY, *supra* note 39, at 126. In my view, except for the rare situation where the parties agree to disregard the arbitration award and instead agree on a settlement (with party autonomy reigning supreme), an arbitration by definition cannot be nonbinding.

⁵² See Holger P. Hestermeyer, *The Invalidity of ICANN's UDRP Under National Law*, 3 MINN. INTELL. PROP. REV. 1, 44 (2002); Julia Hörnle, *The Uniform Domain Name Dispute Resolution Procedure: Is Too Much of a Good Thing a Bad Thing?*, 11 SMU SCI. & TECH. L. REV. 253, 254 (2008).

arbitration matters) involves an institutional case manager⁵³ who oversees the conduct of the proceeding, under specified rules and guidelines. In addition, several features of the UDRP procedure appear to be borrowed from the international arbitration model, especially relating to the panels (and individual panelists) that decide the dispute. Specifically, these features address (1) the panelists' qualifications; (2) the panelists' required disclosures before and after appointment; (3) the number of panelists comprising the panel; (4) party involvement in the selection of panelists; (5) the role of the presiding panelist (or chair); (6) the nationality of the panelists; and (7) the powers and authority of the panels during the proceeding. These characteristics are addressed in order.

(1) Regarding the qualifications of tribunal members, the major international arbitral organizations impose a basic requirement that every arbitrator be "impartial and independent."⁵⁴ The UDRP Rules repeat this very phrasing

⁵³ In arbitration, the parties may agree to craft the procedures of the arbitration themselves (ad hoc arbitration), or to abide by the rules and practices of an administering organization (institutional arbitration). *See generally* Gerald Aksen, *Ad Hoc Versus Institutional Arbitration*, 2 ICC ICARB. BULL. 8 (1991).

⁵⁴ Am. Arbitration Assoc., International Arbitration Rules, art. 13(1) (2014) [hereinafter AAA Rules]; Int'l Chamber of Commerce, Arbitration Rules, art. 11(1) (2012) [hereinafter ICC Rules]; London Court of Int'l Arbitration, Arbitration Rules, art. 5.3 (2014) [hereinafter LCIA Rules]. The United Nations Commission on International Trade Law (UNCITRAL) Arbitration Rules, the leading rules for ad hoc arbitrations, provide, "The appointing authority shall have regard to such considerations as are likely to secure the appointment of an independent and impartial arbitrator" G.A. Res. 68/109, art. 6(7), U.N. GAOR,

for the administrative panel.⁵⁵ WIPO offers that its panelists are “well-reputed for their impartiality, sound judgement and experience as decision-makers, as well as their substantive experience in the areas of intellectual property law, electronic commerce and the Internet.”⁵⁶ (2) A prospective arbitrator must disclose any circumstances that might give rise to “justifiable doubts” as to her impartiality or independence.⁵⁷ Some organizations add that such doubt or question should be considered in “the eyes”⁵⁸ or “the mind”⁵⁹ of the parties. A UDRP panelist is likewise under a duty to disclose “any circumstances giving rise to justifiable

68th Sess., Supp. No. 17, U.N. Doc. A/RES/68/109 (Dec. 16, 2013) [hereinafter UNCITRAL Rules].

⁵⁵ UDRP Rules, *supra* note 15, ¶ 7.

⁵⁶ *WIPO Domain Name Panelists*, WIPO, <http://www.wipo.int/amc/en/domains/panel.html>. *See also* WIPO Guide, *supra* note 20 (“E. Who Are the Panelists”) (“The persons appearing on the WIPO Center’s list of Domain Name Panelists have been selected on the basis of their well-established reputation for their impartiality, sound judgment and experience as decision-makers, as well as their substantive experience in the areas of international trademark law, electronic commerce and Internet-related issues.”).

⁵⁷ AAA Rules, *supra* note 54, art. 13(2); LCIA Rules, *supra* note 54, art. 5.4; UNCITRAL Rules, *supra* note 54, art. 11. *See* ICC Rules, *supra* note 54, art. 11(2) (requiring disclosure of “any facts or circumstances which might be of such a nature as to call into question the arbitrator’s independence in the eyes of the parties, as well as any circumstances that could give rise to reasonable doubts as to the arbitrator’s impartiality”).

⁵⁸ ICC Rules, *supra* note 54, art. 11(2).

⁵⁹ LCIA Rules, *supra* note 54, art. 5.4.

doubt as to the Panelist's impartiality or independence,"⁶⁰ to which WIPO practice adds that the question of independence be considered "in the eyes of one or both of the parties."⁶¹

(3) With respect to the number of arbitrators, the rules of most administering organizations provide that a single arbitrator will preside over the arbitration, unless the parties agree on a different number, or the organization in its discretion determines that a three-member tribunal is necessary.⁶² In a UDRP proceeding, a sole panelist decides the case,⁶³ unless either the complainant or the respondent elects to have the dispute decided by a panel with three members.⁶⁴ (4) In an arbitration, if a single arbitrator is to decide the dispute, the administering organization appoints the arbitrator, unless the parties agree on a different procedure.⁶⁵ In a UDRP proceeding, the provider appoints a

⁶⁰ UDRP Rules, *supra* note 15, ¶ 7. The duty to disclose is a continuing one. *Id.*

⁶¹ *Statement of Acceptance and Declaration of Impartiality and Independence*, WIPO, <http://www.wipo.int/amc/en/domains/statement/panel.html>.

⁶² AAA Rules, *supra* note 54, art. 11; ICC Rules, *supra* note 54, art. 12(2); LCIA Rules, *supra* note 54, art. 5.8. See UNCITRAL Rules, *supra* note 54, art. 7.

⁶³ UDRP Rules, *supra* note 15, ¶ 6(b).

⁶⁴ *Id.* ¶ 6(c). If the complainant elects to have a three-member panel, the complainant must pay the applicable fees. If the complainant elects a single panelist and the respondent elects to have three panelists, the parties must share the fees of a three-member panel. *Id.*

⁶⁵ AAA Rules, *supra* note 54, arts. 12(1) & (6); ICC Rules, *supra* note 54, art. 12(3); UNCITRAL Rules, *supra* note 54, art. 8(1). The LCIA takes a different approach: "No party or third person may appoint any arbitrator under the Arbitration Agreement: the LCIA Court alone is empowered to appoint arbitrators (albeit taking into account any written

single panelist from its list of approved panelists.⁶⁶ Where an arbitration agreement provides for three arbitrators, some arbitral organizations allow each party to nominate one of the arbitrators.⁶⁷ In a UDRP proceeding with a three-member panel, there is also party involvement in the selection of the panelists – each party is to provide a list of three candidates, “drawn from any ICANN-approved Provider’s list of panelists,” to serve as one of the panelists.⁶⁸ The rules also state that the provider “shall endeavor” to appoint one panelist from the list of candidates provided by each of the parties.⁶⁹

agreement or joint nomination by the parties).” LCIA Rules, *supra* note 54, art. 5.7.

⁶⁶ UDRP Rules, *supra* note 15, ¶ 6(b).

⁶⁷ ICC Rules, *supra* note 54, art. 12(4); LCIA Rules, *supra* note 54, art. 5.8; *see* UNCITRAL Rules, *supra* note 54, art. 9(1) (“If three arbitrators are to be appointed, each party shall appoint one arbitrator.”).

⁶⁸ UDRP Rules, *supra* note 15, ¶¶ 3(b)(iv), 5(b)(v), 6(d). The WIPO Supplemental Rules add that the party must indicate its order of preference. WIPO Supp. Rules, *supra* note 23, ¶ 7(a).

⁶⁹ UDRP Rules, *supra* note 15, ¶ 6(e). The WIPO Supplemental Rules state that in appointing a panelist in this situation, WIPO “shall, subject to availability, respect the order of preference indicated by a Party.” WIPO Supp. Rules, *supra* note 23, ¶ 7(a). In the event that a provider is unable to confirm timely the appointment of a panelist from either party’s list of candidates, “the Provider shall make that appointment from its list of panelists.” UDRP Rules, *supra* note 15, ¶ 6(e). Also, if the complainant elects to have a three-member panel and the respondent defaults, WIPO “shall, subject to availability, appoint one Panelist from the names submitted by the Complainant and shall appoint the second Panelist and the Presiding Panelist from its published list.” WIPO Supp. Rules, *supra* note 23, ¶ 7(c)(ii).

(5) In an arbitration with three arbitrators, one of the arbitrators serves as the chair or presiding arbitrator of the tribunal. This is of practical significance in that she, as first among equals, serves a leading role in the conduct of the arbitration, may vote to break ties when the party-nominated arbitrators disagree,⁷⁰ and takes on the principal responsibility of drafting the resulting award. The rules of one administering organization provide that it will select the president of the arbitral tribunal unless the parties have agreed on another procedure.⁷¹ Another method seen in practice is for the two party-appointed arbitrators to select the presiding arbitrator.⁷² For proceedings under the UDRP, “The third Panelist shall be appointed by the Provider from a list of five candidates submitted by the Provider to the Parties, the Provider’s selection from among the five being made in a manner that reasonably balances the preferences of both Parties, as they may specify to the Provider”⁷³ ICANN’s UDRP documents do not specify the role or the title of the third panelist, but the WIPO Supplemental Rules provide that the third panelist “shall be the Presiding Panelist.”⁷⁴

⁷⁰ See ICC Rules, *supra* note 54, art. 31(1); LCIA Rules, *supra* note 54, art. 26.5; UNCITRAL Rules, *supra* note 54, art. 33(2).

⁷¹ ICC Rules, *supra* note 54, art. 12(5).

⁷² UNCITRAL Rules, *supra* note 54, art. 9(1).

⁷³ UDRP Rules, *supra* note 15, ¶ 6(e). From the list of candidates for the presiding panelist, each party may indicate its order of preference. WIPO Supp. Rules, *supra* note 23, ¶ 7(b)(ii). The WIPO Supplemental Rules provide that “[n]otwithstanding the procedure provided for in Paragraph 6(e) of the [UDRP Rules], the Parties may jointly agree on the identity of the Presiding Panelist.” *Id.* ¶ 7(b)(iii).

⁷⁴ WIPO Supp. Rules, *supra* note 23, ¶ 7(b)(i).

(6) Where an arbitration involves opposing parties from different countries, the nationality of the arbitrator deciding the case is of some moment.⁷⁵ Most arbitral rules address the nationality of the parties or arbitrators explicitly.⁷⁶ Some provide that where the parties are of different nationalities, the sole panelist or the chair must be of a nationality other than those of the parties, unless the parties agree otherwise.⁷⁷ Given that many disputes under the UDRP involve parties from different countries, perhaps it is surprising that the Policy, the UDRP Rules, and the WIPO Supplemental Rules do not specifically mention the nationality of the parties or panelists. WIPO does note that its list of panelists "is international, consisting of some 400 Panelists from over 50 countries, many of whom are multi-lingual."⁷⁸ Especially because some proceedings involve

⁷⁵ For a discussion of the nationality of the arbitrator in international commercial arbitration, see Ilhyung Lee, *Practice and Predicament: The Nationality of the International Arbitrator*, 31 FORDHAM INT'L L.J. 603 (2008).

⁷⁶ E.g., AAA Rules, *supra* note 54, art. 12(4) ("At the request of any party or on its own initiative, the Administrator may appoint *nationals* of a country other than that of any of the parties."); ICC Rules, *supra* note 54, art. 13(1) ("In confirming or appointing arbitrators, the [ICC] shall consider the prospective arbitrator's *nationality*, residence and other relationships with the countries of which the parties or the other arbitrators are *nationals*. . . .") (emphasis added); see UNCITRAL Rules, *supra* note 54, art. 6.7 ("The appointing authority . . . shall take into account the advisability of appointing an arbitrator of a *nationality* other than the *nationalities* of the parties.") (emphasis added).

⁷⁷ ICC Rules, *supra* note 54, art. 13(5); LCIA Rules, *supra* note 54, art. 6.1.

⁷⁸ WIPO Guide, *supra* note 20 ("E. Who Are the Panelists"). See WIPO *Domain Name Panelists*, *supra* note 56 ("WIPO panelists come from different regions of the world . . .").

more than one language,⁷⁹ it is likely that the nationality of the parties and prospective panelists is taken into account when providers appoint individual panelists. In a UDRP proceeding where the complainant and respondent are from different countries, a three-member panel whose composition includes both nationalities will contribute to party confidence in the system.⁸⁰

(7) Once appointed, the arbitrator has wide discretion in conducting the arbitration.⁸¹ In contrast to the arbitrator, the tasks of the UDRP panelist are more circumscribed, especially given that generally the proceeding does not allow for discovery (of the type seen in U.S. civil actions) or in-person hearings.⁸² Yet the UDRP panel has similar discretion and authority to “conduct the administrative

⁷⁹ The UDRP Rules address the matter of the language of the proceeding. UDRP Rules, *supra* note 15, ¶ 11. For a decision discussing the rule, see *infra* text accompanying notes 265-71.

⁸⁰ A discussion of the composition of the panels in the 58 decisions herein, by nationality of the panelists, appears *infra* text accompanying notes 376-77.

⁸¹ AAA Rules, *supra* note 54, art. 20(1) (“Subject to these Rules, the arbitral tribunal may conduct the arbitration in whatever manner it considers appropriate, provided that the parties are treated with equality and that each party has the right to be heard and is given a fair opportunity to present its case.”); LCIA Rules, *supra* note 54, art. 14.5 (“The Arbitral Tribunal shall have the widest discretion to discharge these general duties, subject to such mandatory law(s) or rules of law as the Arbitral Tribunal may decide to be applicable . . .”).

⁸² Paragraph 13 of the UDRP Rules states: “There shall be no in-person hearings (including hearings by teleconference, videoconference, and web conference), unless the Panel determines, in its sole discretion and as an exceptional matter, that such a hearing is necessary for deciding the complaint.” UDRP Rules, *supra* note 15, ¶ 13.

proceeding in such manner as it considers appropriate in accordance with the Policy and these Rules”⁸³ and “determine the admissibility, relevance, materiality and weight of the evidence.”⁸⁴ Toward a decision, the panel may consider, in addition to the party submissions and the UDRP documents, “any rules and principles of law that it deems applicable.”⁸⁵

With this background in hand, we turn to the decisions of the UDRP panels in the 58 proceedings involving Korean parties.

II. THE COMPLAINANT’S CASE AND THE RESPONDENT’S DEFENSE, BY THE 58 DECISIONS

A. THE REQUISITE ELEMENTS

As one panel stated, “The overriding objective of the Policy is to prevent abusive domain name registration and use for the benefit of legitimate trademark owners”⁸⁶ To reiterate, under paragraph 4(a) of the Policy, in order for the complainant to obtain transfer or cancellation of the disputed domain name, it must show that: the domain name “is identical or confusingly similar to a trademark or service mark in which the complainant has rights”; the respondent has “no rights or legitimate interests in respect of the domain

⁸³ *Id.* ¶ 10(a).

⁸⁴ *Id.* ¶ 10(d).

⁸⁵ *Id.* ¶ 15(a).

⁸⁶ IPGM Inst. Mixte de Prévoyance du Groupe Mornay v. Sooyong Kim, WIPO Case No. D2007-1513 (Mar. 4, 2008) (citing Telstra Corp. v. Nuclear Marshmallows, WIPO Case No. D2000-0003 (Feb. 18, 2000)).

name”; and the domain name “has been registered and is being used in bad faith.”⁸⁷ WIPO-administered decisions typically include the panel’s disposition of each of the three elements of paragraph 4(a).⁸⁸ This Part highlights and elaborates on the requisite elements, as interpreted and applied by the panels in the 58 decisions.

1. DOMAIN NAME IS “IDENTICAL OR CONFUSINGLY
SIMILAR TO A TRADEMARK OR SERVICE MARK IN
WHICH THE COMPLAINANT HAS RIGHTS”

The complainant having rights in a trademark or service mark is a prerequisite to the question of whether the domain name is identical or confusingly similar to that mark.⁸⁹ In the large majority of UDRP decisions, the complainant demonstrates such rights by registration and use. In most cases, registration is presumptive evidence of valid rights.⁹⁰ In those instances where the complainant did

⁸⁷ UDRP, *supra* note 15, ¶ 4(a).

⁸⁸ In one of the 58 decisions, the panel’s discussion of paragraph 4(a) is limited to the bad faith element in 4(a)(iii), and does not address directly the other two elements. JJGC Industria E Comercio de Materiais Dentarios S.A. v. Yun-Ki Kim, WIPO Case No. D2013-1838 (Dec. 20, 2013).

⁸⁹ Dig. Overture Inc. v. Chris Bradfield/GoPets Ltd., WIPO Case No. D2008-0091 (Apr. 23, 2008).

⁹⁰ In one decision, the respondent invited the panel to disregard the registration of a mark (“JET TOURS”), urging that it was descriptive or generic. Jet Marques v. Vertical Axis, Inc., WIPO Case No. D2006-0250 (May 26, 2006). The panel declined, stating, “[I]t is only in very limited circumstances that a Panel may examine the circumstances of a trademark registration to determine whether the registration satisfies the requirements of the Policy (*e.g.* in cases where the trademark registration

not register the mark, it may nevertheless demonstrate common law rights⁹¹ through use. For example, in *Shoulderdoc Ltd. v. Vertical Axis, Inc.*,⁹² although “shoulderdoc.co.uk” was not a registered mark, the panel determined that the complainant’s use of the term on its website and in its brochure satisfied the preliminary requirement of rights in a mark. Noting that the complainant’s use would allow the public to see the mark as indicating the origin of services, the panel found that “the Complainant is likely to have generated sufficient reputation and goodwill in the name <shoulderdoc.co.uk> . . . to have acquired common law rights in a shoulderdoc.co.uk mark in England and Wales.”⁹³ Evidence of trademark rights in any country is sufficient for purposes of paragraph 4(a)(i) of the Policy.⁹⁴ Indeed, the complainant need not necessarily show rights in the country of the respondent or the registrar.⁹⁵

is automatic or unexamined, as occurs with the United States state registrations).” *Id.*

⁹¹ *Reckitt Benckiser Plc v. Eunsook Wi*, WIPO Case No. D2009-0239 (May 20, 2009).

⁹² WIPO Case No. D2006-0625 (Sept. 8, 2006).

⁹³ *Id.* The source-indicating function is indeed the “hallmark of a trademark,” *Rock & Roll Hall of Fame & Museum, Inc. v. Gentile Prods.*, 134 F.3d 749, 755 (6th Cir. 1998), and a definitional component, Lanham Trademark Act of 1946, 15 U.S.C. § 1127 (definition for “Trademark” includes use “to indicate the source of the goods”).

⁹⁴ *Reckitt Benckiser Plc*, WIPO Case No. D2009-0239; *IPGM Inst. Mixte de Prévoyance du Groupe Mornay v. Sooyong Kim*, WIPO Case No. D2007-1513 (Mar. 4, 2008) (citation omitted).

⁹⁵ But trademark rights in other countries, and the extent to which the mark is known worldwide, may be relevant to the question of whether

In two of the 58 decisions, the panel held that the complainant failed to show that it had rights in a mark. In *Deutsche Telekom AG v. Unitedeurope Consulting*,⁹⁶ the complainant had registrations for various marks beginning with the “T-” prefix, including “T-BIZ”, “T-BOX”, “T-CITY”, “T-HOME”, “T-JOBS”, “T-NETWORK”, “T-HEALTH”, “T-PORTAL”, and “T-SALES”, which corresponded to nine of the eleven disputed domain names. The complainant argued that it also had trademark rights relating to <t-broadcast.com> and <t-show.com>, relying on its European Community registrations for “T” and non-registered marks rights to “T-[descriptive term].” The panel disagreed, stating that “[s]uch a finding with regard to trademark rights would be overly broad.”⁹⁷

In the proceeding involving the domain name <gopets.net>, the panel determined that there was no evidence to support registered trademark rights or “common law (i.e., unregistered) trademark rights.”⁹⁸ There, the complainant sought to obtain rights based on the registration and use of its own domain name <gopets.com> (which was not the subject of the proceeding). The

the respondent was aware of the complainant’s mark and was acting in bad faith under paragraph 4(a)(iii) of the Policy.

⁹⁶ WIPO Case No. D2006-0930 (Dec. 27, 2006).

⁹⁷ The panel reasoned that “such an issue is one that is more proper for the relevant trademark offices and courts of law – not these administrative proceedings.” *Id.*

⁹⁸ Dig. Overture Inc. v. Chris Bradfield/GoPets Ltd., WIPO Case No. D2008-0091 (Apr. 23, 2008). The two parties in the proceeding were also involved in an action in the U.S. district court, brought by the respondent. See *infra* text accompanying notes 224-27 & note 230.

complainant had registered the domain name nine years before its commencement of the UDRP proceeding, and had developed a marketing plan and referred to “development tasks” concerning the intended website. The panel ruled that these were insufficient to show trademark rights: “The Complainant’s preparatory plans and research do not show that it has used a mark ‘in trade’. It merely indicates an intention to do so. But such an intention does not show that it has actually been done”⁹⁹

Once rights in a mark are established, the panel’s discussion turns to the question of whether the domain name is identical or confusingly similar to the complainant’s mark. This entails an objective test, a comparison between the complainant’s mark and the domain name at issue.¹⁰⁰ For purposes of this comparison under paragraph 4(a)(i), the presence of the generic Top Level Domain (gTLD) (e.g., “-.com” or “-.net”), a technical requirement in every domain name, is generally disregarded.¹⁰¹ Thus, panels have

⁹⁹ *Id.*

¹⁰⁰ IPGM Inst. Mixte de Prévoyance du Groupe Mornay v. Sooyong Kim, WIPO Case No. D2007-1513 (Mar. 4, 2008) (citing *Magnum Piering, Inc. v. Mudjackers & Garwood S. Wilson, Sr.*, WIPO Case No. D2000-1525 (Jan. 29, 2001)); *Nursefinders, Inc. v. Vertical Axis, Inc.*, WIPO Case No. D2007-0417 (July 5, 2007). One panel added that this comparison is “independent of the use factors usually considered in a traditional trademark infringement action.” *IPGM Inst. Mixte de Prévoyance du Groupe Mornay*, WIPO Case No. D2007-1513.

¹⁰¹ *Mobile’s Republic v. Kwangpyo Kim*, WIPO Case No. D2014-0089 (Apr. 23, 2014); *Deutsche Lufthansa AG v. [] Kwangpyo Kim*, WIPO Case No. D2013-1844 (Jan. 22, 2014); *Heimbs Kaffee GmbH & Co. KG v. Ho Kyoung Trading Co, Ltd., Heui-il Kang*, WIPO Case No. D2011-1407 (Oct. 17, 2011); *Reckitt Benckiser Plc v. Eunsook Wi*, WIPO Case No.

determined that the first element of paragraph 4(a) was satisfied in decisions involving the following domain names: <carfax.net>;¹⁰² <chivas.net>;¹⁰³ <ifil.com>;¹⁰⁴ <itau.com>;¹⁰⁵ <maxell.net>;¹⁰⁶ <sony.net>;¹⁰⁷ and <samsung.com.ve>.¹⁰⁸ These domain names were challenged by the respective complainant whose mark appeared in full in the domain name, followed by the gTLD. Panels have also found confusing similarity where the domain name incorporates the complainant's mark, with the only difference being the alteration of a letter (<herts.com>¹⁰⁹); the deletion of a letter

D2009-0239 (May 20, 2009); *IPGM Inst. Mixte de Prévoyance du Groupe Mornay*, WIPO Case No. D2007-1513; *STX LLC v. Yu nae ho*, WIPO Case No. D2006-0567 (Aug. 14, 2006); *Jet Marques v. Vertical Axis, Inc.*, WIPO Case No. D2006-0250 (May 26, 2006); *Carfax, Inc. v. COMn.COM*, WIPO Case No. D2002-0513 (Sept. 18, 2002). See WIPO Overview 2.0, *supra* note 26, ¶ 1.2 ("The applicable top-level suffix in the domain name . . . would usually be disregarded under the confusing similarity test . . .").

¹⁰² *Carfax, Inc.*, WIPO Case No. D2002-0513.

¹⁰³ *Chivas Bros. Ltd. v. Anyweb Co.*, WIPO Case No. D2006-1446 (Feb. 2, 2007).

¹⁰⁴ *IFIL S.p.A v. Han Jin Go*, WIPO Case No. D2007-0535 (Aug. 15, 2007).

¹⁰⁵ *Banco Itau S.A. v. Webmedia*, WIPO Case No. D2008-0531 (July 18, 2008).

¹⁰⁶ *Hitachi Maxell Kabushiki Kaisha v. Gyuhwa Chung*, WIPO Case No. D2003-0079 (May 1, 2003) [in Korean].

¹⁰⁷ *Sony Kabushiki Kaisha v. sony.net*, WIPO Case No. D2000-1074 (Nov. 28, 2000).

¹⁰⁸ *Samsung Networks Co. v. SuperVirtualOffice Corp.*, WIPO Case No. DVE2010-0001 (May 10, 2010).

¹⁰⁹ *Hertz Sys., Inc. v. Jeff Park*, WIPO Case No. D2007-1120 (Nov. 9, 2007).

(<nursefinder.com>¹¹⁰); the deletion of a space (<nbcuniversal.com>¹¹¹); the deletion of a space and a letter (<unitedairline.com>¹¹²); the deletion of an apostrophe, a letter, and a space (<samclub.com>¹¹³); and the addition of a generic word or a geographic name inserted before or after the mark (<mysony.com>¹¹⁴ <amazon119.com>¹¹⁵ <amazoncar.com>¹¹⁶ <amazonpic.com>¹¹⁷ <amazonfire.com>¹¹⁸ <casioshop.net>¹¹⁹ <minkagroup.com>¹²⁰ <weddingritz.com>¹²¹ <samsungturkey.com>¹²² <playboysportsbooks.com>¹²³).

¹¹⁰ Nursefinders, Inc. v. Vertical Axis, Inc., WIPO Case No. D2007-0417 (July 5, 2007).

¹¹¹ NBC Universal, Inc. v. Junak Kwon, WIPO Case No. D2004-0764 (Dec. 23, 2004).

¹¹² United Airlines, Inc. v. United Airline Dot.Com, WIPO Case No. D2002-0835 (Nov. 9, 2002).

¹¹³ Wal-Mart Stores, Inc. v. iContents, WIPO Case No. D2006-0226 (June 20, 2006).

¹¹⁴ Sony Kabushiki Kaisha v. Sin, Eonmok, WIPO Case No. D2000-1007 (Nov. 16, 2000).

¹¹⁵ Amazon.com, Inc. v. Amazoninsu Co., WIPO Case No. D2001-1275 (Dec. 20, 2001). "119" is the Korean equivalent of "911" stateside, for emergency services.

¹¹⁶ Amazon.com, Inc. v. Sung Hee Cho, WIPO Case No. D2001-1276 (Dec. 20, 2001).

¹¹⁷ Amazon.com, Inc. v. Amazonpic, WIPO Case No. D2002-0330 (July 22, 2002).

¹¹⁸ Amazon.com, Inc. v. Kim Yoon-Jo, WIPO Case No. D2003-0774 (Mar. 2, 2004).

¹¹⁹ Casio Keisanki Kabushiki Kaisha v. Jongchan Kim, WIPO Case No. D2003-0400 (July 15, 2003).

¹²⁰ Minka Lighting, Inc. v. Lee Wongi, WIPO Case No. D2004-0984 (Feb. 22, 2005).

i. RESPONDENT HAS “NO RIGHTS OR LEGITIMATE
INTERESTS IN RESPECT OF THE DOMAIN NAME”

Procedurally, the complainant has the ultimate burden of proving, by a preponderance of the evidence, each of the elements of paragraph 4(a) of the Policy.¹²⁴ But the requisite element relating to the respondent’s rights or legitimate interests in the domain name calls on matters that are “peculiarly within the knowledge of the Respondent” and imposes on the complainant “the [often] impossible task of proving the negative.”¹²⁵ Thus, for purposes of paragraph 4(a)(ii), panels have decided that the complainant satisfies its initial burden by making a *prima facie* case that the respondent lacks a right or interest in the domain name, upon which the burden shifts to the respondent to show that it has such a right or interest.¹²⁶ One panel advised that a

¹²¹ *Hotel Ritz, Ltd. v. Kim Min-Kouk*, WIPO Case No. D2004-0154 (June 23, 2004).

¹²² *Samsung Elecs. Co. v. Pimser Elecs. Ltd.*, WIPO Case No. D2009-1630 (Feb. 16, 2010).

¹²³ *Playboy Enters. Int’l, Inc. v. Sookwan Park*, WIPO Case No. D2001-0778 (Oct. 1, 2001).

¹²⁴ *JJGC Industria E Comercio de Materiais Dentarios S.A. v. Yun-Ki Kim*, WIPO Case No. D2013-1838 (Dec. 20, 2013).

¹²⁵ *IPGM Inst. Mixte de Prévoyance du Groupe Mornay v. Sooyong Kim*, WIPO Case No. D2007-1513 (Mar. 4, 2008) (quoting *Belupo d.d. v. WACHEM d.o.o.*, WIPO Case No. D2004-0110 (Apr. 14, 2004)).

¹²⁶ *Mobile’s Republic v. Kwangpyo Kim*, WIPO Case No. D2014-0089 (Apr. 23, 2014); *Heimbs Kaffee GmbH & Co. KG v. Ho Kyoung Trading Co, Ltd., Heui-il Kang*, WIPO Case No. D2011-1407 (Oct. 17, 2011) (citing *Clerical Medical Inv. Grp. Ltd v. Clericalmedical.com*, WIPO Case No.

prima facie case is made if the complainant shows that “it has not granted any rights to the Respondent, that the Respondent has no links with the Complainant and that the disputed domain name is not the name of the Respondent.”¹²⁷

In practice, in a significant number of UDRP proceedings, the complainant makes a prima facie case in its complaint, and the respondent defaults.¹²⁸ In these circumstances,¹²⁹ the panel must independently determine whether there is sufficient evidence to establish the respondent’s right or legitimate interest. Paragraph 4(c) provides a non-exhaustive list of circumstances in which the respondent may demonstrate “rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

D2000-1228 (Nov. 28, 2000)); *Educ. Testing Serv. v. Hackers Language Inst./David Cho, Ph.D.*, WIPO Case No. D2006-1089 (Nov. 27, 2006).

¹²⁷ *Educ. Testing Serv.*, WIPO Case No. D2006-1089. See *Jet Marques v. Vertical Axis, Inc.*, WIPO Case No. D2006-0250 (May 26, 2006) (quoting *Cassava Enters. Ltd. v. Victor Chandler Int’l Ltd.*, WIPO Case No. D2004-0753 (Nov. 11, 2004)).

¹²⁸ See *supra* note 18.

¹²⁹ In the event of a default, the rules allow the panel to decide the dispute based on the complaint, “[i]n the absence of exceptional circumstances.” UDRP Rules, *supra* note 15, ¶ 5(e). The panel may “draw such inferences therefrom as it considers appropriate.” *Id.* ¶ 14(b).

- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.¹³⁰

As discussed herein, where the respondent was successful in demonstrating a right or legitimate interest in the domain name, it has most frequently been under paragraph 4(c)(i).

Most of the decisions that contain significant discussion of the respondent's right or interest appear to fall in one of two categories. In the first, there is a prior relationship between the complainant and respondent before the dispute emerges. The second includes decisions that involve a domain name (identical or similar to the complainant's mark) that the respondent contends is a generic or descriptive term to which it has a right to use on the Internet. These decisions are addressed in turn.

In *Topfield Co. v. Jai Kemp & Digital Products Group Pty Ltd.*,¹³¹ the Korean complainant had registrations worldwide (including Australia) for the "TOPFIELD" mark, used for television set-top boxes and personal video recorders. The

¹³⁰ UDRP, *supra* note 5, ¶ 4(c).

¹³¹ WIPO Case No. DAU2008-0002 (Apr. 21, 2008).

complainant challenged the Australian respondent's registration and use of the domain names <i-topfield.com.au> and <topfield-australia.com.au>, which the respondent was using for its operations as a local distributor of the complainant. The parties disputed whether there was a termination of the distribution agreement. The panel proceeded on the basis that the distributorship was not terminated. It determined that the active websites for which the domain names were used "were consistent with the legitimate operations of a distributor of the Complainant's products," and thus, there was a bona fide offering of services under paragraph 4(c)(i).¹³²

There was also a relationship of sorts between the parties in *Educational Testing Service v. Hackers Language Institute/David Cho, Ph.D.*¹³³ There, the complainant developed the Test of English for International Communication (TOEIC) and Test of English for Foreign Languages (TOEFL), well-known standardized tests for assessing English language proficiency, and especially familiar to students in Korea who desire to study in the United States. The complainant challenged the respondent's registration of the domain names <hackerstoefl.com> and <hackstoEIC.com>. The respondent claimed trademark rights of its own, from its registration in Korea of "HACKER'S", used for studying methods for the TOEFL and TOEIC tests –

¹³² Regarding the question of whether use by an authorized dealer or reseller is a bona fide offering of goods or services within the meaning of paragraph 4(c)(i), the panel referred to the requirements offered in *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903 (Nov. 6, 2001).

¹³³ WIPO Case No. D2006-1089 (Nov. 27, 2006).

the “Hacker’s Program for the TOEFL Test” and the “Hacker’s Program for the TOEIC Test.”¹³⁴

The panel found that the respondent demonstrated a right or interest in the domain name under paragraph 4(c)(i), stating, “The Respondent has been operating the websites under the disputed domain names for a bona fide offering of goods and services before receiving notification regarding the dispute.”¹³⁵ The panel also commented on the ongoing co-existence between the two parties, noting: “use of these domain names has apparently been tolerated by the Complainant”; and “the Complainant apparently still

¹³⁴ *Id.* The respondent’s argument that it could not offer preparation materials for the TOEFL or TOEIC test “without naming the Complainant’s marks,” *id.*, reminds of the “nominative fair use” defense seen in U.S. trademark law. As Judge Kozinski explained,

[W]here the defendant uses a trademark to describe the plaintiff’s product, rather than its own, we hold that a commercial user is entitled to a nominative fair use defense provided he meets the following three requirements: First, the product or service in question must be one not readily identifiable without use of the trademark; second, only so much of the mark or marks may be used as is reasonably necessary to identify the product or service;[] and third, the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.

New Kids on the Block v. News America Publ’g, Inc., 971 F.2d 302, 308 (9th Cir. 1992) (footnote and citation omitted).

¹³⁵ *Educ. Testing Serv.*, WIPO Case No. D2006-1089. Without referring to paragraph 4(c)(ii), the panel also noted, “The Respondent is commonly known by the disputed domain names, as evidenced by the number of visitors to its websites and the amount of queries for ‘hackers toeic’ and ‘hackers toefl’ in a well-known search engine in the Republic of Korea. Around 64 % of all TOEFL applicants in the Republic of Korea have utilized the ‘Hackers TOEFL’-program.” *Id.*

tolerates the use of its trademarks in combination with the Respondent's trademark as part of the title of the books and programs which the Respondent has published."¹³⁶

There is also a group of decisions in which the panel elaborated on the respondent's right or interest in the domain name, where the respondent contended that the domain name was a generic or descriptive term. These decisions pit the holder of the following marks versus the party that registered the corresponding domain names: "NEWS REPUBLIC" v. <newsrepublic.com>;¹³⁷ "JET TOURS" v. <jettour.com>;¹³⁸ "MORNAY" v. <mornay.com>;¹³⁹ "NURSEFINDERS" v. <nursefinder.com>;¹⁴⁰ and "SHOULDERDOC.CO.UK" v. <shoulderdoc.co.uk>.¹⁴¹

In the dispute over the domain name <newsrepublic.com>, the panel declared that the complainant failed to make even a prima facie case showing that the respondent lacked a right or legitimate interest.¹⁴² But even if the panel were to accept that the complainant established a prima facie case, the panel continued, the

¹³⁶ *Id.*

¹³⁷ *Mobile's Republic v. Kwangpyo Kim*, WIPO Case No. D2014-0089 (Apr. 23, 2014).

¹³⁸ *Jet Marques v. Vertical Axis, Inc.*, WIPO Case No. D2006-0250 (May 26, 2006).

¹³⁹ *IPGM Inst. Mixte de Prévoyance du Groupe Mornay v. Sooyong Kim*, WIPO Case No. D2007-1513 (Mar. 4, 2008).

¹⁴⁰ *Nursefinders, Inc. v. Vertical Axis, Inc.*, WIPO Case No. D2007-0417 (July 5, 2007).

¹⁴¹ *Shoulderdoc Ltd. v. Vertical Axis, Inc.*, WIPO Case No. D2006-0625 (Sept. 8, 2006).

¹⁴² *Mobile's Republic*, WIPO Case No. D2014-0089.

respondent had submitted sufficient evidence to rebut it. The panel explained that “a respondent may have a right to register and use a domain name to attract Internet traffic based on the appeal of a commonly used descriptive term, even when the domain name is confusingly similar or identical to a complainant’s registered mark,” so long as that domain name is registered “because of its attraction as a dictionary word or combination of descriptive terms, and not because of any value corresponding to a trademark; the use of the domain name must also be consistent with its attraction as dictionary words or descriptive terms.”¹⁴³ Here, the panel noted that there was a descriptive nature to the domain name, which incorporates “news” and “republic” (the latter term meaning, when used with another word, “a body of persons freely engaged in a specified activity”).¹⁴⁴ The panel found that the complainant’s use of the website “to gather in one place links to news sites is consistent with the ordinary meanings of the terms combined to form the disputed domain name.”¹⁴⁵ Thus, the use of the domain name was a bona fide offering of goods or services under paragraph 4(c)(i) and confirmed the respondent’s right or interest in the domain name.¹⁴⁶

In the decisions involving <jettour.com>, <mornay.com>, <nursefinder.com>, and

¹⁴³ *Id.*

¹⁴⁴ *Id.* & n.3 (citing Merriam-Webster online dictionary).

¹⁴⁵ *Id.*

¹⁴⁶ *Id.* The panel also noted that the respondent had purchased the disputed domain name from a party that had previously used it for several years for “a website displaying news articles and links to other news services.” *Id.*

<shoulderdoc.co.uk>, the panel in each case, after discussing at length the question of whether the respondent had a right or interest in the domain name, declined to reach a finding on the matter, in light of the panel's instructive determination regarding the bad faith element under paragraph 4(a)(iii).¹⁴⁷ The panel in most of these decisions noted a connection between the second and third elements, specifically, that the question of whether the respondent had a right or interest depends on whether the respondent was aware of the complainant and its mark, which relates to

¹⁴⁷ *Jet Marques v. Vertical Axis, Inc.*, WIPO Case No. D2006-0250 (May 26, 2006) (stating, "There are significant gaps in the evidence provided on this issue by both parties, and the Panel believes that it has insufficient information to make any reliable finding on it. . . . In the end, the Panel is clear in its view that the Complainant has failed to discharge its burden of proving bad faith under Paragraph 4(a)(iii), and it is therefore not necessary to reach a conclusion under Paragraph 4(a)(ii). Accordingly, we make no finding under paragraph 4(a)(ii) of the Policy, and the Complaint falls to be decided under paragraph 4(a)(iii)."); *IPGM Inst. Mixte de Prévoyance du Groupe Mornay v. Sooyong Kim*, WIPO Case No. D2007-1513 (Mar. 4, 2008) (stating, "The Panel finds that whether the second element of the Policy has been met is a fairly close question. . . . [T]he Panel has concluded that the third element of the Policy has not been met. Therefore, the Panel finds that it is not necessary to decide whether the second element has been met."); *Nursefinders, Inc. v. Vertical Axis, Inc.*, WIPO Case No. D2007-0417 (July 5, 2007) (stating, "Because [the question of the respondent's right or interest] goes to the heart of the Complainant's bad-faith argument, it is addressed below in connection with the third UDRP element."); *Shoulderdoc Ltd. v. Vertical Axis, Inc.*, WIPO Case No. D2006-0625 (Sept. 8, 2006) (stating that "it is not necessary in the particular circumstances of this case to make a finding under paragraph 4(a)(ii).").

whether it was acting in good faith (or bad faith).¹⁴⁸ Or as the panel in the <nursefinder.com> decision wrote,

[T]he Respondent's use of the Domain Name would not be deemed to be in connection with a bona fide commercial offering if the evidence indicated that the Respondent selected generic words that were identical or confusingly similar to a trademark of which *the Respondent was or should have been aware*, with the likely effect of misleading Internet users as to the source of the website associated with the Domain Name. . . . Because that question goes to the heart of the Complainant's *bad-faith* argument, it is addressed below in connection with the third UDRP element.¹⁴⁹

ii. DOMAIN NAME "HAS BEEN REGISTERED AND IS BEING USED IN BAD FAITH"

Paragraph 4(a)(iii) of the Policy requires evidence that the domain name "has been registered and is being used in bad faith."¹⁵⁰ Paragraph 4(b) provides,

For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be

¹⁴⁸ *Nursefinders, Inc.*, WIPO Case No. D2007-0417; *Shoulderdoc Ltd.*, WIPO Case No. D2006-0625; *Jet Marques*, WIPO Case No. D2006-0250.

¹⁴⁹ *Nursefinders, Inc.*, WIPO Case No. D2007-0417 (emphasis added) (citations omitted).

¹⁵⁰ UDRP, *supra* note 5, ¶ 4(a)(iii).

present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of

your web site or location or of a product or service on your web site or location.¹⁵¹

An aside here. Precisely what is required to satisfy the bad faith element under paragraph 4 of the Policy has been a subject of much discussion by UDRP panels. Some panelists, emphasizing the “conjunctive” phrasing of paragraph 4(a)(iii) (“registered *and* is being used”), have declared that the provision requires *both* bad faith registration *and* bad faith use.¹⁵² Therefore, under this approach, if either bad faith registration or bad faith use is absent, then this requisite element is not met, and the complaint must be denied.¹⁵³ But other panelists emphasize the prefatory language of paragraph 4(b) (“*For the purposes of Paragraph 4(a)(iii), the following circumstances . . . shall be evidence of the registration and use . . . in bad faith*”) to conclude that evidence demonstrating the presence of any of the four non-

¹⁵¹ *Id.* ¶ 4(b).

¹⁵² *E.g.*, Strongarm Designs, Inc. v. Arisu Tech, WIPO Case No. D2001-0776 (Sept. 17, 2001). *See* Heimbs Kaffee GmbH & Co. KG v. Ho Kyoung Trading Co, Ltd., Heui-il Kang, WIPO Case No. D2011-1407 (Oct. 17, 2011) (stating that “the Complainant must prove that both registration and use of the disputed domain name are in bad faith”); VoiceStream Wireless Corp. v. Hanjin Ko, WIPO Case No. D2001-1411 (Mar. 25, 2002) (referring to “twin requirements of paragraph 4(a)(iii) of the Policy”).

¹⁵³ *E.g.*, Reckitt Benckiser Plc v. Eunsook Wi, WIPO Case No. D2009-0239 (May 20, 2009). Or put another way, if either bad faith registration or bad faith use is absent, then it is dispositive, and it is not necessary for the panel to address the other. IPGM Inst. Mixte de Prévoyance du Groupe Mornay v. Sooyong Kim, WIPO Case No. D2007-1513 (Mar. 4, 2008) (noting absence of bad faith registration, which was dispositive); Protosoftware, Inc. v. Vertical Axis, Inc., WIPO Case No. D2006-0905 (Oct. 10, 2006) (same).

exhaustive examples (incidentally, three of which refer to registration and one to use) is sufficient to satisfy the requisite element in paragraph 4(a)(iii).¹⁵⁴ Some panelists ultimately place themselves in the latter camp, when they

¹⁵⁴ Panelist Sally M. Abel addressed this point in a decision outside of the 58 decisions herein, in which she stated:

The Policy speaks for itself. While Paragraph 4(a)(iii) of the Policy requires that the Complainant prove that the 'domain name has been registered and is being used in bad faith,' that requirement is further illuminated by the language of Paragraph 4(b) addressing 'Evidence of Registration and Use in Bad Faith'. Paragraph 4(b) expressly delineates four, each free-standing, examples of what a panel may find to be 'evidence of the registration and use of a domain name in bad faith' but first underscores that these examples are not the exclusive basis for finding registration and use in bad faith Thus the Policy contemplates that the circumstances of bad faith registration and use presented in particular cases will not necessarily fall neatly into one or more of the four examples contained in the Policy, but are helpful guideposts for panels considering unique sets of facts as to the type of behavior the Policy is intended to address.

Dean Hill Sys. Ltd. v. Gregory Santana, WIPO Case No. D2002-0404 (Sept. 20, 2002) (citing American Mensa, Ltd. v. Millennium Energy Niche Studies Associative, WIPO Case No. D2000-1030 (Jan. 26, 2001)) (Abel, Pan., concurring).

Within the 58 decisions, some panels have found bad faith registration and use under paragraph 4(a)(iii) based on *one* example provided in paragraph 4(b). *E.g.*, Deutsche Lufthansa AG v. [] Kwangpyo Kim, WIPO Case No. D2013-1844 (Jan. 22, 2014); Minka Lighting, Inc. v. Lee Wongi, WIPO Case No. D2004-0984 (Feb. 22, 2005) (finding bad faith in paragraph 4(b)(iv)); NHN Corp. v. NHN Corp., WIPO Case No. D2003-0939 (Feb. 27, 2004) (paragraph 4(b)(i)).

begin with the statement that paragraph 4(a)(iii)'s "requirement is conjunctive, and therefore the Complainant must establish both bad faith registration and bad faith use," but then add, "For purposes of the Policy, a finding of any of the circumstances listed in Paragraph 4(b) will be sufficient to establish registration and use in bad faith."¹⁵⁵ The debate over the interpretation of paragraph 4(a)(iii) continues for UDRP panelists, and has seen lively and innovative arguments.¹⁵⁶ The split is not addressed directly in WIPO's

¹⁵⁵ Amazon.com, Inc. v. Kim Yoon-Jo, WIPO Case No. D2003-0774 (Mar. 2, 2004) (citations omitted). See Esquire Innovations, Inc. v. [] Vertical Axis, Inc., WIPO Case No. D2007-0856 (Oct. 5, 2007).

¹⁵⁶ Panelist Tony Willoughby offered a comprehensive discussion of the matter in *Camon S.p.A. v. Intelli-Pet, LLC*, WIPO Case No. D2009-1716 (Mar. 12, 2010). There, he discussed, among much more, the significance in the phrasing of the prefatory language in paragraph 4(b) ("the following circumstances . . . shall be evidence of the registration and use of a domain name in bad faith") (emphasis added) in contrast to that of paragraph 4(c) ("the following circumstances . . . shall demonstrate your rights or legitimate interests to the domain name") (emphasis added). Another decision of interest is *Guru Denim Inc. v. Ibrahim Ali Ibrahim Abu-Harb*, WIPO Case No. D2013-1324 (Sept. 27, 2013), where the majority of the panel, in denying the complaint due to the absence of bad faith registration, began the discussion regarding the bad faith element:

There are broadly two views of the interpretation of the requirements for bad faith under the third element of the Policy, namely the "unitary" and the "conjunctive" views. . . . Suffice it to say here that the majority subscribes to the "conjunctive" view or in other words that the plain literal meaning of the third element of the Policy is that both registration and use in bad faith must be found individually before the requirements of that element are fulfilled.

overview of panel decisions on common issues, and no consensus view is identified.¹⁵⁷ In all events, the 58 decisions herein include examples of both approaches to the application and interpretation of paragraph 4(a)(iii) (and 4(b)).¹⁵⁸

Id. The dissenting panelist disagreed that “the plain literal meaning of the third element” required a finding of both registration and use in bad faith individually, and also urged,

The majority sets up a dispute that does not exist between the majority and minority view. The minority view has never contended that one need only prove bad faith registration or bad faith use. That would be a conflict between a conjunctive and disjunctive view, a view which the minority has never held. Rather the dispute is that the majority treats bad faith registration and use as a binary concept. One must separately prove bad faith registration, th[e]n separately prove bad faith use. Under the majority view one must prove one plus one. The minority view treats bad faith registration and use as a unitary concept. One is required to prove that under all the facts and circumstances that the respondent is acting in bad faith by intending to profit from the good will developed in the complainant’s trademark. There is no arithmetical calculation required.

Id. (Donahey, Pan., dissenting). The decision has received attention in recent cases. *Cyberlaw*, *supra* note 34, at 2130 (noting, “it is important to supplement the majority opinion with a robust policy defense”).

¹⁵⁷ See WIPO Overview 2.0, *supra* note 26.

¹⁵⁸ Compare *Heimbs Kaffee GmbH & Co. KG v. Ho Kyoung Trading Co, Ltd., Heui-il Kang*, WIPO Case No. D2011-1407 (Oct. 17, 2011) (requiring proof of “both registration and use of the disputed domain name are in bad faith”) with *Esquire Innovations, Inc.*, WIPO Case No. D2007-0856 (stating “any one” of four circumstances in Paragraph 4(b) of Policy

There is universal agreement that bad faith on the part of the respondent for purposes of paragraph 4(a)(iii) presumes that the respondent was aware of the complainant, the owner of a protected mark.¹⁵⁹ The examples provided in paragraph 4(b) support this point. The respondent is presumed to have knowledge of the owner of the mark (i) to whom it intends to sell the domain name, (ii) to prevent the owner from reflecting the mark in a corresponding domain name, (iii) to disrupt the business of the owner, a competitor, or (iv) to attract Internet users by creating a likelihood of confusion with the owner's mark.

One question that arises in this context is whether the doctrine of constructive notice seen in U.S. trademark law is adopted in UDRP proceedings. The Lanham Act provides: "Registration of a mark on the principal register . . . shall be constructive notice of the registrant's claim of ownership thereof."¹⁶⁰ But UDRP panels "have generally declined to adopt the United States doctrine of constructive notice to the bad faith requirement."¹⁶¹ Thus, there must be evidence that the "domain name registrant was actually aware of the complainant and its mark and selected the domain name to take some advantage of the mark and any good will attached

"shall be evidence of the registration and use of a domain name in bad faith").

¹⁵⁹ HSM Argentina S.A. v. Vertical Axis, Inc., WIPO Case No. D2007-0017 (May 1, 2007); Shoulderdock Ltd. v. Vertical Axis, Inc., WIPO Case No. D2006-0625 (Sept. 8, 2006); Jet Marques v. Vertical Axis, Inc., WIPO Case No. D2006-0250 (May 26, 2006).

¹⁶⁰ 15 U.S.C. § 1072 (2016).

¹⁶¹ JJGC Industria E Comercio de Materiais Dentarios S.A. v. Yun-Ki Kim, WIPO Case No. D2013-1838 (Dec. 20, 2013).

to it,"¹⁶² or "facts that might support an inference of knowledge."¹⁶³

Turning to the decisions where the panel found the bad faith element to be satisfied,¹⁶⁴ the most common basis is the respondent's attempt to attract Internet users to its website by creating a likelihood of confusion with the complainant's mark, under paragraph 4(b)(iv).¹⁶⁵ This is frequently seen in cases where the disputed domain name resolves to a website whose content includes text or links relating to the complainant's services or products,¹⁶⁶ its

¹⁶² *Id.*

¹⁶³ *Id.* As another observed, "Rarely, if ever, will there be direct proof that a respondent was fully aware of a complainant's trademark rights and intentionally registered a disputed domain name in bad faith. And so it is not surprising that a respondent may assert ignorance of a complainant's trademark rights. Accordingly, a panel must always look to the circumstantial evidence in making this determination." *Deutsche Telekom AG v. Unitedeurope Consulting*, WIPO Case No. D2006-0930 (Dec. 27, 2006).

¹⁶⁴ Panels often identify which of the four examples in paragraph 4(b) are present. In some decisions, a finding of bad faith is based on multiple examples provided in paragraph 4(b). *Esquire Innovations, Inc.*, WIPO Case No. D2007-0856 (finding bad faith under paragraph 4(b)(i), (ii), & (iv)); *Chivas Bros. Ltd. v. Anyweb Co.*, WIPO Case No. D2006-1446 (Feb. 2, 2007) (same); *Groupe Canal+ Co. v. Jinsoo Yoon*, WIPO Case No. D2006-1240 (Dec. 26, 2006) (same); *Carfax, Inc. v. COMn.COM*, WIPO Case No. D2002-0513 (Sept. 18, 2002) (same).

¹⁶⁵ *E.g.*, *Deutsche Lufthansa AG v. [J] Kwangpyo Kim*, WIPO Case No. D2013-1844 (Jan. 22, 2014); *Hertz Sys., Inc. v. Jeff Park*, WIPO Case No. D2007-1120 (Nov. 9, 2007); *Amazon.com, Inc. v. Amazonpic*, WIPO Case No. D2002-0330 (July 22, 2002) (2-1 decision).

¹⁶⁶ *E.g.*, *Knowland Grp. v. Trademark Mgmts.*, WIPO Case No. D2011-1005 (Aug. 26, 2011) (noting respondent's "website . . . contained a number of links to goods and services related to the software and

competitors, or sometimes more brazenly, the complainant directly.¹⁶⁷ Illustrative is *Tokyu Corp. v. Jeongyong Cho*, where the complainant, Tokyu Group, “one of the leading enterprise groups in Japan,” operated “a wide variety of hotel businesses, and [was] expanding in the various forms of hotels, as symbolized by the opening of new ‘The Capitol Hotel Tokyu.’”¹⁶⁸ The respondent registered the domain name <capitoltokyu.com>, which resolved to a website that featured hotels in Japan.¹⁶⁹ The panel concluded that the respondent intended to cause confusion with respect to the source of the products or services in the website, “as well as the sponsorship and capital or business tie-up with the Complainant and the Tokyu Group, leading customers to believe that the Respondent is affiliated with the Complain[an]t, and gaining commercial profits by using the Domain Name.”¹⁷⁰

business solution, in connection with which the Complainant has consistently used the KNOWLAND Mark since 2004.”); *Casio Keisanki Kabushiki Kaisha v. Jongchan Kim*, WIPO Case No. D2003-0400 (July 15, 2003) (stating, “Respondent, by using the disputed domain name to lead to a website promoting, for commercial gain, goods identical with the designated goods of the Complainant’s trademark, has intentionally sought to confuse internet users as to the source, sponsorship, affiliation or endorsement of his website.”).

¹⁶⁷ *Amazon.com, Inc. v. Kim Yoon-Jo*, WIPO Case No. D2003-0774 (Mar. 2, 2004) (stating, “Respondent’s bad faith registration and use of the <amazonfire.com> domain name can be inferred from Respondent’s inclusion of the entire AMAZON.COM trademark in the <amazonfire.com> Domain Name . . .”).

¹⁶⁸ WIPO Case No. D2008-1407 (Dec. 28, 2008).

¹⁶⁹ *Id.*

¹⁷⁰ *Id.*

Bad faith is also frequently found when the respondent attempts to sell the domain name to the complainant or the complainant's competitor at a high(er) price, under paragraph 4(b)(i)), an example of classic cybersquatting. For example, in *Playboy Enterprises International, Inc. v. Sookwan Park*,¹⁷¹ the Korean respondent registered the domain name <playboysportsbooks.com> days after the complainant announced its intention to operate an online sports wagering site at <playboysportsbook.com>. According to the complainant, the respondent then contacted the complainant and requested a payment of \$1,000 for the transfer of the domain name. The panel found that this was an offer to sell the domain name for an amount in excess of out-of-pocket expenses, under paragraph 4(b)(i).¹⁷²

A finding of bad faith under paragraph 4(b)(ii), wherein the respondent is found to have engaged in a pattern of registering domain names in order to prevent the owner of the mark "from reflecting the mark in a corresponding domain name," is less frequent in the UDRP resolutions. Among the 58 decisions herein, the only decision in which this element was the sole basis for a finding of bad faith is *Sony Kabushiki Kaisha v. Sin, Eonmok*, which involved the domain name <mysony.com>.¹⁷³ The panel found that in addition to this domain name, the respondent had previously registered numerous other domain names that incorporated the complainant's "SONY"

¹⁷¹ WIPO Case No. D2001-0778 (Oct. 1, 2001).

¹⁷² *Id.*

¹⁷³ WIPO Case No. D2000-1007 (Nov. 16, 2000).

mark, all without the complainant's authorization.¹⁷⁴ Bad faith may also be found under paragraph 4(b)(iii), where the respondent registered the domain name "primarily for the purpose of disrupting the business of a competitor."¹⁷⁵ There is no decision from the 58 decisions in which bad faith was found under this provision alone.¹⁷⁶

As noted above, the list of circumstances indicating bad faith in paragraph 4(b) is not exhaustive. Panels have relied on other factors to satisfy the bad faith element. For example, in a decision involving the disputed domain name <sony.net>,¹⁷⁷ the panel initially concluded that there was no evidence to support any of the criteria set out in paragraph 4(b). Emphasizing that the provision's list is non-exhaustive, the panel stated,

The Domain Name can only sensibly refer to the Complainant, there is no obvious possible justification for the Respondent's selection of

¹⁷⁴ These domain names included: <calsony.com>; <hotsony.com>; <mildsony.com>; <onytour.com>; <sonycall.com>; <sonyfashion.com>; <sonyfund.com>; <sonym.com>; <sonymild.com>; <sonymotors.com>; <sonyms.com>; <sonyn.com>; <sonypresents.com>; <sonyshow.com>; <sonystock.com>; <sonystocks.com>; <sony7.com>; <sony77.com>; <sony777.com>; <sunsony.com>. The panel also noted that the respondent registered over other 2,000 domain names, incorporating well-known trademarks such as "HYUNDAI", "LPGA", "NASDAQ", "NFL", and "SAMSUNG". *Id.*

¹⁷⁵ UDRP, *supra* note 5, ¶ 4(b)(iii).

¹⁷⁶ But examples involving non-Korean parties are available. *E.g.*, Diebold, Inc. v. Paul Terwilliger, WIPO Case No. D2003-0416 (July 15, 2003); Carpetright PLC v. Carpets Direct, WIPO Case No. D2001-0287 (Apr. 26, 2001).

¹⁷⁷ Sony Kabushiki Kaisha v. sony.net, WIPO Case No. D2000-1074 (Nov. 28, 2000).

the Domain Name, the Respondent has not sought to put before the Panel any justification for its selection of the Domain Name and it is difficult to conceive of any use of the Domain Name, which will not be likely to cause confusion of some kind. In the Panel's view the threat that such use may be made of the Domain Name constitutes use in bad faith.¹⁷⁸

¹⁷⁸ *Id.* The decisions also include discussion of other circumstances that may constitute bad faith for purposes of paragraph 4 of the Policy, and the views therein indicate the range of discretion that a panel may exercise in its findings. One panel declared that the respondent's use of a privacy service to shield its identity was not "evidence in itself of bad faith." *Bright Horizons Family Solutions Inc. v. Vertical Axis, Inc.*, WIPO Case No. D2007-0795 (Oct. 12, 2007). But another stated that the respondent's "attempts to conceal its true identity are further evidence of its bad faith." *United Airlines, Inc. v. United Airline Dot.Com*, WIPO Case No. D2002-0835 (Nov. 9, 2002). The panel in *Bright Horizons Family Solutions Inc.* denied the complaint; in *United Airlines, Inc.*, the panel ordered the transfer of the domain name.

The respondent's failure to reply to the complainant's cease and desist letter "may in some circumstances be relevant to" registration and use in bad faith. *Bright Horizons Family Solutions Inc.*, WIPO Case No. D2007-0795. "For example, it could undermine the credibility of an explanation proffered at a later stage which one might have expected to have been given earlier, if true." *Id.* Ultimately, the panel in *Bright Horizons Family Solutions Inc.* determined that the respondent's failure to reply was not a sufficient ground for a finding of bad faith. In another decision, the respondent transferred the domain name to a Korean language registrar after the respondent became aware of the complainant, in an apparent attempt to change the language of the proceeding from English to Korean. The panel described such conduct as "improper" and "suggestive of bad faith with regard to the conduct of these proceedings," but "not sufficient by itself, to show that the Domain

B. A MINORITY OF DECISIONS: COMPLAINT IS DENIED,
RESPONDENT KEEPS THE DOMAIN NAME (AND SOMETIMES
GETS FINDING OF COMPLAINANT BAD FAITH)

Of the 58 decisions that are included in this study, the panel denied the complaint in twenty-one of them, thus allowing the respondents to keep twenty-nine of the eighty-one subject domain names,¹⁷⁹ for a rate of over 35%.¹⁸⁰ This percentage (albeit taken from a small sample) is significantly higher than that seen in WIPO-administered UDRP decisions overall – less than 13%.¹⁸¹ Under paragraph 4(a) of the Policy, the panel must deny the complainant's request for relief when any of the three elements of paragraph 4(a) is not established.¹⁸² The previous discussion referred to some

Name was registered in bad faith." IPGM Inst. Mixte de Prévoyance du Groupe Mornay v. Sooyong Kim, WIPO Case No. D2007-1513 (Mar. 4, 2008).

¹⁷⁹ Some decisions involved more than one domain name; the complaint was denied with respect to some names, but not in others. See Appendix.

¹⁸⁰ The rate of decisions in favor of the respondent for all WIPO-administered decisions involving Korean parties (whether decided by a sole or three-member panels) is 10.1%. See Lee, *supra* note 18, at 310.

¹⁸¹ See WIPO Case Outcomes, *supra* note 12.

¹⁸² In some of the twenty-one proceedings, the panel based its decision on the absence of one of the elements, stating that it was unnecessary to decide one or both of the other elements. *E.g.*, UTV Ltd. v. Unitedeuropa Consulting, Kwang Pyo Kim, WIPO Case No. D2011-2293 (Mar. 5, 2012) (stating unnecessary to decide paragraph 4(a)(iii), in light of dispositive decision on paragraph 4(a)(ii)); Reckitt Benckiser Plc v. Eunsook Wi,

of the decisions in which the complaint was denied due to the complainant's failure to establish rights in its purported mark (paragraph 4(a)(i)) or failure to show that the respondent lacked a right or interest in the domain name (paragraph 4(a)(ii)).¹⁸³ In most of the decisions in which the complaint was denied, thus allowing the respondent to keep the domain name, the lack of the bad faith element proved fatal for the complainant. This section discusses the illustrative bad faith decisions, and the common reasons for the denial of the complaint under paragraph 4(a)(iii).

One example of a case that lacks bad faith is where the disputed domain name is registered *before* the complainant obtains rights in a mark. In such an instance, the respondent could not have been aware of the complainant's mark, or have an intent to capitalize on it. Thus, in *Protosoftware, Inc. v. Vertical Axis, Inc.*,¹⁸⁴ where the respondent registered the domain name <proto.com> three years before the complainant registered the "PROTO" mark, and four years before it first used this mark in commerce, the panel found the bad faith element missing and denied the complaint. The same result occurred in *Deutsche Telekom AG v. Unitedeurope Consulting*, where the panel found that the

WIPO Case No. D2009-0239 (May 20, 2009) (stating unnecessary to decide paragraph 4(a)(ii), in light of dispositive decision on paragraph 4(a)(iii)); *Protosoftware, Inc. v. Vertical Axis, Inc.*, WIPO Case No. D2006-0905 (Oct. 10, 2006) (stating unnecessary to decide paragraph 4(a)(i) or (ii), in light of dispositive decision on paragraph 4(a)(iii)).

¹⁸³ *IPGM Inst. Mixte de Prévoyance du Groupe Mornay*, WIPO Case No. D2007-1513.

¹⁸⁴ WIPO Case No. D2006-0905.

respondent registered the domain names <t-health.com>, <t-portal.com>, and <t-sales.com>, before the complainant filed applications for registration of its corresponding trademarks, “T-HEALTH”, “T-PORTAL”, and “T-SALES”.¹⁸⁵

Nearly half of the 58 decisions in which the complaint was denied, and almost all of the decisions where the lack of the bad faith element was dispositive, involve a domain name that the respondent urged was generic or descriptive in nature: <allegretto.com>,¹⁸⁶ <brighthorizon.com>,¹⁸⁷ <jettour.com>,¹⁸⁸ <mornay.com> (“meaning a white sauce”),¹⁸⁹ <neodent.com>,¹⁹⁰ <newsrepublic.com>,¹⁹¹ <nursefinder.com>,¹⁹² and <shoulderdoc.com>.¹⁹³ From these decisions, common themes emerge relating to whether the respondent was aware of the complainant or its mark at the time the respondent registered the domain name. Specifically, the panel noted that the complainant’s mark

¹⁸⁵ WIPO Case No. D2006-0930 (Dec. 27, 2006).

¹⁸⁶ Heimbs Kaffee GmbH & Co. KG v. Ho Kyoung Trading Co, Ltd., Heui-il Kang, WIPO Case No. D2011-1407 (Oct. 17, 2011).

¹⁸⁷ Bright Horizons Family Solutions Inc. v. Vertical Axis, Inc., WIPO Case No. D2007-0795 (Oct. 12, 2007).

¹⁸⁸ Jet Marques v. Vertical Axis, Inc., WIPO Case No. D2006-0250 (May 26, 2006).

¹⁸⁹ IPGM Inst. Mixte de Prévoyance du Groupe Mornay v. Sooyong Kim, WIPO Case No. D2007-1513 (Mar. 4, 2008).

¹⁹⁰ JJGC Industria E Comercio de Materiais Dentarios S.A. v. Yun-Ki Kim, WIPO Case No. D2013-1838 (Dec. 20, 2013).

¹⁹¹ Mobile’s Republic v. Kwangpyo Kim, WIPO Case No. D2014-0089 (Apr. 23, 2014).

¹⁹² Nursefinders, Inc. v. Vertical Axis, Inc., WIPO Case No. D2007-0417 (July 5, 2007).

¹⁹³ Shoulderdoc Ltd. v. Vertical Axis, Inc., WIPO Case No. D2006-0625 (Sept. 8, 2006).

was not particularly distinctive or well-known or had wide reputation;¹⁹⁴ the complainant's rights in the mark was limited to its own country or nearby region, and did not extend to the respondent's Korea;¹⁹⁵ and the respondent had a plausible reason for registering the domain name.¹⁹⁶

¹⁹⁴ *JJGC Industria E Comercio de Materiais Dentarios S.A.*, WIPO Case No. D2013-1838 (stating, "[T]he Panel finds that the Complainant's marks are not fanciful and not marks known widely as unique to its owner (such as YAHOO or EXXON) but rather an obvious abbreviation for 'New dental' in English."); *IPGM Inst. Mixte de Prévoyance du Groupe Mornay*, WIPO Case No. D2007-1513 (stating, "Complainant is not so famous, nor is its MORNAY mark so arbitrary, that the Panel can in the circumstances of this case assume knowledge of Complainant's name and mark."); *Bright Horizons Family Solutions Inc. v. Vertical Axis, Inc.*, WIPO Case No. D2007-0795 (Oct. 12, 2007) (stating, "The Complainants have provided no evidence of the nature or extent of their reputation under the mark . . ."); *Nursefinders, Inc.*, WIPO Case No. D2007-0417 (stating that "the mark is inherently descriptive, being comprised of common English words"); *Shoulderdoc Ltd.*, WIPO Case No. D2006-0625 (referring to mark's "relative lack of distinctiveness" and "descriptive nature"); *Jet Marques v. Vertical Axis, Inc.*, WIPO Case No. D2006-0250 (May 26, 2006) (stating that "there is no evidence of the reputation of the mark extending to [Korea]" and "[t]he mark may be well known to professionals in the travel industry in countries outside Europe, but there is no evidence that the Respondent falls into that category.").

¹⁹⁵ *JJGC Industria E Comercio de Materiais Dentarios S.A.*, WIPO Case No. D2013-1838 (stating, "The Complainant provides no evidence that the Respondent, who does business only in the Republic of Korea, knew of the Complainant or its NEODENT marks when the Respondent registered the disputed domain name . . ."); *Nursefinders, Inc.*, WIPO Case No. D2007-0417 (stating that "the Complainant's mark has demonstrably acquired a distinctive secondary meaning only in the United States where there Respondent is not located"); *Jet Marques*, WIPO Case No. D2006-0250 (stating, "The mark is registered only in Europe. The Respondent appears to be a domain name professional

An illustrative decision incorporating these points is seen in the proceeding involving the domain name <allegretto.com>.¹⁹⁷ There, the complainant, a German coffee roaster, commenced a UDRP proceeding against a Korean manufacturer of “underwear, garments, baby garments,” and other products.¹⁹⁸ The respondent argued that it had never heard of the complainant or its trademark “ALLEGRETTO” before the dispute, and that the term is a common dictionary word meaning “fairly quickly or briskly,” which the respondent learned when in middle school.¹⁹⁹ The panel agreed with the respondent’s characterization of the domain name as a “‘dictionary’ term” and that “‘allegretto’ is not the kind of word/trademark that can be said to be obviously related to one specific company or goods/services.”²⁰⁰ The panel also noted that at the time

based in the Republic of Korea, and possibly with business interests in the United States. There is no evidence of the Respondent carrying on business in Europe, and no other reason to conclude that the Respondent’s residence or place of business would, in the ordinary course of things, have made it aware of the mark.”).

¹⁹⁶ *Jet Marques*, WIPO Case No. D2006-0250 (stating that “it is therefore plausible that the Respondent may have chosen the Domain Name for no better reason than that it was a relatively short, common word English expression which had recently become available and was thought to have some value.”).

¹⁹⁷ *Heimbs Kaffee GmbH & Co. KG v. Ho Kyoung Trading Co, Ltd., Heui-il Kang*, WIPO Case No. D2011-1407 (Oct. 17, 2011).

¹⁹⁸ *Id.*

¹⁹⁹ *Id.*

²⁰⁰ *Id.* In assessing whether the complainant’s mark is famous, well-known, arbitrary, or distinctive, the panel may resort to Internet search engines. *IPGM Inst. Mixte de Prévoyance du Groupe Mornay v. Sooyong*

of the domain name's registration, the complainant had only German trademarks, and that there was no evidence that the mark was well-known outside of Deutschland. In these circumstances, where "the respondent has a good faith belief that the domain name's value derives from its generic or descriptive qualities, rather than its specific trademark value, the use of the domain name consistent with such good faith belief may be considered use in good faith."²⁰¹

Kim, WIPO Case No. D2007-1513 (Mar. 4, 2008) (stating, "When the Panel recently conducted a search for MORNAY on 'www.google.com' or 'www.google.co.kr' from the United States of America[], there was no reference to Complainant in the first ten pages of results.").

²⁰¹ *Heimbs Kaffee GmbH & Co. KG*, WIPO Case No. D2011-1407 (citing *Mobile Commc'n Serv. Inc. v. WebReg, RN*, WIPO Case No. D2005-1304 (Feb. 24, 2006); *Media Gen. Commc'ns, Inc. v. Rarenames, WebReg*, WIPO Case No. D2006-0964 (Sept. 23, 2006)). In the *Heimbs Kaffee GmbH & Co. KG* decision, there appears a description of the respondent's action four days after the complainant filed the complaint,

The Panel notes that the Respondent filed the Korean national trademark application for ALLEGRETTO (fig) in Class 35 on August 23, 2011, the same day as the Respondent also transferred <allegretto.com> to a new Registrar. The Panel cannot draw any other conclusion than these actions, initiated after the date of the filing of the Complaint, were not basically done as a result of the Respondent[']s serious business activities but rather indicating a goal to make a dispute resolution case more difficult to handle for the Complainant (in particular related to the language of the proceedings).

Heimbs Kaffee GmbH & Co. KG, WIPO Case No. D2011-1407. The above discussion precedes the panel's finding that the respondent had no right or legitimate interest in the domain name. The panel did not address it in the context of the respondent's bad faith. Instead, the panel found that

For many of the same reasons seen in the cases involving a generic or descriptive term or phrase discussed above, panels have found that bad faith was not established in cases involving a domain name with two or three letter acronyms or abbreviations: <hsm.com>²⁰² and <rb.net>.²⁰³ In both cases, the panel found that the complainant satisfied the requirement under paragraph 4(a)(i) that it had rights (through use, registration, or both) in the mark to which the domain name was identical or confusingly similar: “HSM” (along with “HSMONLINE”, “HSMEDUCATION”, and “HSM MANAGEMENTV”) for services “in the field of executive education”;²⁰⁴ and “RB” (the two letters resulting from “the merger of the UK Company Reckitt & Colman plc and the Dutch group Benckiser N.V.”²⁰⁵) for “commercial activities in the household, health care and personal care sectors.”²⁰⁶ (The complaint in a third case, involving the domain name <utv.com> and the corresponding mark “UTV” (originating from Ulster Television) for “television and radio broadcasting services and entertainment,” among others, was denied not under the bad faith element, but due

the complainant failed to prove both bad faith registration and bad faith use, and denied the complaint.

²⁰² *HSM Argentina S.A. v. Vertical Axis, Inc.*, WIPO Case No. D2007-0017 (May 1, 2007).

²⁰³ *Reckitt Benckiser Plc v. Eunsook Wi*, WIPO Case No. D2009-0239 (May 20, 2009).

²⁰⁴ *HSM Argentina S.A.*, WIPO Case No. D2007-0017.

²⁰⁵ *Reckitt Benckiser Plc*, WIPO Case No. D2009-0239 (emphasis added).

²⁰⁶ *Id.*

to the respondent's right or legitimate interest in the domain name.²⁰⁷)

In all three of the decisions, the panel determined that there was no evidence to show that the respondent was aware of the complainant at the time of the domain name registration,²⁰⁸ and noted the related points of the complainant's weak or unknown mark,²⁰⁹ the geographic

²⁰⁷ UTV Ltd. v. Unitedeurope Consulting, Kwang Pyo Kim, WIPO Case No. D2011-2293 (Mar. 5, 2012).

²⁰⁸ *Id.*; *Reckitt Benckiser Plc*, WIPO Case No. D2009-0239; *HSM Argentina S.A.*, WIPO Case No. D2007-0017.

²⁰⁹ *UTV Ltd.*, WIPO Case No. D2011-2293 (stating, "The Panel did, however, not find any evidence in support of the Complainant's allegations of the Trademark's strong reputation"; "[t]he disputed domain name typically is such a short term which may represent many acronyms."; and "the disputed domain name is merely a generic short acronym in which the Respondent has a legitimate interest to use."); *Reckitt Benckiser Plc*, WIPO Case No. D2009-0239 (stating, "'RB' has, as most other two-letter-acronyms, various meanings and is not only referring to the Complainant."; "proof has not been established that the Complainant itself, as a company, is well-known under the acronym 'RB' (the website at '<http://en.wikipedia.org/wiki/RB>', providing information on different meanings of 'RB', does not mention the Complainant)."); *HSM Argentina S.A.*, WIPO Case No. D2007-0017 (stating, "This evidence suggests that the combination of the letters 'hsm' may have a number of potential associations, unconnected with the Complainant."; "the Panel stops short of finding that the Complainant or its marks are famous. The Complainant appears to be well-known in its field. But that field ('executive education') appears specific and defined. The Panel does not make the finding that the Complainant was, when the disputed domain name was registered, so generally well-known that the Respondent must have been aware of it.").

separation of the complainant from Korea,²¹⁰ and a plausible reason for the respondent registering the domain name.²¹¹

In a UDRP proceeding, the successful complainant receives a panel decision directing cancellation of the disputed domain name or its transfer to the complainant. For the respondent, a denial of the complaint is the only result in its favor. In certain circumstances, however, the panel may issue a further vindication of the respondent and an affirmative rebuke against the complainant. “Reverse domain name hijacking” is defined under the UDRP Rules

²¹⁰ *UTV Ltd.*, WIPO Case No. D2011-2293 (stating, “This could have been different if the Complainant’s claim that that the Trademark has a strong reputation and is widely known outside the (Northern) Ireland region, and – as the Complainant implied – more particularly in Republic of Korea where the Respondent is located . . . is true, as in such case the Respondent would have registered and used the disputed domain name with the actual knowledge of the Trademark and may have been using the disputed domain name in bad faith.”; “the Panel is of the opinion that the Respondent who is located in Republic of Korea cannot reasonably be expected to have knowledge of the Trademark which has only been used in United Kingdom and Ireland.”); *Reckitt Benckiser Plc.*, WIPO Case No. D2009-0239 (stating, “The Complainant has neither demonstrated business activities in the Republic of Korea in the year 2000, when the disputed domain name was registered, nor contended that it was well known in the Republic of Korea then”); *HSM Argentina S.A.*, WIPO Case No. D2007-0017 (stating, “[T]he Respondent is resident in the Republic of Korea, while the Complainant is based in Argentina and its marks are registered principally in the Americas and the EU. The Complainant did not provide evidence of operating or having registered marks in the Republic of Korea.”).

²¹¹ *UTV Ltd.*, WIPO Case No. D2011-2293 (stating, “The disputed domain name typically is such a short term which may represent many acronyms.”; “the disputed domain name is merely a generic short acronym in which the Respondent has a legitimate interest to use.”).

as “using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name.”²¹² Another provision of the rules elaborates on the panel’s authority to make a finding of reverse domain name hijacking (and re-emphasizes the bad faith component):

If after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.²¹³

In contrast to bad faith on the part of the respondent under paragraph 4(a)(iii) of the Policy, with non-exhaustive examples provided in paragraph 4(b), neither the Policy nor the UDRP Rules offer any further guidance on the

²¹² UDRP Rules, *supra* note 15, ¶ 1.

²¹³ *Id.* ¶ 15(e). Perhaps the respondent’s request for a finding of reverse domain name hijacking in a UDRP proceeding is the closest equivalent to the defendant’s counterclaim in a civil action. One panel noted that the respondent has the burden of proving bad faith in the filing of the complaint. *Protosoftware, Inc. v. Vertical Axis, Inc.*, WIPO Case No. D2006-0905 (Oct. 10, 2006). If reverse domain name hijacking is a sanction against the complainant, it is a symbolic one. Another panel stated, “As the Rules do not provide for monetary remedies or specific relief in such a case [as described in paragraph 15(e)], a finding of reverse domain name hijacking would be of limited value to the Respondent.” *Nursefinders, Inc. v. Vertical Axis, Inc.*, WIPO Case No. D2007-0417 (July 5, 2007).

complainant's bad faith in bringing a complaint for purposes of a reverse domain name hijacking determination. Panels have stated that a finding of reverse domain name hijacking is warranted when "the complainant in fact knew or clearly should have known at the time that it filed the complaint that it could not prove one of the essential elements required by the UDRP,"²¹⁴ or when "the face of the complaint itself demonstrates a settled reason why the complaint must be denied."²¹⁵ But a "mere lack of success of the Complaint is not of itself sufficient."²¹⁶ The determination of reverse domain name hijacking "is always within the panel's discretion," and even where the facts may justify such a finding, the panel may choose instead "to leave the parties as it found them."²¹⁷ Of the twenty-one decisions herein in

²¹⁴ JJGC Industria E Comercio de Materiais Dentarios S.A. v. Yun-Ki Kim, WIPO Case No. D2013-1838 (Dec. 20, 2013) (quoting WIPO Overview 2.0, *supra* note 26, ¶ 4.17). See Witmer Pub. Safety Grp. Inc. v. Kwang pyo Kim, WIPO Case No. D2011-0075 (Mar. 31, 2011) ("[O]ne who brings a complaint, knowing that it will not be able to prove one or more of the elements set out in the Policy or recklessly indifferent as to whether it will be able to prove its case or not, runs a very real risk of . . . a finding [of reverse domain name hijacking] being made against it.") (Brown, Pan., concurring in part, dissenting in part).

²¹⁵ JJGC Industria E Comercio de Materiais Dentarios S.A., WIPO Case No. D2013-1838 (citing Mile, Inc. v. Michael Burg, WIPO Case No. D2010-2011 (Feb. 7, 2011); Liquid Nutrition Inc. v. liquidnutrition.com/Vertical Axis Inc., WIPO Case No. D2007-1598 (Jan. 28, 2008)).

²¹⁶ Protosoftware, Inc., WIPO Case No. D2006-0905 (citing Deutsche Post AG v. NJDomains, WIPO Case No. D2006-0001 (Mar. 1, 2006)).

²¹⁷ JJGC Industria E Comercio de Materiais Dentarios S.A., WIPO Case No. D2013-1838 (quoting Rudy Rojas v. Gary Davis, WIPO Case No. D2004-1081 (Apr. 18, 2005)).

which the complaint was denied, the panel found reverse domain name hijacking in three of them.²¹⁸

In the proceeding involving the domain name <proto.com>, the panel stated that it was unnecessary to address the first two elements of paragraph 4(a), given the panel's "fundamental finding" that the complainant failed to establish the respondent's bad faith.²¹⁹ Here, the respondent registered the domain name years before the complainant filed its application for trademark registration and began using the mark.²²⁰ Thus, in these circumstances, the respondent could not have been aware of the complainant's mark, and could not have acted in bad faith in registering the domain name.²²¹ The panel found reverse domain name hijacking and declared that the complaint was brought in bad faith and was an abuse of the Policy: "The Panel considers that the Complainant is represented by Counsel who even on a rudimentary examination of the Policy and its[] application in this area should have appreciated that the Complaint could not succeed"²²² The panel's cautionary language on the cavalier resort to a UDRP proceeding is worthy of note:

Initiating domain name dispute resolution proceedings necessarily involves putting the parties to a considerable expenditure of time

²¹⁸ *Id.*; Dig. Overture Inc. v. Chris Bradfield/GoPets Ltd., WIPO Case No. D2008-0091 (Apr. 23, 2008); *Protosoftware, Inc.*, WIPO Case No. D2006-0905.

²¹⁹ *Protosoftware, Inc.*, WIPO Case No. D2006-0905.

²²⁰ See *supra* text accompanying note 184.

²²¹ *Protosoftware, Inc.*, WIPO Case No. D2006-0905.

²²² *Id.*

and in many cases cost and the Policy must not be used unless the complainant has a reasonable and credible belief it is entitled to succeed. In particular, proceedings must not be commenced in a brash and totally unjustifiable attempt to pressure a domain name owner into releasing a legitimately held domain name that considerably pre-dates any trademark rights held by the complainant.²²³

In the decision involving the domain name <gopets.net>,²²⁴ the *respondent* had previously registered the mark GOPETS. Ten months before the subject UDRP proceeding, the respondent commenced an action against the complainant in the U.S. district court, seeking transfer of the domain name <gopets.com> from the complainant.²²⁵ Five weeks before the complainant filed its UDRP complaint, the district court issued a preliminary injunction against the complainant “on the grounds that the *Respondent* would be ‘likely to succeed on the merits of its service mark infringement claim.’”²²⁶ The panel emphasized the court’s statement that “the law is clear that ownership of a domain name alone does not confer any rights to a trademark in the

²²³ *Id.* (citing Sustainable Forestry Mgmt. Ltd. v. SFM.com, WIPO Case No. D2002-0535 (Sept. 13, 2002)).

²²⁴ Dig. Overture Inc. v. Chris Bradfield/GoPets Ltd., WIPO Case No. D2008-0091 (Apr. 23, 2008).

²²⁵ GoPets Ltd. v. Hise, No. CV 07-1870 AHM VBKX (C.D. Cal. Mar. 2007).

²²⁶ Dig. Overture Inc., WIPO Case No. D2008-0091 (quoting *GoPets Ltd.*, No. CV 07-1870 AHM VBKX).

same name.”²²⁷ Thus, the complainant was on notice that it could not establish any rights in its mark, under paragraph 4(a)(i). The panel added that the complainant’s case was “similarly fatally weak” with respect to the respondent’s right or interest in the domain name and the bad faith element.²²⁸ A majority of the panel found reverse domain name hijacking,²²⁹ stating, “The Complainant should have known its case was fatally weak. . . . It seems plain that the Complainant, had it properly understood what was required, would have understood that it could not make its case.”²³⁰ The panel also cautioned the complainant and prospective complainants:

It is also notable that [WIPO] provides a substantial amount of information on its

²²⁷ *Id.*

²²⁸ *Id.*

²²⁹ One panelist dissented on the finding. For a discussion, *see infra* text accompanying notes 273-75.

²³⁰ *Dig. Overture Inc.*, WIPO Case No. D2008-0091. The complainant also lost in the court action. The district court’s partial summary judgment in favor of the respondent concluded that the complainant’s use of the domain name <gopets.com> violated the respondent’s rights under the Lanham Act. The court of appeals affirmed this and other portions of the judgment in favor of the respondent, but reversed and remanded on one of the respondent’s claims under the Anticybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d), and the district court’s award of attorneys’ fees. *GoPets Ltd. v. Hise*, 657 F.3d 1024, 1035 (9th Cir. 2011). On remand, the only issue before the district court was the matter of attorneys’ fees. Emphasizing the complainant’s “bad faith and willfulness,” the court awarded the respondent fees in the amount of \$40,335. *GoPets Ltd. v. Hise*, No. CV 07-1870 AHM VBKX, 2012 WL 3962789, at *2-3 (C.D. Cal. Sept. 10, 2012), *aff’d*, 595 F. App’x 721 (9th Cir. 2015).

website, to fully inform parties about conducting disputes under the Policy. This includes a model Complaint, which the Complainant in this case has used. The notes embedded in that model Complaint relevantly instruct a complainant to “specify the trademark(s) or service mark(s) on which the Complaint is based and, for each mark, describe the goods or services, if any, in connection with which the mark is used.” This was evidently a part of that template which the Complainant ignored.²³¹

Finally, in the decision challenging the domain name <neodent.com>, the panel stated that it “need look no further than the Complaint to determine that the Complainant has not established that the Respondent registered the disputed domain name in bad faith.”²³² Indeed, the panel did not address the first two elements of paragraph 4(a), other than referring to the parties’ contentions relating to them. As discussed above, the panel determined that there was no evidence that the respondent, “who does business only in the Republic of Korea, knew of the Complainant or its NEODENT marks when the Respondent registered the domain name in 2002, five years before the Complainant obtained its Korean trademark, or of facts that might support an inference of knowledge.”²³³ The

²³¹ *Dig. Overture Inc.*, WIPO Case No. D2008-0091.

²³² *JJGC Industria E Comercio de Materiais Dentarios S.A. v. Yun-Ki Kim*, WIPO Case No. D2013-1838 (Dec. 20, 2013).

²³³ *Id.*

panel rejected the complainant's argument regarding constructive notice of the mark's registration and "renown" of the mark.²³⁴

Declaring that a finding of reverse domain name hijacking was appropriate, the panel relied on three reasons. First, the panel was critical of the complainant, represented by counsel, for disregarding the "longstanding rule of decision in Policy proceedings" that rejects the U.S. doctrine of constructive notice for UDRP proceedings, at least where non-U.S. parties are involved. "The Complainant offers the Panel no reason why in this proceeding the Panel should depart from or modify settled Policy precedent."²³⁵ Second, the complainant committed "a more serious pleading error."²³⁶ Given that there was evidence (in both Korean and English) that the respondent operated a dental clinic in Korea under the name "NEO Dental Clinic" from twelve years before the filing of the complaint, the panel stated that the complainant "could and should have verified" its allegation in the complaint that the respondent "has never been known by the disputed domain name."²³⁷ The panel described the pleading as "misleading to the point of attempting to deceive the Panel."²³⁸ "Third, the

²³⁴ *Id.*

²³⁵ *Id.*

²³⁶ *Id.*

²³⁷ *Id.*

²³⁸ *Id.* The panel explained, "This alone has been held grounds for finding RDNH." *Id.* (citing *Timbermate Prods. Pty Ltd. v. Domains by Proxy, LLC/Barry Gork*, WIPO Case No. D2013-1603 (Nov. 3, 2013); *Coöperatie Univé U.A. v. Ashantiplc Ltd.*, WIPO Case No. D2011-0636) (June 30, 2011)).

Complainant's basic theory of its case raises issues far outside the limited jurisdiction and competence of a UDRP panel, and the Complainant or its representative should have known it."²³⁹

In another decision, involving the domain name <newsrepublic.com>, the panel noted that the complainant failed "even to make a *prima facie* case showing that the Respondent lacks right or legitimate interest"²⁴⁰ and also failed to establish the bad faith element.²⁴¹ In denying the complaint, the panel added in a footnote, "[T]he Panel unanimously finds the allegations and evidence of [the] Complainant to be seriously inadequate to establish a successful case."²⁴² The panel's words that follow sound of the cautionary language seen in previous decisions where reverse domain name hijacking was found: "The Panel wishes to remind Complainant that, under the Policy, the responsibility rests on Complainant to fully comprehend the Policy and to provide sufficient legal allegations to establish its rights, along with evidence to support such allegations."²⁴³ Nevertheless, there was no mention of reverse domain name hijacking in the decision, nor did the respondent request it.²⁴⁴

²³⁹ *Id.*

²⁴⁰ *Mobile's Republic v. Kwangpyo Kim*, WIPO Case No. D2014-0089 (Apr. 23, 2014).

²⁴¹ *Id.*

²⁴² *Id.* n.6.

²⁴³ *Id.*

²⁴⁴ The panel declined the respondent's request for a finding of reverse domain name hijacking in five decisions. The panel offered its reasons for doing so in the following three decisions, where it had denied the complaint:

Heimbs Kaffee GmbH & Co. KG v. Ho Kyoung Trading Co, Ltd., Heui-il Kang, WIPO Case No. D2011-1407 (Oct. 17, 2011) ("In this present case, the Complainant 1) has in fact a valid trademark registration for ALLEGRETTO dated earlier than the registration of the disputed domain name, and 2) found the disputed domain name identical to its trademark, and used only on a website indicating that the domain name was for sale. It is the Panel's view that the Complainant, not having all facts and arguments, had understandable reasons to file the Complaint.");

Nursefinders, Inc. v. Vertical Axis, Inc., WIPO Case No. D2007-0417 (July 5, 2007) ("[T]he Complainant holds registered marks that are nearly identical to the Domain Name and has used the NURSEFINDERS mark for more than thirty years. The Complaint was advanced with ultimately unpersuasive claims, but there is no indication that the Complaint was brought to harass the Respondent as a competitor. Moreover, this Respondent was found to have acted in bad faith in some of the earlier UDRP proceedings in which it was involved. Thus, while the Complainant has failed to establish all of the elements of a Policy complaint, the Panel does not conclude that the Complainant initiated this proceeding in bad faith.");

Reckitt Benckiser Plc v. Eunsook Wi, WIPO Case No. D2009-0239 (May 20, 2009) ("In the present case, where the Complainant owns if limited common law trade mark rights identical to the second level domain name, there is no room for a reverse domain name hijacking order.");

In two other decisions, the respondent requested a finding of reverse domain name hijacking, but the panel ruled in favor of the complainant and ordered a transfer of the domain name. *Samsung Elecs. Co. v. Pimser Elecs. Ltd.*, WIPO Case No. D2009-1630 (Feb. 16, 2010);

III. THE SEPARATE OPINIONS

The similarities between arbitration and the UDRP proceeding continue to the decision stage. A decision by any three-member tribunal requires deliberations within the collective body. UDRP decisions are no exception. Like the rules of most arbitral organizations, the Policy, the UDRP Rules, and the WIPO Supplemental Rules do not provide any mention of, or guidance on, the panel's internal deliberations. As with many arbitration cases involving multi-member panels, the manner and extent of the UDRP panel's deliberation is entirely up to its members.²⁴⁵

SMS Demag AG v. Seung Gon, Kim, WIPO Case No. D2000-1434 (Jan. 19, 2001).

²⁴⁵ Because UDRP proceedings generally have no in-person hearings, internal deliberations will most likely be by electronic means. Given the international composition of many UDRP panels (which is the case in all of the 58 decisions), deliberations would be necessary especially where party submissions and portions of the case record are in a language in which an individual panelist may not have proficiency, requiring summaries of translations or similar assistance by another member of the panel with proficiency in that language. Of the 58 proceedings, the panel in the following seven included at least one non-Korean panelist, where the decision was published in Korean. (The nationality of the non-Korean panelist is indicated, per the guidelines provided in the Appendix.) *News Corp. v. Yoon Jinsu*, WIPO Case No. D2005-0504 (Aug. 5, 2005) (Ricketson, Australia); *NBC Universal, Inc. v. Junak Kwon*, WIPO Case No. D2004-0764 (Dec. 23, 2004) (Barker, New Zealand); *Societe Air France v. Daung Soo Ghim*, WIPO Case No. D2003-0891 (Feb. 13, 2003) (Vivant, France); *Produits Berger v. Pil Technology Korea Ltd.*, WIPO Case No. D2003-0192 (May 31, 2003) (Bensoussan, France); *Konica Corp. v. [Jin Hee Lee]*, WIPO Case No. D2003-0101 (May 23, 2003) (Limbury, Great Britain/Australia); *Societe Nationale de Television*

With respect to the tribunal's ultimate decision, the rules of the leading arbitral organizations require that the award be in writing and state the reasons upon which the award is based.²⁴⁶ These rules also acknowledge the possibility of a divided vote and decision by a majority.²⁴⁷ Identical provisions appear in the UDRP Rules: "The Panel's decision shall be in writing, provide the reasons on which it is based";²⁴⁸ and "[i]n the case of a three-member Panel, the Panel's decision shall be made by a majority."²⁴⁹ While some arbitration administering organizations do not address explicitly the matter of the dissenting opinion, the UDRP

France3 v. [Segwon Kim], WIPO Case No. D2002-1181 (May 9, 2003) (Dreyfus, France); Experian Info. Solutions, Inc. v. [Suh Jung Gohn], WIPO Case No. D2002-0368 (Sept. 6, 2002) (Hunter, Australia; U.S.).

²⁴⁶ AAA Int'l Rules, *supra* note 54, art. 30(1); ICC Rules, *supra* note 54, art. 31(2); LCIA Rules, *supra* note 54, art. 26.2. See UNCITRAL Rules, *supra* note 54, art. 34(2) & (3). Some organizations provide that the parties may agree that no reasons are to be given. AAA Int'l Rules, *supra* note 54, art. 30(1); LCIA Rules, *supra* note 54, art. 26.2. See UNCITRAL Rules, *supra* note 54, art. 34(3).

²⁴⁷ AAA Int'l Rules, *supra* note 54, art. 29(2); ICC Rules, *supra* note 54, art. 31(1); LCIA Rules, *supra* note 54, art. 26.5. See UNCITRAL Rules, *supra* note 54, art. 33(1). Some rules provide that where there is no majority, the president or presiding arbitrator makes the decision. ICC Rules, *supra* note 54, art. 31(1); LCIA Rules, *supra* note 54, art. 26.5.

²⁴⁸ UDRP Rules, *supra* note 15, ¶ 15(d).

²⁴⁹ *Id.* ¶ 15(c).

framework contemplates the possibility of the dissenting opinion and addresses it squarely.²⁵⁰

In international arbitration, there has been significant discussion regarding the utility of dissenting opinions.²⁵¹ Alan Redfern, among others, is critically opposed to the practice:

[F]irst, . . . they may inhibit that open discussion which ought to take place secretly and within the confines of the arbitral tribunal. Secondly, . . . they may cast doubts on the correctness or validity of the award made by the majority. Thirdly, . . . they do not serve to advance the development of the law, since there is no doctrine of precedence in arbitrations and, in general no appeal against

²⁵⁰ “Panel decisions and dissenting opinions shall normally comply with the guidelines as to length set forth in the Provider’s Supplemental Rules. Any dissenting opinion shall accompany the majority decision.” *Id.* ¶ 15(e). The UDRP prescription that a dissenting opinion “shall accompany the majority decision” is perhaps included in light of the general understanding in arbitration that a dissenting opinion is not part of the award. ALAN REDFERN & MARTIN HUNTER, *LAW AND PRACTICE OF INTERNATIONAL COMMERCIAL ARBITRATION* 389 (4th ed. 2004); Peter J. Rees QC & Patrick Rohn, *Dissenting Opinions: Can They Fulfil a Beneficial Role?*, 25 *ARB. INT’L* 329, 333 (2009). The UDRP rule avoids the (one hopes) rare situation in arbitration where the dissenting opinion surfaces after the award is issued, sometimes without the knowledge of the majority or the administering organization, when the dissenter reveals the opinion to the losing party.

²⁵¹ For a summary, see Ilhyung Lee, *Introducing International Commercial Arbitration and Its Lawlessness, by Way of the Dissenting Opinion*, 4 *CONTEMP. ASIA ARB. J.* 19 (2011), and citations therein.

the award of an arbitral tribunal and no open publication of that tribunal's award.²⁵²

Others argue that a proper dissent can be beneficial.²⁵³ Although the UDRP process borrows much from the arbitration method, given some of the differences between the two (mainly that the UDRP decision is not necessarily binding), the reasons for opposing a dissent in arbitration do not transfer perfectly to the UDRP setting. With respect to WIPO-administered decisions particularly, note the provider's understanding that "with UDRP decisions covering a multitude of facts and arguments, genuine differences of opinion may be difficult to avoid on particular issues, all the more so where panelists and parties come from a multitude of jurisdictions. Moreover, these opinions must be formed in the context of a rapidly evolving Domain Name System and Internet."²⁵⁴

²⁵² Alan Redfern, *The 2003 Freshfields Lecture – Dissenting Opinions in International Commercial Arbitration: The Good, the Bad, and the Ugly*, 20 *ARB. INT'L* 223, 240 (2004); see REDFERN & HUNTER, *supra* note 250, at 391-92.

²⁵³ Richard M. Mosk, *The Debate Over Dissenting and Concurring Opinions in International Arbitration*, 26 *UWLA L. REV.* 51, 53-54 (1995) (stating that dissenting, as well as concurring, opinions "should be allowed in international arbitration and are useful" and "can be "influential" and "a source of legal reasoning"). See Richard M. Mosk & Tom Ginsburg, *Dissenting Opinions in International Arbitration*, in *LIBER AMICORUM BENGT BROMS* 259, 283 (Matt Tupamäki ed., 1999) ("Dissenting opinions can improve the legitimacy and performance of international arbitration, and thus offer significant benefits that offset the risks posed.").

²⁵⁴ WIPO Overview 2.0, *supra* note 26 (prefatory text).

WIPO also notes that although “[t]he UDRP does not operate on a strict doctrine of precedent”²⁵⁵ and prior decisions are not binding on panelists,²⁵⁶ the organization apparently desires to “maximize the consistency” of the UDRP system,²⁵⁷ one that operates in a “predictable manner for all parties.”²⁵⁸ As one commentator noted, “[T]he UDRP has in effect given rise to a new system of *international common law*, with panelists increasingly citing to, and relying upon, previous UDRP decisions.”²⁵⁹ Over time, “consensus or clear majority views”²⁶⁰ may emerge. Along the way, well-reasoned dissenting statements by individual panelists may provoke thought and prompt deliberative discussion within the international pool of panelists, and perhaps serve as the basis for sound majority rules in the future.²⁶¹

From the 58 decisions herein, there are ten in which disagreement within the panel is noted from the text of the publicly available decision. Of these ten:

²⁵⁵ *Id.* ¶ 4.1. (“What deference is owed to past UDRP decisions dealing with similar factual matters or legal issues?”)

²⁵⁶ *Id.* (prefatory text).

²⁵⁷ *Id.*

²⁵⁸ *Id.* ¶ 4.1. (“What deference is owed to past UDRP decisions dealing with similar factual matters or legal issues?”). “[P]redictability remains a key element of dispute resolution systems . . .” *Id.* (prefatory text).

²⁵⁹ Sorkin, *supra* note 18, at 43 (citing David G. Post, *Juries and the UDRP*, ICANN WATCH (Sept. 6, 2000), http://www.icannwatch.org/archive/juries_and_the_udrp.htm) (emphasis added)).

²⁶⁰ WIPO Overview 2.0, *supra* note 26 (prefatory text).

²⁶¹ It was apparently the concern that future panelists may be persuaded by the dissent in *Guru Denim Inc. v. Ibrahim Ali Ibrahim Abu-Harb*, WIPO Case No. D2013-1324 (Sept. 27, 2013), that prompted in the commentary a rousing defense of the majority’s approach. See *Cyberlaw*, *supra* note 34.

- Two are not on the merits of the decision. One relates to the necessity of making a finding on the first element of paragraph 4(a), given the dispositive nature of the panel's finding on the bad faith element; the other is a dissent from the majority's determination of the proper language of the proceeding.
- One decision includes a panelist's dissent from the majority's finding of reverse domain name hijacking.
- Another decision records a dissent from the majority's refusal to find reverse domain name hijacking. The same decision is also noteworthy in that the panel's unanimous decision denying the complaint attaches two concurring opinions.
- The remaining six decisions see an individual panelist's dissent from the ultimate outcome of the dispute.

We turn to the decisions.

A. ELEMENTS, LANGUAGE, RDNH

In the proceeding involving the domain name <shoulderdoc.com>, the panel denied the complaint on the ground that the complainant failed to establish the required bad faith element of paragraph 4(a)(iii) of the Policy.²⁶² The panel stated that in view of its conclusion regarding the bad

²⁶² *Shoulderdoc Ltd. v. Vertical Axis, Inc.*, WIPO Case No. D2006-0625 (Sept. 8, 2006).

faith element, it was not necessary to make a finding regarding the respondent's right or legitimate interest in the domain name. Regarding the first element, concerning identical or confusing similarity to a mark in which the complainant has rights, the majority of the panel decided that the complainant's use of its own domain name <shoulderdoc.co.uk> was sufficient to establish common law rights in a mark.²⁶³ But "[o]ne member of the Panel would decline to reach a finding on this question, on the ground that the Panel's finding as to bad faith is dispositive of the present matter."²⁶⁴ That member of the panel is not identified, and there is no separate opinion or further elaboration.

A disagreement regarding the proper language of the proceeding brought a separate opinion in *NBC Universal, Inc. v. Junak Kwon*.²⁶⁵ There, the U.S. complainants challenged the Korean respondent's registration and use of the domain name <nbcuniversal.com>. The panel unanimously determined that the complainants satisfied the requisite three elements of paragraph 4(a), and ordered the transfer of the domain name to the complainants. The panel's decision was in Korean, with two of the panelists deciding that Korean was the language of the proceeding. The non-Korean panelist disagreed on this point.²⁶⁶

Given the possibility of parties from different countries and languages coming together in a domain name

²⁶³ *Id.*

²⁶⁴ *Id.*

²⁶⁵ WIPO Case No. D2004-0764 (Dec. 23, 2004) [in Korean].

²⁶⁶ *Id.* (Opinion of Sir Ian Barker).

dispute, the UDRP Rules specifically address the question of the language of the proceeding:

11. Language of Proceedings

- (a) Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.
- (b) The Panel may order that any documents submitted in languages other than the language of the administrative proceeding be accompanied by a translation in whole or in part into the language of the administrative proceeding.²⁶⁷

In the <nbcuniversal.com> decision, the complainants filed the complaint in English on the belief that the registration agreement was in English. After the registrar advised WIPO that the registration agreement was in Korean, WIPO ordered the complainants to submit a Korean translation of the complaint, to which the complainants complied.²⁶⁸ The respondent did not file a response. The majority of the panel stated that under paragraph 11, the availability of the

²⁶⁷ UDRP Rules, *supra* note 15, ¶ 11.

²⁶⁸ Over the years, WIPO's practice in such circumstances has evolved. See Lee, *supra* note 18.

registration agreement in English (as well as in Korean) and the complainant's lack of fluency in Korean were not sufficient reasons to depart from the language of the registration agreement. The majority also noted that the respondent used the English language only briefly for its website and that the procedures for the respondent to follow were spelled out in Korean. Thus, the majority declared that the decision would be in Korean.²⁶⁹ Panelist Sir Ian Barker filed a separate opinion, stating, "I respectfully disagree with the opinion of the majority that Korean should be the language of the proceedings," and offered "the following reasons that require English.

- (a) The Respondent demonstrated some facility with the English language in his email communications to the Center.
- (b) The disputed domain name includes a word in the English language (universal) and clearly relates to companies in an English-speaking country.
- (c) The content on the Respondent's website is in English and shows that he may communicate his views in that language.
- (d) The fact that the Respondent has filed no response even to the Korean complaint.²⁷⁰

²⁶⁹ *NBC Universal, Inc.*, WIPO Case No. D2004-0764.

²⁷⁰ *Id.* (Opinion of Sir Ian Barker). On the merits, Panelist Barker wrote, "I agree with the majority that the complaint be allowed and transfer of the Disputed Domain Name ordered. I have been supplied with a translation of the operative part of the decision by the Presiding Panelist and I agree with it." *Id.* The case appears to be one of the few in which the text of the decision reveals that a particular panelist was included in the list provided by one of the parties. Panelist Barker stated that he was chosen

Panelist Barker relied on prior UDRP decisions with similar circumstances in which the panel decided to depart from the Korean language of the registration agreement and to proceed in English.²⁷¹

As noted above, in the decision involving the domain name <gopets.net>,²⁷² the panel unanimously denied the complaint based on its conclusion that the complainant failed to meet any of the three requirements under paragraph 4(a), with particular attention to the complainant's failure to show any rights in a relevant trademark. A majority of the panel also found reverse domain name hijacking against the complainant, reasoning that there was "sufficient evidence that the Complainant brought the Complaint either deliberately knowing of its flaws, or that it should have been aware of them."²⁷³ The decision continues, "One Panelist, however, considers that the Complainant should be given the benefit of the doubt on this point, since it is unrepresented by counsel. On this alternative, it is possible that the Complainant simply misunderstood the scope of the Policy."²⁷⁴ The panelist is not identified, and there is no separate opinion. The dissenter's position would be defensible under the guidelines, offered

as a panelist by WIPO from a list of three provided by the complainant.

Id.

²⁷¹ *Id.* (citations omitted).

²⁷² Dig. Overture Inc. v. Chris Bradfield/GoPets Ltd., WIPO Case No. D2008-0091 (Apr. 23, 2008).

²⁷³ *Id.*

²⁷⁴ *Id.*

by a later panel decision within the 58, that a determination of reverse domain name hijacking “is always within the panel’s discretion,” and even where the evidence indicates that the complainant used the proceeding in bad faith and in an attempt to deprive the respondent of its domain name, the panel may choose “to leave the parties as it found them.”²⁷⁵

B. THREE OPINIONS, TWO CONCURRING, ONE DISSENTING
IN PART

The result in *Witmer Public Safety Group, Inc. v. Kwang pyo Kim*,²⁷⁶ may well be the UDRP’s version of the U.S. Supreme Court’s decision in *New York Times Co. v. United States*.²⁷⁷ In *New York Times Co.*, the Court rejected the government’s request to enjoin two newspapers from publishing the “Pentagon Papers.”²⁷⁸ The Court’s decision included a per curiam opinion, and nine separate opinions, one by each member of the Court – six concurring²⁷⁹ and

²⁷⁵ JJGC Industria E Comercio de Materiais Dentarios S.A. v. Yun-Ki Kim, WIPO Case No. D2013-1838 (Dec. 20, 2013) (quoting Rudy Rojas v. Gary Davis, WIPO Case No. D2004-1081 (Apr. 18, 2005)).

²⁷⁶ WIPO Case No. D2011-0075 (Mar. 31, 2011).

²⁷⁷ 403 U.S. 713 (1971) (per curiam).

²⁷⁸ *Id.*

²⁷⁹ *Id.* at 714 (Black, J., concurring); *id.* at 720 (Douglas, J., concurring); *id.* at 724 (Brennan, J., concurring); *id.* at 727 (Stewart, J., concurring); *id.* at 730 (White, J., concurring); *id.* at 740 (Marshall, J., concurring).

three dissenting.²⁸⁰ In *Witmer Public Safety Group, Inc.*, the panel denied the complaint, but that was the only issue on which the three panelists were unanimous.²⁸¹ The decision signed by the presiding panelist is followed by another panelist's concurring opinion offering different grounds for denying the complaint.²⁸² These two panelists also formed a majority to deny the respondent's request for a finding of reverse domain name hijacking. The third panelist's separate opinion concurred with the decision to deny the complaint on grounds virtually identical to those of the presiding panelist, but dissented from the majority's refusal to find reverse domain name hijacking.²⁸³

The respondent in *Witmer Public Safety Group, Inc.* registered the domain name <firestore.com> on December 24, 1999. From 2001 to 2008, the domain name resolved to a website that offered electronic goods for sale.²⁸⁴ The website was later changed, and, at the time of the UDRP proceeding, was "a referral website featuring pay-per-click links to other websites promoting and selling firefighting equipment and related goods."²⁸⁵ The complainant was a U.S. company based in Pennsylvania that – beginning from 1999 – sold equipment and supplies to fire, police, "EMS," and military personnel, under the trademark "thefirestore.com". In September 2006, the complainant applied to register the

²⁸⁰ *Id.* at 748 (Burger, C.J., dissenting); *id.* at 752 (Harlan, J., dissenting); *id.* at 759 (Blackmun, J., dissenting).

²⁸¹ WIPO Case No. D2011-0075.

²⁸² *Id.* (Hudis, Pan., concurring).

²⁸³ *Id.* (Brown, Pan., concurring).

²⁸⁴ *Id.* (Pan. Decision).

²⁸⁵ *Id.*

mark with the U.S. Patent and Trademark Office, and received registration in January 2008.²⁸⁶

Presiding Panelist Gabriela Kennedy “accept[ed] that the Complainant presently has rights in the ‘the[]firestore.com’ trade mark” based on its registration in 2008.²⁸⁷ She wrote that although the complainant obtained the trademark registration *after* the respondent registered the domain name, “Paragraph 4(a)(i) of the Policy does not require that the Complainant show it had rights in the trade mark at the time that the Disputed Domain Name was registered, but rather it merely requires that such right exists at the time of filing the Complaint.”²⁸⁸ Completing the discussion of the first element, the presiding panelist found that the domain name <firestore.com> was confusingly similar to the complainant’s mark “thefirestore.com”.²⁸⁹ Turning to the second element of the respondent’s right or

²⁸⁶ *Id.*

²⁸⁷ *Id.*

²⁸⁸ *Id.* (citing *Digital Vision, Ltd. v. Advanced Chemill Sys.*, WIPO Case No. D2001-0827 (Sept. 23, 2001); *Esquire Innovations, Inc. v. [] Vertical Axis, Inc.*, WIPO Case No. D2007-0856 (Oct. 5, 2007)). She added:

Whether the Complainant had rights in the trade mark at the time of registration of the Disputed Domain Name may be relevant to the consideration of bad faith under paragraph 4(a)(iii) of the Policy, but it is not relevant for the purposes of determining whether the Disputed Domain Name is confusingly similar to a trade mark in which the Complainant has rights.

Id.

²⁸⁹ *Id.*

interest in the domain name, the presiding panelist agreed with the respondent's view that the domain name was of a descriptive nature and that there was no evidence to show that the respondent knew of the complainant's mark. Accordingly, the presiding panelist found that the complainant failed to establish the second element. Although the complaint failed on this ground, and it was not necessary to address the bad faith element, the presiding panelist thought "it fit to look at the third requirement" in light of the respondent's request for a finding of reverse domain name hijacking.²⁹⁰

Presiding Panelist Kennedy emphasized that paragraph 4(a)(iii) imposed a "conjunctive requirement," necessitating proof of both bad faith registration *and* bad faith use. With respect to bad faith registration, she noted that "[b]y the Complainant's own admission, the Respondent did not register the Disputed Domain Name in bad faith."²⁹¹ Moreover, the presiding panelist pointed out that the complainant did not have a trademark registration for "thefirestore.com" when the respondent registered the domain name; there was insufficient evidence to show that the complainant had common law rights in the mark at the time the domain name was registered; and given that the domain name "consisted of descriptive generic terms," there was no evidence that the complainant's mark "obtained any great degree of fame or secondary meaning" before the domain name was registered, "certainly none that extended

²⁹⁰ *Id.*

²⁹¹ *Id.*

to South Korea, where the Respondent resides.”²⁹² Thus, the presiding panelist noted, the complainant could not have satisfied paragraph 4(a)(iii). She did state, however, that the respondent’s recent use of the domain name for a website that included links to the complainant’s competitors was “suggestive of bad faith.”²⁹³ Regarding reverse domain name hijacking, Presiding Panelist Kennedy wrote that “the Complainant had an arguable case at least,” and declined to find that the complaint “was frivolous or that it was filed merely to harass the Respondent.”²⁹⁴

Panelist Jonathan Hudis filed a concurring opinion. To him, the “fatal flaw” in the complainant’s case was its “lack of proof of priority” in the mark.²⁹⁵ “The Complainant has not shown that it possessed registered or common law trade mark rights in ‘TheFireStore.com’ prior to the Respondent’s registration of the Disputed Domain Name.”²⁹⁶ According to Panelist Hudis, the complaint failed on that ground alone, and presumably, it was unnecessary to address the latter two elements of paragraph 4(a). His opinion continues, however. He described the respondent’s re-tasked website, which directed Internet users to the complainant’s competitors, as “objectionable use” and “progressive encroachment,” and determined that the respondent did not have a right or legitimate interest in the domain name.²⁹⁷ The panelist also stated that the

²⁹² *Id.*

²⁹³ *Id.*

²⁹⁴ *Id.*

²⁹⁵ *Id.* (Hudis, Pan., concurring).

²⁹⁶ *Id.*

²⁹⁷ *Id.*

respondent's use of the domain name "arguably, cause[d] confusion," and was "arguably infringing" and "arguably . . . bad faith use."²⁹⁸ Regarding the bad faith element, the panelist wrote:

I further depart from that part of the Presiding Panelist's opinion stating that it is unnecessary to discuss bad faith (in view of the Complainant's failure to prevail under paragraphs 4(a)(i) or 4(a)(ii) of the Policy),^[299] and then devote a whole section of the decision to bad faith. To this Panelist, such a circular approach makes no sense.³⁰⁰

Finally, Panelist Hudis agreed wholly with the presiding panelist's decision against a finding of reverse domain name hijacking.³⁰¹

The Honorable Neil Brown Q.C. filed an opinion concurring in part and dissenting in part. Regarding the first element, he concurred with the presiding panelist that the complainant satisfied the requirements therein. He wrote, "It is sometimes said that for the purposes of paragraph 4(a)(i) of the Policy, a complainant need satisfy only a

²⁹⁸ *Id.*

²⁹⁹ To clarify, the presiding panelist determined that the complainant satisfied the element in paragraph 4(a)(i), but not (ii). Panelist Hudis would have found that the complainant did not satisfy (i), but did satisfy (ii). *Id.*

³⁰⁰ *Id.* "Moreover, . . . I do not wish to enter the debate whether any complainant needs to prove bad faith use and registration to establish its case under the Policy." *Id.*

³⁰¹ *Id.*

comparatively low threshold. Thus, for example, the prevailing view seems to be that a complainant need only show that it has a trade mark at the time the complaint is filed.”³⁰² Regarding the respondent’s right or interest in the domain name, Panelist Brown concurred with the presiding panelist “for the reasons given” that the complainant did not satisfy this element. He likewise concurred with the presiding panelist that there was no bad faith registration. Nonetheless, departing from the presiding panelist regarding bad faith use, he wrote, “[T]he Complainant has not satisfied paragraph 4(a)(iii) of the Policy in so far as it relates to bad faith use.”³⁰³

Panelist Brown disagreed with the majority’s decision declining to find reverse domain name hijacking, in a strongly worded dissent:

³⁰² *Id.* (Brown, Pan., concurring in part, dissenting in part). He added:

Accordingly, it may be the case that the Complainant in the present proceedings has satisfied the requirement of paragraph 4(a)(i) as a matter of literal interpretation of the Policy, for it “has” trademark rights, even if it did not have them when the Disputed Domain Name was registered. But it should be noted that its trademark rights are weak and will not allow it to prevail in these proceedings. That is so because the trademark in question was not applied for until 7 years after the Disputed Domain Name was registered and was not issued until 9 years after the Disputed Domain Name was registered. As such, it is clear that the trademark relied on will not enable a finding that the Disputed Domain Name was registered in bad faith.

Id.

³⁰³ *Id.*

In the present case, it is clear that there was no ground for filing the complaint and that this was known to the Complainant. That is so because the Complainant has made the unusual but frank admission that the domain name was not registered in bad faith. That being so, the Complainant must have been fixed with knowledge, at the time it filed the Complaint, that it would not be able to prove one of the elements required to be proved, namely that within the meaning of paragraph 4(a)(iii), the Disputed Domain Name had not only been used in bad faith, but had been registered in bad faith. That, by itself, is a ground for making a finding of reverse domain name hijacking.³⁰⁴

³⁰⁴ *Id.* He also added:

[T]here is an air of unreality about the Complainant's case of which it must have been aware. It has its own website, "www.thefirestore.com" and the domain name leading to that website is clearly <thefirestore.com>. A search shows that the domain name is registered in the name Jeff Smith Private Registration and that it was registered on August 12, 1999. Despite this privacy registration, it is apparent that the Complainant made a conscious decision to register, not <firestore.com>, which it could have registered, but <thefirestore.com>. It seems unreal for it to claim 11 years later that the Respondent has no right to and registered in bad faith a domain name that it could have registered itself, but did not and a domain name that another party subsequently registered and used to promote goods coming within its generic meaning.

Ultimately, for Panelist Brown, the case for a finding of reverse domain name hijacking was “not a marginal one but a strong one.”³⁰⁵

At this juncture, a table offering in one glance a summary of the three panelists’ respective views might be helpful:

Witmer Public Safety Group, Inc. [U.S.] v. Kwang pyo Kim [Korea]

Complainant’s mark: “thefirestore.com”; Respondent’s domain name: <firestore.com>

WIPO Case No. 2011-0075 (Mar. 31, 2011)

Panelist	¶ 4(a)(i)	¶ 4(a)(ii)	¶ 4(a)(iii)	Decision	RDNH
Kennedy, Pr. Pan.	Complainant has rights in subject mark; confusing similarity	Respondent <u>has</u> right or interest in domain name	Addressed for purposes of RDNH. Conjunctive requirement. <u>No</u> bad faith registration. (Recent) bad faith use.	Complaint denied	No
Hudis, Pan.	Complainant does <u>not</u> have	Respondent does not have	Unnecessary to decide	Complaint denied	No

Id.

³⁰⁵ *Id.*

	timely rights in subject mark ³⁰⁶	right or interest in domain name			
Brown, Pan.	Complainant has rights in subject mark; confusing similarity	Respondent <u>has</u> right or interest in domain name	Conjunctive requirement. <u>No</u> bad faith registration. <u>No</u> bad faith use.	Complaint denied	Yes

In review, the panel was unanimous in its decision to deny the complaint. A majority (Kennedy and Brown) determined that the complainant proved that the domain name was identical or confusingly similar to a mark in which the complainant had rights.³⁰⁷ The same majority concluded that the complainant failed to prove that the respondent did not have a right or interest in the domain name. With respect to the bad faith element, Panelist Hudis wrote that it was not necessary to address it; Presiding

³⁰⁶ "I would decide this matter based upon the Complainant's failure of proof regarding its trade mark priority." *Id.* (Hudis, Pan., concurring).

³⁰⁷ Regarding the first element, and specifically, the situation of a domain name that is registered *before* the complainant's registration of a mark or common law rights in the mark, the Presiding Panelist and Panelist Brown's approach appears to be the consensus view. WIPO reports: "Registration of a domain name before a complainant acquires trademark rights in a name does not prevent a finding of identity or confusing similarity under the UDRP. The UDRP makes no specific reference to the date on which the holder of the trademark or service mark acquired rights." WIPO Overview 2.0, *supra* note 26, ¶ 1.4. Of course, precisely as the two panelists intimated, WIPO notes that "in such circumstances it may be difficult to prove that the domain name was registered in bad faith under the third element of the UDRP." *Id.*

Panelist Kennedy (who addressed it for the purpose of a reverse domain name hijacking determination) and Panelist Brown applied the “conjunctive requirement,” with the former finding an absence of bad faith registration but evidence of recent bad faith use, and the latter finding absence of both bad faith registration and bad faith use. A different majority (Kennedy and Hudis) declined to find reverse domain name hijacking, from which Brown dissented.

Witmer Public Safety Group, Inc. makes for an interesting case study of a UDRP proceeding decided by a three-member panel. Had the proceeding been decided by a sole panelist, and WIPO appointed any one of the three panelists, and the individual panelists decided the matter on the respective grounds indicated in the three-member decision, the complaint would have been denied, though for different reasons. If Panelist Brown were the sole panelist, the respondent would have prevailed on its request for a finding of reverse domain name hijacking. In all events, the three panelists’ opinions, individually and as a group, contribute to a sharper understanding of the requisite elements of paragraph 4(a) of the Policy.

C. DISSENT ON MERITS

There are six decisions that include a dissent on the merits of the case. In the first two, the dissenting panelist disagreed with the majority’s decision to deny the complaint, and would have ordered a transfer of the disputed domain name. (The majority decision in both of these cases is written in Korean.) In the last four, the individual panelist dissented from the majority’s decision to order transfer of the domain name, and would have denied the complaint. These decisions are addressed in turn.

A. DISSENT FROM DENIAL OF COMPLAINT

a. <FRANCE3.COM>

The three-member panel decision involving the domain name <france3.com> came a year after a UDRP decision by a sole panelist involving the same parties and the same domain name.³⁰⁸ The proceeding before the three-member panel was not an appeal of the decision by the sole panelist. The UDRP framework does not provide for appellate review of a panel decision by another panel. Thus, an initial question for the second panel was whether there was a proper re-filed complaint.³⁰⁹

³⁰⁸ Societe Nationale de Television France3 v. Kim Segwon, WIPO Case No. D2001-1322 (Jan. 29, 2002) (sole panelist) [in Korean].

³⁰⁹ WIPO provides:

A refiled case concerns the complainant submitting a second complaint involving the same domain name(s) and the same respondent(s) as in an earlier complaint that had been denied. A refiled case may only be accepted in limited circumstances. These circumstances include when the complainant establishes in the complaint that relevant new actions have occurred since the original decision, or that a breach of natural justice or of due process has occurred, or that there was other serious misconduct in the original case (such as perjured evidence). A refiled complaint would usually also be accepted if it includes newly presented evidence that was reasonably unavailable to the complainant during the original case.

WIPO Overview 2.0, *supra* note 26, ¶ 4.4 ("Under what circumstances can a refiled case be accepted?").

To retrace, the Korean respondent registered the domain name on March 28, 2001.³¹⁰ The domain name initially resolved to a website with pornographic content. The pictures were later removed, and replaced with a message that read, “sex solution. . . . We start the optimal website for you.”³¹¹ The complainant, a French television broadcasting company that registered and used the mark “FRANCE3” for its business, brought a UDRP complaint in November 2001.

The sole panelist denied the complaint, reasoning that the complainant failed to satisfy the second and third elements of paragraph 4(a) of the Policy.³¹² Regarding the respondent’s right or legitimate interest in the domain name, the panel noted that the respondent was preparing to use the domain name for the service of “providing adult information” (*sung-in-jung-boh-jeh-gong-ub*), and specifically referred to paragraph 4(c)(i).³¹³ With respect to the bad faith element, the panel stated that there was inadequate evidence to show that the respondent registered the domain name to sell it to the complainant, and indeed, referred to the respondent’s plans to use it for the adult-oriented services. Moreover, the panel noted that although the complainant’s mark might be well-known in France and other parts of Europe, it was not so in Korea; indeed, the complainant did

³¹⁰ *Societe Nationale de Television France3 v. [Segwon Kim]*, WIPO Case No. D2002-1181 (May 9, 2003) (three-member panel) [in Korean].

³¹¹ *Societe Nationale de Television France3*, WIPO Case No. D2001-1322. The phrase “sex solution” was in English; the rest is a translation from Korean text.

³¹² *Id.*

³¹³ *Id.*

not register the mark in Korea. Finally, given the differences in the parties' businesses, the panel added, there could not be confusion by Internet users.³¹⁴

Eleven months after the decision of the sole panelist, the complainant commenced another UDRP proceeding.³¹⁵ The complainant asserted that there was new evidence to show that after the previous panel decision, the respondent entered into a contract with a third party to sell the domain name for US\$100,000, thus proving bad faith.³¹⁶ In a twist, the respondent countered that it was the complainant who suggested to the third party that the third party contact the respondent to purchase the domain name.³¹⁷ For the second proceeding, WIPO appointed three panelists: Nathalie Dreyfus, of France; Sang Jo Jung, of Korea (as the presiding panelist); and Dr. Jisuk Woo, of Korea. (The decision does not state which party elected to have the proceeding decided by a three-member panel.) Initially, the panel cited prior panel decisions to set forth the limited grounds for bringing a re-filed complaint.³¹⁸ Ultimately, the panel appeared to accept the respondent's contention that the complainant in effect arranged to have a third party contact the respondent to purchase the domain name from the respondent. Under

³¹⁴ *Id.*

³¹⁵ *Societe Nationale de Television France3*, WIPO Case No. D2002-1181.

³¹⁶ *Id.*

³¹⁷ *Id.* The decision does not mention whether the complainant sought to contest the respondent's charge.

³¹⁸ *Id.* (citing *Grove Broad. Co. v. Telesystems Commc'ns Ltd.*, WIPO Case No. D2000-0703 (Nov. 10, 2000); *Creo Prods. Inc. v. Website In Dev.*, WIPO Case No. D2000-1490 (Jan. 19, 2001); *Furrytails Ltd. v. Andrew Mitchell*, WIPO Case No. D2001-0857 (Sept. 6, 2001)).

these circumstances, the panel observed, the complainant should not be permitted to bring a re-filed complaint.³¹⁹ The panel explicitly referred to the principle of “estoppel” (parenthetically, in English).³²⁰ The panel therefore denied the complaint.

The decision also noted that after the sole panelist’s previous resolution of the dispute, the complainant sought to retrieve the domain name by bringing an action against the respondent in a French court in Nantes³²¹ (where it prevailed), and also in the Seoul District Court³²² (where it did not). The panel noted that even if it were to accept the re-filed complaint and order a transfer of the domain name, the order would be unnecessary or impossible to implement, given the Korean court’s disposition of the dispute.³²³

Although there is no separate opinion, the text of the panel’s decision in Korean devotes a section entitled “opposing opinion” (반대의견 or *bahn-deh-eui-gyun*), which notes a dissenting view.³²⁴ This portion of the decision describes Panelist Nathalie Dreyfus’ statement that: the re-filed complaint should be allowed in light of the new evidence of the respondent’s contract to sell the domain name; the domain name should be transferred to the complainant because the requisite elements are satisfied; the

³¹⁹ *Id.*

³²⁰ *Id.*

³²¹ *Id.* (citing “Ordonnance de Refere Rendue Le 17 Mai 2001, Tribunal de Grande Instance de Nanterre (N°R.G.: 01/01497)”).

³²² *Id.* (citing Seoul D. Ct., *jah* 2001 *kah-hahb* 1625 (Sept. 26, 2001)).

³²³ *Id.* In this discussion, the panel referred to and paraphrased paragraph 17 of the UDRP Rules. *Id.* n.8.

³²⁴ *Id.*

domain name was used for a pornographic website; and there was bad faith in selling the domain name to a third party.³²⁵

The <france3.com> affair, which involved two UDRP proceedings, conflicting decisions from courts in two different countries, and international intrigue, is not a typical dispute over a domain name. The two panel decisions invite further discussion on several issues stemming from the UDRP process. First, there are many examples of disputes involving domain names that resort to sexually graphic and explicit websites. UDRP decisions have found that using a domain name for a site with pornographic content may not always be a right or legitimate interest in respect of the domain name,³²⁶ and also that such use is evidence of bad faith.³²⁷ Here, the domain name initially resolved to a site with pornographic pictures, which were removed and replaced with a message referring to a website relating to "sex solution." Even if, arguably, a service that provides "adult information" relating to "sex solution" is a bona fide offering of services under paragraph 4(c)(i), there is a question as to the distinction between such a service and pornographic material.

The burden is on the complainant to prove the presence of all three elements. Although this burden is eased somewhat relating to the respondent's right or interest in the

³²⁵ *Id.*

³²⁶ *E.g.*, V&V Supremo Foods, Inc. v. pxlchk1@gmail.com, WIPO Case No. D2006-1373 (Jan. 22, 2007).

³²⁷ *E.g.*, *id.*; Coral Trademarks, Ltd. v. Eastern Net, Inc., WIPO Case No. D2000-1295 (Dec. 26, 2000); America Online, Inc. v. Viper, WIPO Case No. D2000-1198 (Nov. 28, 2000).

domain name, proving the respondent's bad faith in many cases poses challenges. As noted above, the respondent's knowledge of the complainant's mark at the time of the domain name registration may be inferred, especially if the mark is well-known. The sole panelist in the <france3.com> proceeding was not convinced of the "FRANCE3" mark's fame in Korea and appeared to accept the respondent's argument that the domain name merely incorporated a generic or geographic term. The situation is problematic for holders of trademarks that do not have instant, worldwide recognition. The complainant is left to pose the question of the likelihood that an individual in Korea who desires to register a domain name for a pornographic site would choose "france3"³²⁸ (over "france1" or "france2," for example) or the "france-" prefix (over "japan-," "germany-," or "switzerland-"), without having the complainant and its mark in mind. Perhaps to make a stronger case for bad faith – and specifically to establish the respondent's knowledge of the complainant and its mark, as well as the respondent's intent in choosing the domain name – the complainant would have benefitted from the judicial process seen in U.S. civil litigation.³²⁹ In contrast, the UDRP is a streamlined procedure to address cybersquatting, with no discovery, in-

³²⁸ Is there some significance to the number "3" for such a site?

³²⁹ See, for example, *Quality Inns Int'l, Inc. v. McDonald's Corp.*, 695 F. Supp. 198, 204 (D. Md. 1988), where the court, citing to various portions of the record, rejected the defendant chief executive officer's testimony that his selection of "McSleep Inn" was not "an imitation of McDonald's or that McDonald's occurred to him at the time that he selected the name McSleep."

person hearings, or cross-examination, and the three requisite elements of paragraph 4(a) govern.

Many domain name disputes involve parties from different countries. The panelists appointed to decide the disputes also have nationality. They have two options in their decision making, which is of an all-or-nothing character: deny the complaint or order transfer of the domain name to the complainant. The instances where a panelist decides in favor of the party with the same nationality, whatever the facts of the case or the merit in the argument, will raise a human suspicion from the non-prevailing party of national favoritism. The arbitral rules seek to avoid this situation by appointing a sole arbitrator or the chair of a panel (in those cases with a tribunal of three panelists) from a third, neutral country.³³⁰ There are examples of this practice in WIPO's appointment of UDRP panelists as well,³³¹ but the expedited schedule of an administrative proceeding³³² poses challenges, in that qualifying panelists, especially those with the necessary language skills, may not be available.

With respect to the three-member panel decision in <france3.com>, in denying the complaint, the majority indicated that given the Korean court's decision against the

³³⁰ See *supra* text accompanying note 77.

³³¹ See *infra* text accompanying notes 376-77 & note 377.

³³² The UDRP Rules provide that for a proceeding with a sole panelist, the provider is to appoint a panelist within five days after receipt of the respondent's response, or the date that the response is due. UDRP Rules, *supra* note 15, ¶ 6(b). Although the time frame for appointing panelists for a proceeding with a three-member panel is more relaxed, it is nevertheless an expedited schedule. *Id.*

complainant in its request for a transfer of the domain name, it would be pointless for the panel to decide the dispute under the Policy. The fact, as well as the content, of the dissent was indicated by the majority of the panel. The description of the dissenting view provided above is a summary of an English translation of a portion of the decision in Korean, which presumably is a translation of what the French dissenting panelist relayed in English to the two Korean panelists comprising the majority. This is a reality of the international dispute resolution tribunal, and there is always the possibility of some loss of meaning in translation. The dissenting view, as reported by the majority, does not mention the matter of the complainant's purported involvement in the respondent's contract for the sale of the domain name nor the Seoul District Court's decision, two points on which the majority relied to reject the re-filed complaint. The lack of a separate opinion may also contribute to the view that the decision was unanimously reached.³³³

³³³ WIPO's notation of the case does not indicate a dissent. See *Search WIPO Cases and WIPO Panel Decisions*, *supra* note 26 (result for D2002-1181). An epilogue: The respondent in the <france3.com> proceedings is no longer the named registrant of the domain name, nor is the domain name used for a pornographic or adult site. Currently, Internet users who resort to <france3.com> are re-directed to <france3.fr>, which displays a website in French text devoted to television broadcasting. The <france3.com> domain name is registered to "France Televisions," based in Paris. See *Whois france3.com*, WHOIS, <http://www.whois.com/whois/france3.com>.

b. <SAMCLUB.COM>

The dispute over the domain name <samclub.com> was also the subject of two separate proceedings involving the same parties, the first decided by a sole panelist,³³⁴ and then after a re-filed complaint, by a three-member panel.³³⁵ There, Wal-Mart Stores, Inc., the U.S.-based retailer that had rights in the mark "SAM'S CLUB", challenged the Korean party's registration and use of the domain name <samclub.com>. The sole panelist denied the complaint.³³⁶ Eight months later, the complainant commenced another UDRP proceeding against the same respondent over the same domain name, and requested a three-member panel to decide the dispute. The panel unanimously agreed that the complaint presented a new dispute and that the tribunal had the authority to decide it. The panel denied the complaint by a majority vote.³³⁷ I was the dissenting panelist, and in an exercise of discretion, decline to offer an analysis of the pertinent issues in the decision. The <samclub.com> proceeding is included here for the sake of a complete database of the subject decisions. The reasons for my disagreement with the majority's decision are set out in full in the dissenting opinion.³³⁸ Interested readers are invited to review the decision by the sole panelist, the majority

³³⁴ Wal-Mart Stores, Inc. v. iContents, WIPO Case No. D2005-0492 (June 28, 2005) (sole panelist) [in Korean].

³³⁵ Wal-Mart Stores, Inc. v. iContents, WIPO Case No. D2006-0226 (June 20, 2006) (three-member panel) [in Korean].

³³⁶ *Wal-Mart Stores, Inc.*, WIPO Case No. D2005-0492.

³³⁷ *Wal-Mart Stores, Inc.*, WIPO Case No. D2006-0226.

³³⁸ *Id.* (Lee, Pan., dissenting).

decision, and the dissenting opinion (or their translations), and reach their own conclusions about the proceedings in the context of this study.³³⁹

i. DISSENT FROM TRANSFER

a. <STX.COM>

The complainant in *STX LLC v. Yu nae ho*,³⁴⁰ a leading manufacturer and distributor of sporting equipment and apparel, especially lacrosse and hockey equipment, used the mark “STX” for its products. STX products were sold in a number of countries, including Korea. On April 18, 2006, two weeks before the complaint was filed, STX LLC sent a cease and desist letter to the then registrant of the domain name <stx.com>, which resolved to a site that included links to the complainant’s competitors and “meta-tags such as ‘STX lacrosse’ and ‘STX field hockey[].’”³⁴¹ On April 19, the respondent, who had made a down payment of ₩9,000,000 (approximately US\$9,475, under the exchange rate at that time) five days prior, paid the rest of the sales price and took “assignment” of the domain name.³⁴² On April 20, by when <whois.com> records indicated the change in the registrant, the complainant sent an email to the respondent attaching

³³⁹ The domain name is still registered to the respondent; the domain name resolves to an active website.

³⁴⁰ WIPO Case No. D2006-0567 (Aug. 14, 2006).

³⁴¹ *Id.*

³⁴² *Id.* This is the resulting figure using the currency converter for April 13, 2006. YAHOO! FINANCE, <http://finance.yahoo.com/currency-converter> (last visited May 24, 2016).

the complainant's cease and desist letter to the previous registrant; the respondent did not respond. On May 4, the complainant commenced the UDRP proceeding. "Sometime later (the exact date is unknown)," the respondent replaced the content of the website previously described with an "under construction message."³⁴³

The panel unanimously decided that the domain name <stx.com> was confusingly similar to the "STX" mark in which the complainant had rights.³⁴⁴ The panel was also unanimous in deciding that the respondent did not have a right or legitimate interest in respect of the domain name.³⁴⁵ The panel's treatment of the bad faith element was more complex and divided. In summary, the majority of the panel – Presiding Panelist Lawrence K. Nodine and Panelist Sally M. Abel – determined that the respondent registered and used the domain name in bad faith "primarily because he did not discontinue his predecessor's bad faith" until after the complaint was filed.³⁴⁶

Elaborating, the majority stated that the active website was bad faith *use* in that the contents included advertisements for lacrosse and hockey products, links to the complainant's competitors, and meta-tags that targeted the complainant. This was evidence that the respondent

³⁴³ *STX LLC*, WIPO Case No. D2006-0567.

³⁴⁴ *Id.* Indeed, the respondent conceded the point.

³⁴⁵ *Id.* The panel stated that the respondent's purported intention to use the <stx.com> domain name "for a website for Social Training for eXtreme People" was not sufficient to satisfy the requirements of "demonstrable preparations to use . . . the domain name in connection with a bona fide offering of goods or services," under UDRP ¶ 4(c)(i). *Id.*

³⁴⁶ *Id.*

attempted to attract Internet users to the website by creating a likelihood of confusion with the complainant's mark, under paragraph 4(b)(iv).³⁴⁷ The majority of the panel also found bad faith *registration* of the domain name, for purposes of paragraph 4(a)(iii). Initially, the majority explained that bad faith acquisition substitutes for bad faith registration. Here, bad faith was present in that, absent contrary evidence, the respondent was presumed to have knowledge of the offending contents of the website at the time he acquired the domain name.³⁴⁸

The majority noted, in two separate footnotes, that the third panelist "does not join."³⁴⁹ The dissenting opinion reads in full: "I respectfully dissent. In my view, the Complainant has failed to sustain its burden of proving that the Respondent registered (or acquired) and has used the disputed domain name in bad faith. I would therefore deny the Complaint."³⁵⁰ We cannot know of the deliberations among the panel members in *STX LLC* regarding the bad faith element. The three panelists may well have vetted all aspects of the issue in full, with each panelist expounding her or his reasons; the majority may have re-cast its formulation of bad faith acquisition and bad faith use, in

³⁴⁷ *Id.*

³⁴⁸ *Id.*

³⁴⁹ "Panelist David Sorkin does not join in the finding of bad faith registration." *Id.* n.1. "Panelist David Sorkin does not join in this portion of the decision and would instead find that Complainant has not satisfied its burden to prove that Respondent Yu registered or acquired the disputed domain name in bad faith." *Id.* n.2. Of note, the majority's description refers only to registration or acquisition, not use.

³⁵⁰ *Id.* (Sorkin, Pan., dissenting).

light of the dissenter's concerns. This is known only to the panelists.

As alluded to above, the bad faith element under paragraph 4(a)(iii) of the Policy has been the subject of much discussion by panelists and commentators.³⁵¹ The *STX LLC* decision contributes further. Note in the majority's exposition, the references to the respondent's responsibility, inferences, presumptions, coded and imputed knowledge, and rules:

We . . . hold Respondent Yu *responsible* for the contents of the webpage as of the filing date of the UDRP Complaint. This *rule* is recognized where ownership does not change, *i.e.* a registrant may not escape bad faith *inferences* by deleting offending content from a webpage after an action is filed. . . .

The *rule* should be no different merely because the Respondent acquired ownership shortly before, in this case two weeks prior to, the filing of the UDRP action. The status of the webpage on the date the UDRP action is filed controls the proceedings. . . . If he were acting in good faith, Respondent Yu should have taken down the offending webpage promptly after receiving the April 20 cease and desist e-mail. . . .

. . . The *inferences* that may be drawn from the content of the webpage should not

³⁵¹ See *supra* text accompanying notes 150-78 & note 156.

change where the registrant only recently acquired ownership of the page.

. . . It is immaterial that the Respondent subsequently deleted offending content from the [webpage].

. . . .

. . . [T]he assignee of the disputed domain name in all likelihood *had knowledge* of the content of the webpage displayed on the acquired domain name at the time of acquisition. . . . Respondent Yu may fairly be *presumed*, therefore, to have had knowledge of, not only the hockey and lacrosse product emphasis and links that the appeared on the <stx.com> webpage, but also of the meta-tags that reveal use of the trademark STX (“stx lacrosse” and “stx field hockey”) in the meta-tags. We find that it is more likely than not that these meta-tags were *coded with knowledge* of the Complainant’s trademark rights with respect to lacrosse and hockey products for the express purpose of attracting internet users looking for the Complainant’s STX products. . .

. . . [A]ny other *rule* would enable an accused cyber-pirate to avoid the UDRP by quick transfers. If it is fair to *infer* that the creator of the meta-tags was aware of the Complainant’s rights, then we must be permitted to apply the same *inference* to the conduct of an assignee who fails to take down the offending site after he acquires control of it and continues to publish the webpage after receiving notice of the Complainant’s rights. A

majority of the Panel would *charge the Respondent with knowledge* of the meta-tags that appear on the web-page he continued to broadcast and further *charge him with awareness* that these meta-tags revealed trademark usage of STX.

. . . [T]he *rule* should be that one who acquires a webpage that has been used in bad faith assumes responsibility for the contents of that page if he continues to publish it after receiving notice of the Complainant's rights. . .³⁵²

It is not clear from what, if any, of the above the dissenter was dissenting. To be sure, the dissent of the thirty-eight words might have defenders, especially from those in arbitration circles.³⁵³ Nevertheless, the UDRP

³⁵² *STX LLC*, WIPO Case No. D2006-0567 (emphasis added).

³⁵³ Given the conflicting views on the utility of a dissent in arbitration cases, some commentators urge that a dissenting opinion, if it must be filed at all, should be "short, polite and restrained." REDFERN & HUNTER, *supra* note 250, at 392. In this regard, in my own travels, one well-known arbitrator, who indicated to me his opposition to dissenting opinions in arbitration matters, advised that if an arbitrator disagrees with the majority on the ultimate outcome of the award, "[h]e has two options. Refuse to sign the award, or just write, 'I respectfully dissent.'" Another commentator, however, has cautioned against a dissent that is too brief to be helpful. "A perfunctory dissent will serve neither the institution of arbitration nor any of the parties. A responsibly formulated dissent is also required to encourage the majority to proper reconsideration of its award in the light of the dissent." Hans Smit, *Dissenting Opinions in Arbitration*, 15 ICC INT'L CT. OF ARB. BULL. 37, 41 (2004).

process benefits more when panel decisions are seen as a form of international common law (where persuasive precedents emerge after panel percolation), rather than as international commercial arbitration (which arguably emphasizes a decision for the dispute only).³⁵⁴ In all events, the legal commentary is taking note of dissenting opinions, and notable dissenters, in UDRP decisions.³⁵⁵

b. <ISCRUB.COM>

The complainant in *Esquire Innovations, Inc. v. [] Vertical Axis, Inc.*, was a U.S. company engaged “in the process of document creation, formatting, re-purposing, comparing, and the supply of metadata management

³⁵⁴ Redfern and Hunter have noted that “the very purpose of an arbitration . . . is to arrive at a determinative decision. . . . It is that *decision* which matters; and it matters not as a guide to the opinions of a particular arbitrator, or as an indication of the future development of the law, but because it resolves the particular dispute that divides the parties, in the manner chosen by the parties, even if one of the arbitrators believes that decision to be wrong.” REDFERN & HUNTER, *supra* note 250, at 392. Nevertheless, the notion of (non-binding) precedent in arbitration is receiving more attention. See W. Mark C. Weidemaier, *Judging-Lite: How Arbitrators Use and Create Precedent*, 90 N.C. L. REV. 1091 (2012).

³⁵⁵ For example, Panelist M. Scott Donahey’s dissent in *Guru Denim Inc. v. Ibrahim Ali Ibrahim Abu-Harb*, WIPO Case No. D2013-1324 (Sept. 27, 2013), was critically reviewed by a *Harvard Law Review* piece. *Cyberlaw*, *supra* note 34, at 2132-33. “*Guru Denim* is not a novel dissent for Donahey: for the past half-decade, he has consistently advocated for a unitary understanding of bad faith in the face of widespread acceptance of the conjunctive view.” *Id.* at 2133 (citing *A. Nattermann v. Watson Pharm., Inc.*, WIPO Case No. D2010-0800 (Aug. 31, 2010) (Donahey, Pan., dissenting)).

software applications for the legal profession.”³⁵⁶ One of the complainant’s products, named Iscrub, was designed to remove metadata from documents.³⁵⁷ The complainant registered the “ISCRUB” mark with the U.S. Patent and Trademark Office on July 26, 2005, over three years *after* the respondent, Vertical Axis, Inc., had registered the domain name <iscrub.com>, on November 8, 2001. The respondent stated in its response that the complainant did not have enforceable trademark rights under the UDRP “because its mark does not predate the domain name and the alleged date of first use of the mark is four months after the domain name was registered.”³⁵⁸ The respondent also requested a finding of reverse domain name hijacking. Five days after the response was filed, the complainant submitted a supplemental filing that contained new evidence that the first commercial use of the complainant’s “ISCRUB” mark occurred before the registration of disputed domain name. About four weeks later, WIPO appointed the panel, which issued a procedural order stating that the panel would consider the complainant’s supplemental filing, and allowing the respondent to file a reply. The respondent did so.³⁵⁹

³⁵⁶ WIPO Case No. D2007-0856 (Oct. 5, 2007). For citation purposes, the identity shield service as a named respondent party is omitted.

³⁵⁷ “Metadata is electronic text that has been removed from documents and other electronic records, but which has been left behind in the process of amending documents so that, unless removed by Iscrub or another process, it may still be detected.” *Id.*

³⁵⁸ *Id.*

³⁵⁹ *Id.*

Presiding Panelist, the Honorable Neil Anthony Brown QC,³⁶⁰ and Panelists David E. Sorkin and David H. Tatham comprised the three-member panel. Before turning to the merits, the panel discussed the matter of supplemental filings. Under the UDRP Rules,³⁶¹ only the panel, in its discretion, may request further submissions, and parties may not do so without leave of the panel.³⁶² A majority of the panel decided in the exercise of its discretion to consider supplemental filings:

In this case, the Complainant's Supplemental Filing was timely filed, as it was lodged only 7 days after the Response and, as the Complainant says, it has not delayed the proceedings as it was filed simultaneously with its nomination of Panelists. Therefore, on the strength of this, and in the light of the above Decisions,[³⁶³] which give to a panel the

³⁶⁰ The presentation of the presiding panelist's title and name appears this way, and differs from that seen in *Witmer Pub. Safety Grp. Inc. v. Kwang pyo Kim*, WIPO Case No. D2011-0075 (Mar. 31, 2011). Panelist Brown's separate opinion therein is discussed *supra* text accompanying notes 302-05.

³⁶¹ "Further Statements[.] In addition to the complaint and the response, the Panel may request, in its sole discretion, further statements or documents from either of the Parties." UDRP Rules, *supra* note 15, ¶ 12.

³⁶² Within the 58 decisions, there are examples of the panel exercising its discretion and reaching different results. *Deutsche Lufthansa AG v. [Kwangpyo Kim]*, WIPO Case No. D2013-1844 (Jan. 22, 2014) (admitting supplemental filing); *Dig. Overture Inc. v. Chris Bradfield/GoPets Ltd.*, WIPO Case No. D2008-0091 (Apr. 23, 2008) (declining to admit supplemental filing).

³⁶³ The majority previously cited and quoted from a number of WIPO-administered decisions, including principally, *Deutsche Börse AG v.*

flexibility to admit new evidence that was not previously available, a majority of the Panel in this case is prepared to take the Complainant's Supplemental Filing into account.³⁶⁴

Ultimately, the majority concluded that the evidence submitted by the complainant in its supplemental filing was "pivotal" to the resolution of the case, and that the respondent availed itself of the opportunity to reply, "so no injustice can be done to the Respondent."³⁶⁵ "Indeed," the majority noted, "the Panel cannot but be assisted by now having before it all of the material that each side wishes to submit."³⁶⁶ Turning to the merits, the majority concluded that the three elements of paragraph 4(a) were satisfied. With respect to the bad faith element, the majority found that the respondent's activities were covered under three of the examples provided in paragraph 4(b): (i), (ii), and (iv).³⁶⁷

Panelist Sorkin dissented. He stated that while he "agree[d] with many of the majority's findings," the complainant did not meet its burden of proof on bad faith registration, even if the complainant's supplemental filing was considered.³⁶⁸ The panelist did not further elaborate on

Ramon Campos Munoz, WIPO Case No. D2005-0346 (May 23, 2005) (citing *Toronto-Dominion Bank v. Boris Kerpachev*, WIPO Case No. D2000-1571 (June 17, 2001)).

³⁶⁴ *Esquire Innovations, Inc.*, WIPO Case No. D2007-0856.

³⁶⁵ *Id.*

³⁶⁶ *Id.*

³⁶⁷ *Id.*

³⁶⁸ *Id.* (Sorkin, Pan., dissenting).

his views regarding the majority's disposition of the bad faith element. "More importantly," he wrote, "I believe that the Panel should not consider the parties' supplemental filings" ³⁶⁹ The dissent urged that the panel's discretion provided for in the UDRP Rules "ought not be exercised lightly. As the majority acknowledges, additional submissions should be considered only in exceptional circumstances" ³⁷⁰ To the dissent, the case did not present the requisite circumstances to warrant an exception to the general rule.

Panelist Sorkin also stated that "based upon the remaining information before the Panel, I would find that the Complaint was brought in bad faith and constitutes an abuse of this administrative proceeding." ³⁷¹ He further wrote:

The Complaint alleges that Respondent registered the disputed domain name in bad faith in 2001, intending to benefit from a trademark that did not even exist until Complainant adopted and began using it in 2002. In my view, the filing of such an obviously frivolous claim represents an abuse of the UDRP process and warrants a finding that the complaint was brought in bad faith, in an attempt at reverse domain name hijacking. . . . ^[372]

³⁶⁹ *Id.*

³⁷⁰ *Id.*

³⁷¹ *Id.*

³⁷² *Id.* (citing *Datalyst LLC v. Estes*, NAF Case No. FA954109 (May 9, 2007); *Protosoftware, Inc. v. Vertical Axis, Inc.*, WIPO Case No. D2006-

The fact that Complainant later discovered that it had been mistaken about the age of its claimed common-law trademark rights does not alter this conclusion. Had Complainant not elected to abuse the UDRP process by filing a complaint that it knew or should have known to be frivolous, it would later have been in a position to file a nonfrivolous complaint (and indeed, were we to dismiss the present matter, Complainant would remain free to initiate a second UDRP proceeding or pursue a trademark claim in court).³⁷³

The *Esquire Innovations, Inc.* proceeding offers a vivid example of how individual panelists may take profoundly different positions on precisely the same issue, which may in turn effect different outcomes for the parties. Both the majority and the dissent quoted paragraph 12 of the UDRP Rules to emphasize the panel's discretion in allowing additional party submissions. Discretion was in the eye of the beholder. In addition, both referred to the same examples of "exceptional circumstances" that allow for

0905 (Oct. 10, 2006); *Mess Enters. v. Scott Enters.*, WIPO Case No. D2004-0964 (Jan. 25, 2005); *carsales.com.au Ltd. v. Flanders*, WIPO Case No. D2004-0047 (Apr. 8, 2004); *NetDeposit, Inc. v. NetDeposit.com*, WIPO Case No. D2003-0365 (July 22, 2003)).

³⁷³ *Id.*

consideration of supplemental filings.³⁷⁴ Operating under the same standards, the majority and the dissent reached different results. Based on the respective determinations regarding the supplemental filings, the majority continued to reach a decision ordering the transfer of the domain name, while the dissent would have issued a finding of reverse domain name hijacking. Perhaps *Esquire Innovations, Inc.* might give pause to UDRP parties to consider requesting three-member panels toward a collective decision making process, given that much of the panelist's work is a matter of individual discretion.

As a prelude to the last two dissenting opinions, in the international arbitration setting, when the parties are nationals of two different countries, the three-member tribunal is sometimes comprised of: one arbitrator each from the country of the respective parties (often party-nominated arbitrators); and the chair or presiding arbitrator from a third, neutral country.³⁷⁵ Fifty-six of the 58 UDRP decisions

³⁷⁴ *Id.* (majority decision) (quoting *Deutsche Börse AG v. Ramon Campos Munoz*, WIPO Case No. D2005-0346 (May 23, 2005) ("As a rule, additional evidence or submissions should only be admitted in exceptional circumstances, such as when additional submissions are necessary to reply to the finding of newly discovered evidence not reasonably available to the submitting party at the time of its initial submission or to rebut arguments by the respondent that the complainant could not reasonably have anticipated.")); *id.* (Sorkin, Pan., dissenting) (paraphrasing quotation).

³⁷⁵ One commentator explains thus:

In a dispute between say an Indonesian party and an Australian party there may well be an apprehension of unfairness if the dispute is litigated before an Indonesian or Australian court. The fact that the adjudicator possesses the nationality of one of the parties may well

herein involve a dispute between a Korean and a non-Korean party.³⁷⁶ Nine of these fifty-six see a panel with a Korean panelist, a non-Korean panelist with the same nationality as the non-Korean party in the dispute, and the presiding panelist of a third country.³⁷⁷ Seven of these nine

be regarded as unfair or at least undesirable. It is here that arbitration has the distinct advantage. Usually an international arbitrator will not hold the nationality of either of the disputant parties. This is the common case if there is one arbitrator. In the case of a tribunal of three arbitrators, the chairman will be neutral though each of the party-appointed arbitrators may well bear the nationality of the appointing party.

Michael Pryles, *Assessing Dispute Resolution Procedures*, 7 AM. REV. INT'L ARB. 267, 280 (1996).

³⁷⁶ Of the said fifty-six decisions, all but three involve a non-Korean complainant against a Korean respondent. The three with the Korean complainant and a non-Korean respondent are: *Samsung Networks Co. v. SuperVirtualOffice Corp.*, WIPO Case No. DVE2010-0001 (May 10, 2010); *Samsung Elecs. Co. v. Pimser Elecs. Ltd.*, WIPO Case No. D2009-1630 (Feb. 16, 2010); and *Topfield Co. v. Jai Kemp & Dig. Prods. Grp. Pty Ltd.*, WIPO Case No. DAU2008-0002 (Apr. 21, 2008). Two other decisions involve a Korean complainant versus a respondent whose listed address is in the U.S., but according to the decisions, the respondent had significant ties to Korea. *Orion Corp. v. Jang, Dong*, WIPO Case No. D2012-2184 (Feb. 7, 2013) (stating that respondent "spent most of its life in the Republic of Korea"); *NHN Corp. v. NHN Corp.*, WIPO Case No. D2003-0939 (Feb. 27, 2004) (stating that president of respondent was "of Korean origin, [and] understand[s] the Korean language").

³⁷⁷ For these nine decisions, the nationality of the three panelists is indicated in the following list. Korea appears first if the complainant was a Korean party, and last if it was the respondent; the nationality of the presiding panelist is indicated in the middle. *JJGC Industria E Comercio de Materiais Dentarios S.A. v. Yun-Ki Kim*, WIPO Case No. D2013-1838

resulted in unanimous panel decisions;³⁷⁸ dissents were filed in the other two.

In both of the decisions with a dissenting opinion, the complainant was Amazon.com, the U.S. company that operates “an Internet website <amazon.com> that permits persons around the world to purchase books and other merchandise including motor vehicles on-line,”³⁷⁹ and is “one of the most famous trading names on the internet and

(Dec. 20, 2013) (Brazil-U.S.-Korea); UTV Ltd. v. Unitedeurope Consulting, Kwang Pyo Kim, WIPO Case No. D2011-2293 (Mar. 5, 2012) (Australia & Great Britain-Netherlands-Korea); United Airlines, Inc. v. United Airline Dot.Com, WIPO Case No. D2002-0835 (Nov. 9, 2002) (U.S.-India-Korea); Amazon.com, Inc. v. Amazonpic, WIPO Case No. D2002-0330 (July 22, 2002) (U.S.-Great Britain-Korea); VoiceStream Wireless Corp. v. Hanjin Ko, WIPO Case No. D2001-1411 (Australia-Great Britain-Korea); Amazon.com, Inc. v. Amazoninsu Co., WIPO Case No. D2001-1275 (Dec. 20, 2001) (U.S.-New Zealand-Korea); Amazon.com, Inc. v. Sung Hee Cho, WIPO Case No. D2001-1276 (Dec. 20, 2001) (U.S.-New Zealand-Korea); SEMATECH, Inc. v. Lee Hyunggyu, WIPO Case No. D2001-0870 (Nov. 26, 2001) (U.S.-Australia-Korea); SMS Demag AG v. Seung Gon, Kim, WIPO Case No. D2000-1434 (Jan. 19, 2001) (Germany-New Zealand-Korea).

In a tenth case, *Banco Itau S.A. v. Webmedia*, the complainant was a national of Brazil; the respondent, a national of Korea. The panelists were from Brazil, Korea, and Great Britain. The presiding panelist was Korean. WIPO Case No. D2008-0531 (July 18, 2008).

³⁷⁸ *JJGC Industria E Comercio de Materiais Dentarios S.A.*, WIPO Case No. D2013-1838 (complaint denied); *UTV Limited*, WIPO Case No. D2011-2293 (complaint denied); *United Airlines, Inc.*, WIPO Case No. D2002-0835 (transfer); *VoiceStream Wireless Corp.*, WIPO Case No. D2001-1411 (transfer); *Amazoninsu Co.*, WIPO Case No. D2001-1275 (transfer); *SEMATECH, Inc.*, WIPO Case No. D2001-0870 (transfer); *SMS Demag AG*, WIPO Case No. D2000-1434 (transfer).

³⁷⁹ *Sung Hee Cho*, WIPO Case No. D2001-1276.

has expanded its range of products to include . . . video tapes and DVDs.”³⁸⁰ The complainant had registrations of the “AMAZON.COM” mark in seventy countries, including Korea.³⁸¹

c. <AMAZONCAR.COM>; <AMAZONECAR.COM>

In *Amazon.com, Inc. v. Sung Hee Cho*,³⁸² we return to the decision that opened this article. Amazon.com objected to the Korean respondent’s registration of the domain names <amazoncar.com> (which was used for “a Korean language website that offers to rent or lease Hyundai & Kia automobiles”) and <amazonecar.com> (which did not resolve to a website).³⁸³ The respondent did not file a response. The panel – comprised of M. Scott Donahey (U.S.), the Honorable Sir Ian Barker QC (New Zealand) as the presiding panelist, and Boh Young Hwang (Korea) – unanimously determined that the domain names were confusingly similar to the complainant’s mark and that the respondent had no right or legitimate interest in the domain name.³⁸⁴ Regarding the bad faith element, “in the view of the majority of the Panel[,]

it strains belief that the Respondent did not know of the Complainant’s mark and

³⁸⁰ *Amazonpic*, WIPO Case No. D2002-0330.

³⁸¹ *Sung Hee Cho*, WIPO Case No. D2001-1276. Here, the panel also noted that “[s]tudies by Internet monitors have identified the <amazon.com> as one of the most frequently visited sites on the Internet.” *Id.*

³⁸² *Id.*

³⁸³ *Id.*

³⁸⁴ *Id.*

reputation at the time of registration. The inference that there has been a crude attempt by the Respondent to capitalize on the Complainant's reputation as a worldwide vendor on the Internet is inescapable. It is thus easy to infer that the Respondent in bad faith is attempting to divert to his website Internet users who may think the website has some connection with the Complainant.³⁸⁵

Panelist Hwang³⁸⁶ dissented. Although she agreed with the majority on the first two elements of paragraph 4(a), she stated that the complainant failed to prove that the domain names were registered and used in bad faith, and thus would have denied the complaint.³⁸⁷ The crux of the dissenting view appears to be that even though the complainant's trademark was "famous worldwide," especially for its business of Internet book sales, there was no evidence that the mark was well-known for car-related products or services.³⁸⁸ Panelist Hwang noted that the respondent's website for <amazoncar.com> was used only for a car-rental service and presented only "in the local language of the country which the Respondent is targeting

³⁸⁵ *Id.*

³⁸⁶ Until her untimely passing in 2009, Panelist Hwang was the most prolific Korean author of WIPO-administered UDRP decisions.

³⁸⁷ *Sung Hee Cho*, WIPO Case No. D2001-1276 (Hwang, Pan., dissenting).

³⁸⁸ *Id.* Panelist Hwang also noted the lack of evidence to show the complainant's trademark or service rights relating to such car products or car rental services, especially in Korea. *Id.*

for its business purposes.”³⁸⁹ In contrast to the majority’s conclusion on the respondent’s intent in selecting the domain name, the dissent expressed a fundamentally different view: “Except for the Complainant’s use of the word ‘amazoncar’, the reiteration of its domain name and its trade name, nowhere in the Complaint is any indication that the Respondent registered or is using the domain names and the word ‘amazon’ for the purpose of capitalizing on the Complainant’s reputation.”³⁹⁰

³⁸⁹ *Id.* She also observed that the complainant’s website for its car-dealing business was maintained under another domain name, <carsdirect.com>, “although it still represents <amazon.com> as its trademark.” *Id.*

³⁹⁰ *Id.* Of interest here is the decision in another proceeding in which Amazon.com was the complainant, but against a different named respondent. *Amazon.com, Inc. v. Amazoninsu Co.*, WIPO Case No. D2001-1275 (Dec. 20, 2001). The decision in *Amazoninsu Co.* was issued on the same date as that in *Sung Hee Cho*, and by the same panel that decided *Sung Hee Cho* – Panelist Donahey, Presiding Panelist Barker, and Panelist Hwang. *Id.*; *Sung Hee Cho*, WIPO Case No. D2001-1276. In *Amazoninsu Co.*, the respondent registered the domain name <amazon119.com>, and used it “for a Korean language website that offers automobile insurance.” *Amazoninsu Co.*, WIPO Case No. D2001-1275. There, the panel unanimously determined that the complainant successfully proved the requisite elements of paragraph 4(a) of the Policy, and ordered the transfer of the domain name. *Id.* The panel’s language in *Amazoninsu.com* (<amazon119.com>) describing the complainant and in disposing of each of the three elements is virtually identical to the corresponding text seen in *Sung Hee Cho* (<amazoncar.com>). *Amazoninsu.com*, WIPO Case No. D2001-1276; *Sung Hee Cho*, WIPO Case No. D2001-1276. In *Sung Hee Cho*, regarding the bad faith element, the majority stated:

it strains belief that the Respondent did not know of the Complainant’s mark and reputation at the time of

In urging that the complainant should be required to present “more concrete evidence of bad faith,” Hwang referred to the geographic and generic nature of the domain name: “The name ‘Amazon’ is the name of the famous river which runs through the South American Continent and it is within the general knowledge of the public”; and “[t]he term ‘car’ refers to a general commodity used in our everyday life which is the subject of trade in various transactions worldwide.”³⁹¹ This point was also made by the dissenter in the next decision.

d. <AMAZONPIC.COM>

In *Amazon.com, Inc. v. Amazonpic*,³⁹² the Korean respondent registered the domain name <amazonpic.com>, which resolved to a website used for the respondent’s business of selling DVDs. The panel was comprised of David Plant (U.S.), Presiding Panelist Tony Willoughby (Great Britain), and Dr. Jisuk Woo (Korea). Regarding the first

registration. The inference that there has been a crude attempt by the Respondent to capitalize on the Complainant’s reputation as a worldwide vendor on the Internet is inescapable. *It is thus easy to infer that the Respondent in bad faith is attempting to divert to his website Internet users who may think the website has some connection with the Complainant.*

Id. (emphasis added). In *Amazoninsu.com*, the italicized text in the passage above was omitted. *Amazoninsu.com*, WIPO Case No. D2001-1275. There was no dissent from Panelist Hwang in the <amazon119.com> decision. *Id.*

³⁹¹ *Sung Hee Cho*, WIPO Case No. D2001-1276 (Hwang, Pan., dissenting).

³⁹² WIPO Case No. D2002-0330 (July 22, 2002).

element of identical or confusing similarity, the panel, rather than resorting to a simple, objective comparison of the mark and the domain name,³⁹³ instead adopted the formula advanced by the complainant, namely, that “confusing similarity turns on use, similarity of the marks and terms in question, similarity of products and services, similarity of users and similarity of channels of distribution.”³⁹⁴ The majority concluded that all of these factors were present, but noted that confusing similarity would be in question and the complainant’s case would fail if few Korean Internet users had knowledge of the complainant.³⁹⁵ That was not the case here, per the majority, because “Amazon.com is so famous that there must be a risk that a not insubstantial number of internet users in Korea will believe as a result of the similarities between the Complainant’s trade mark and the Domain Name that the businesses associated with each are in some way related.”³⁹⁶

Regarding the respondent’s right or legitimate interest in the domain name, the majority stated that the complainant not only made its prima facie case, but also countered anticipated arguments that the respondent might raise to demonstrate a right or legitimate interest under paragraph 4(b) of the Policy. The burden shifting to the respondent, the majority noted that the respondent did “not seek to answer any of the Complainant’s allegations. Indeed, and most significantly of all, it does not deny the allegation

³⁹³ See *supra* text accompanying note 100.

³⁹⁴ *Amazonpic*, WIPO Case No. D2002-0330.

³⁹⁵ *Id.*

³⁹⁶ *Id.*

that when it registered the Domain Name it had the Complainant's name and trade mark in mind."³⁹⁷ Still under the heading of the respondent's right or interest in the domain name, the majority opined that when the respondent registered the domain name, it was "well aware of the fame of the Complaint."³⁹⁸ The majority concluded that it was "inconceivable that the Respondent did not register the Domain Name with the Complainant's name and trade mark in mind and in the hope and expectation that it would lead to a commercial benefit for the Respondent."³⁹⁹ Finally, the majority found that the "Domain Name was registered and . . . used in bad faith within the meaning of paragraphs 4(a)(iii) and 4(b)(iv) of the Policy," in that "the Respondent's intention was to mislead internet users and thereby derive a commercial benefit from being seen to be associated in some way with the Complainant."⁴⁰⁰

Dr. Woo dissented: "In my opinion, the Complainant has proved none of the three elements of the Policy paragraph 4(a)."⁴⁰¹ On the first element, she stated, "It is difficult for me to be convinced that the Domain Name <amazonpic.com> is confusingly similar to the Complainant's trademark AMAZON.COM. Although <amazonpic.com> and AMAZON.COM may look similar literally, 'amazon' is a generic name that not only means a river but also female warrior or tall, vigorous woman . . .

³⁹⁷ *Id.*

³⁹⁸ *Id.*

³⁹⁹ *Id.*

⁴⁰⁰ *Id.*

⁴⁰¹ *Id.* (Woo, Pan., dissenting).

.⁴⁰² The dissent also questioned whether there was sufficient evidence to support similarity of use, products and services, users, and channels of distribution. Moreover, Panelist Woo disagreed with the majority's view that "Amazon.com is so famous that there must be a risk of confusion."⁴⁰³

The dissenting opinion also stated that the respondent demonstrated its right and legitimate interest in the domain name under paragraph 4(c)(i) by registering the corporate name "amazonpicture", operating a multimedia shopping mall, and registering and using the domain name <amazonpic.com>, which, along with <amazonpic.co.kr>, was "quite naturally wanted and obtained by the Respondent, given its company name."⁴⁰⁴ But in doing so, the dissent did not address a matter included in the factual background portion of the decision, namely, that the respondent did not commence its business until *after* it registered the domain name.⁴⁰⁵ As noted above, the majority stated that it was "inconceivable" that the respondent did

⁴⁰² *Id.* (citation omitted).

⁴⁰³ *Id.*

⁴⁰⁴ *Id.*

⁴⁰⁵ *See id.* ("4. Factual Background"). Indeed, the respondent's response, the substance of which the decision quotes in full, includes the statement, "We . . . have been running a commercial shopping mall business *based* on a registered internet domain of <amazonpic.com> in Korea." *Id.* ("5. Parties' Contentions." "B. Respondent") (emphasis added). The response also stated that the respondent "legally registered a corporation name of amazonpicture and its trademark . . . and successfully received a trademark registration," but did not state when. *Id.*

not register the domain name with the complainant and its mark in mind.⁴⁰⁶

Panelist Woo characterized the majority's decision regarding the bad faith element as "the most problematic."⁴⁰⁷ Initially, she offered that there was no evidence of bad faith examples under paragraph 4(b)(i)-(iii). Urging that there was also no evidence that the respondent intentionally attempted to attract Internet visitors to the respondent's website by creating a likelihood of confusion with the complainant's mark, under paragraph 4(b)(iv), the dissent stated,

Most of the users of the respondent's web site seem to be Koreans and my guess is that they would not consider AMAZON.COM so much to be a seller of movies and other multimedia products as the Complainant argues. AMAZON.COM seems to be primarily considered a book-seller in Korea. To what extent AMAZON.COM is considered a seller of movies and other products, and whether Koreans would be confused by this Domain Name and think that it is affiliated to AMAZON.COM is a question that the Complainant must have shown, but failed.⁴⁰⁸

This portion of the dissent, which is reminiscent of Panelist Hwang's dissent in *Sung Hee Cho*, posits that even though the complainant's "AMAZON.COM" mark may be

⁴⁰⁶ *Id.*

⁴⁰⁷ *Id.* (Woo, Pan., dissenting).

⁴⁰⁸ *Id.*

well-known for online book sales, confusion can and should not be assumed when the mark or a similar rendition is used for movies or DVDs (<amazonpic.com>). Panelist Woo warned of the “quite serious and negative policy implications” of the majority decision, which “implies that no other entity could register any domain name that includes <amazon.com> because it is a trademark. This would result in granting too much right to the Complainant, preventing all the others from using otherwise available domain names, and protecting the status quo too strongly.”⁴⁰⁹

With the dissenting views in the above two Amazon.com decisions in mind, two hypotheticals are offered for consideration. Assume that an individual, a resident of the U.S., avers in a sworn affidavit that her first name is Samantha, and that she previously performed as a singer and band member at local events near her residence. She begins a new business relating to the manufacture, distribution, and sale of intimate apparel, and to this end, registers the domain name <samsunglingerie.com>. Or the individual is Samuel, also a former singer, who registers <samsungjockstraps.com>,⁴¹⁰ which resolves to a website for men’s sporting equipment. Assume also that a Korean company, claiming rights in a mark identical to the term preceding the generic name of the product that appears in both domain names, protests that Samuel and Samantha have engaged in cybersquatting, abusively registering and

⁴⁰⁹ *Id.*

⁴¹⁰ As of this writing, according to the <whois.com> database, the two hypothetical domain names are available.

using the domain names, in violation of the company's purported trademark rights. The Korean party files a UDRP complaint with WIPO.

The Policy and the UDRP Rules govern. The appointed panel, at its discretion, may refer to prior decisions (and separate opinions) for guidance. In order for the complainant to win transfer of each domain name from the respondent, it must demonstrate that:

- the domain name (<samsunglingerie.com> and <samsungjockstraps.com>) is identical or confusingly similar to a mark in which the complainant has rights (say, "SAMSUNG");
- the respondent has no rights or legitimate interests in respect of the domain name;⁴¹¹ and
- the domain name has been registered and is being used in bad faith.

Regarding the bad faith element, and the requisite component of the respondent's knowledge of the complainant at the time of the registration of the domain name, a panel may well declare that it "strains belief" or that it is "inconceivable" that the respondent did not know of the complainant and its trademark. But one wonders if the views expressed in the dissenting opinions in the Amazon.com cases, especially those relating to the scope of products for which the mark enjoys fame and reputation, should be applied. That is, if it is true that SAMSUNG is

⁴¹¹ Here, the panel would have to address the respondent's likely averment that "sam" refers to her or his first name, by which she or he has always been known, and "sung" is the past participle of a generic term that indicates a previous hobby of the respondent.

well-known worldwide for electronic products, but not for intimate apparel or men's athletic equipment, and if the respondent's website is limited to those respective products, should the panel determine that the respondent did not attempt to attract Internet users to its website by creating a likelihood of confusion?

IV. CONCLUSION

The Uniform Domain Name Dispute Resolution Policy provides for a method of resolving a dispute between a registrant of a domain name and a trademark holder who alleges cybersquatting. The method is an alternative to an action in the courts, which may not be desirable in disputes involving the Internet and parties from different countries. The UDRP process stands in contrast to traditional arbitration, but borrows much from the arbitration method, especially arbitration in the international context. The World Intellectual Property Organization, a major dispute resolution service provider of UDRP proceedings, administered the fifty-eight cases involving Korean parties that are the focus of this article. The proceedings led to administrative panel decisions by three-member panels. The panel decisions as a group shed light on the interpretation and application of key provisions of the Policy that govern in the resolution of disputes over domain names. Some of the 58 decisions include separate and dissenting views on issues relating to the language of the proceeding, reverse domain name hijacking, the appropriate timing of the complainant's trademark rights, panel discretion regarding procedural issues, and the multifaceted bad faith element under paragraph 4. These decisions (and the views therein) assist parties and panelists to understand the application of

the Policy. The 58 decisions may also contribute to a developing “UDRP jurisprudence.”

APPENDIX^A

^a The nationality of each complainant and respondent is based on its listed address on the panel's published decision. The nationality of the panelist is taken from his or her individual profile on WIPO's Internet site, *WIPO Domain Name Panelists*, WIPO, <http://www.wipo.int/amc/en/domains/panel/panelists.html>, or where it is not available, from a search link on WIPO's main website, <http://www.wipo.int>, or a search on the Internet. Some panelists are deceased. Where panelists declared multiple nationalities, they are indicated in the order listed, and by "/" separating the nationalities. Where the panelist's nationality differs from his or her listed address, the address is indicated second, following ";;". Two U.S.-based panelists of Korean national origin who declared American nationality are indicated as "USA, ROK." Three-letter abbreviations are used to indicate nationality, using a list by the International Olympic Committee (IOC). *Moving Forward: 2011 Annual Report*, IOC 94-95, http://www.olympic.org/Documents/Commissions_PDFfiles/Olympic_Solidarity/2011_report_Moving_Forward.pdf.

	Case No.	Complainant	Respondent ^b	Domain name(s)	Decision	Panelists ^c	Comments ^d
1	D2000-1007	Sony Kabushiki Kaisha (JPN)	Sin, Eonmok	mysony.com	Transfer	Barker, I. (NZL) Christie, A. (AUS) Wilson, R. (AUS)	
2	D2000-1074	Sony Kabushiki Kaisha (JPN)	sony.net	sony.net	Transfer	Willoughby, T. (GBR) Carabelli, A. (ITA) Lee, M. (KOR)	
3	D2000-1434	SMS Demag AG (GER)	Seung Gon, Kim	smsdemag.com sms-demag.com	Transfer Transfer	Barker, I. (NZL) Hoeren, T. (GER)	

^b If a privacy or identity shield service is included as a named respondent party, it is omitted. The respondent's nationality is indicated only if it is not Korea.

^c The presiding panelist is listed first. Titles of panelists (*e.g.*, "Honorable," "Q.C.," "Esq.") as indicated in the decisions are not included here. "Jong, S." and "Jung, S." are the same panelist. For this panelist, "Jong" appears as the surname in decisions in English; "Jung" appears as the surname on the panelist's individual profile on WIPO's Internet site. This Article's author is indicated by "Lee, I."

^d The language of the decision is indicated if it is not English. Any separate and dissenting opinions are noted.

						Lee, M. (KOR)	
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	Case No.	Complainant	Respondent	Domain name(s)	Decision	Panelists	Comments
4	D2001-0776	Strongarm Designs, Inc. (USA)	Arisu Tech	strongarm.com	Denied	Hunter, D. (AUS; USA) Lackert, C. (USA) Sorkin, D. (USA)	
5	D2001-0778	Playboy Enterprises International, Inc. (USA)	Sookwan Park	playboysportsbooks.com	Transfer	Jong, S. (KOR) Hwang, B. (KOR) Michaelson, P. (USA)	
6	D2001-0870	SEMATECH, Inc. (USA)	Lee Hyungyu	sematech.com	Transfer	Bennett, A. (AUS) Chang, M. (KOR) Methvin, G. (USA)	Separate decisions in Korean, English
7	D2001-1275	Amazon.com, Inc. (USA)	Amazoninsu Company	amazon119.com	Transfer	Barker, I. (NZL) Donahey, M. (USA) Hwang, B. (KOR)	
8	D2001-1276	Amazon.com, Inc. (USA)	Sung Hee Cho	amazoncar.com amazonecar.com	Transfer Transfer (2-1)	Barker, I. (NZL) Donahey, M. (USA) Hwang, B. (KOR)	Dissent by Hwang
9	D2001-1411	VoiceStream Wireless Corporation (USA)	Hanjin Ko	voicestream.org	Transfer	Perkins D. (UK) Hunter, D. (AUS; USA) Song, S. (KOR)	

10	D2002-0330	Amazon.com, Inc. (USA)	Amazonpic	amazonpic.com	Transfer (2-1)	Willoughby, T. (GBR) Plant, D. (USA) Woo, J. (KOR)	Dissent by Woo
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	Case No.	Complainant.	Respondent	Domain name(s)	Decision	Panelists	Comments
11	D2002-0368	Experian Information Solutions, Inc. (USA)	Jeonggon Seo	experian.net	Transfer	Lee, M. (KOR) Hunter, D. (AUS; USA) Woo, J. (KOR)	Decision in Korean
12	D2002-0513	Carfax, Inc. (USA)	COMn.COM	carfax.net	Transfer	Anand, P. (IND) Hwang, B. (KOR) Trotman, C. (GBR; NZL)	
13	D2002-0835	United Airlines, Inc. (USA)	United Airline Dot Com	unitedairline.com	Transfer	Anand, P. (IND) Hwang, B. (KOR) Samuels, J. (USA)	
14	D2002-1181	Societe Nationale de Television France3 (FRA)	Segwon Kim	france3.com	Denied	Jung, S. (KOR) Dreyfus, N. (FRA) Woo, J. (KOR)	Decision in Korean; dissenting opinion described in panel decision; no separate opinion
15	D2003-0079	Hitachi Maxell Kabushiki Kaisha (JPN)	Gyuhwa Chung	maxell.net	Transfer	Jung, S. (KOR) Hwang, B. (KOR) Lee, M. (KOR)	Decision in Korean

16	D2003-0101	Konica Corporation (JPN) & Minolta Kabushiki Kaisha (JPN)	Jin Hee Lee	konica-minolta.com konicaminolta.com	Transfer Transfer	Lee, M. (KOR) Limbury, A. (GBR/AUS) Park, H. (KOR; USA)	Decision in Korean
17	D2003-0192	Produits Berger (FRA)	Pil Technology Korea Ltd.	lampeberger-kr.com	Transfer	Chang, M. (KOR) Bensoussan, A. (FRA) Kim, Y. (KOR)	Decision in Korean
18	D2003-0400	Casio Keisanki Kabushiki Kaisha (Casio Computer Co., Ltd.) (JPN)	Jongchan Kim	casioshop.net	Transfer	Limbury, A. (GBR/AUS) Elliott, C. (NZL/GBR) Hwang, B. (KOR)	
19	D2003-0774	Amazon.com, Inc. (USA)	Kim Yoon-Jo	amazonfire.com	Transfer	Pinansky, T. (USA; KOR) Chang, M. (KOR) Donahey, M. (USA)	
20	D2003-0891	Societe Air France (FRA)	Daung Soo Ghim	airfrance-klm.com airfranceklm.com	Transfer Transfer	Park, H. (KOR; USA) Hwang, B. (KOR) Vivant, M. (FRA)	Decision in Korean
21	D2003-0939	NHN Corporation (KOR)	NHN Corp., National Health	nhn.com	Transfer	Willoughby, T. (GBR) Abel, S. (USA)	*President of Respondent is of Korean origin

			Network (USA)*			Jong, S. (KOR)	
22	D2004- 0154	The Hotel Ritz, Limited (FRA)	Kim Min-Kouk	weddingritz.com.	Transfer	Nitter, P. (NOR) Jong, S. (KOR) Thorne, C. (GBR)	

	Case No.	Complainant	Respondent	Domain names	Decision	Panelists	Comments
23	D200 4- 0764	NBC Universal, Inc. (USA) & Universal City Studios LLLP (USA)	Junak Kwon	nbcuniversal.com	Transfer	Hwang, B. (KOR) Barker, I. (NZL) Seo, I. (USA, KOR)	Decision in Korean; opinion of Barker in English
24	D200 4- 0984	Minka Lighting, Inc. d/b/a Minka Group (USA)	Lee Wongi	minkagroup.com	Transfer	Seo, I. (USA; KOR) Lee, I. (KOR/USA) Turner, J. (UK)	
25	D200 5- 0393	British Standard Institution (GBR)	BSI Inspectorate Korea Ltd.	bsi- inspectorate.com bsiinspectorate.co m inspectorate.biz inspectorate.net inspectorate.org	Transfer Transfer Denied Denied Denied	Hwang, B. (KOR) Seo, I. (US; KOR) Woo, J. (KOR)	Decision in Korean
26	D200 5- 0504	The News Corporation Limited (USA)	Yoon Jinsu	newscorporation. com	Transfer	Seo, I. (USA; KOR) Hwang, B. (KOR) Ricketson, S. (AUS)	Decision in Korean
27	D200 6- 0226	Wal-Mart Stores, Inc. (USA)	iContents	samclub.com	Denied (2-1)	Park, H. (KOR; USA)	Decision in Korean; dissent by Lee, in

						Jung, S. (KOR) Lee, I. (KOR/USA)	English
28	D200 6- 0250	Jet Marques (FRA)	Vertical Axis, Inc.	jettour.com	Denied	Smith, W. (AUS) Gautier, P. (FRA) Sorkin, D. (USA)	
29	D200 6- 0567	STX LLC (USA)	Yu nae ho & Jinsu Kim	stx.com	Transfer (2-1)	Nodine, L. (USA) Abel, S. (USA) Sorkin, D. (USA)	Dissent by Sorkin

	Case No.	Complainant	Respondent	Domain names	Decision	Panelists	Comments
30	D2006-0625	Shoulderdoc Limited (GBR) 564	Vertical Axis, Inc. U. MIAMI INT'L & COMP. L. REV.	shoulderdoc.com	Denied	Rothnie, W. (AUS) Harris, M. (GBR) Sorkin, D. (USA)	Unidentified panelist would have declined decision on ¶ 4(a)(i)
31	D2006-0905	Proto Software, Inc. (USA)	Vertical Axis, Inc./PROTO.COM	proto.com	Denied & RDNH	Payne, A. (AUS/NZL/IRL) Carmody, J. (USA) Sorkin, D. (USA)	
32	D2006-0930	Deutsche Telekom AG (GER)	Uniteurope Consulting KOR	t-biz.com t-box.com t-broadcast.com t-city.com t-health.com t-home.com t-jobs.com t-network.com t-portal.com t-sales.com t-show.com	Transfer Transfer Denied Transfer Denied Transfer Transfer Transfer Denied Denied Denied	Seo, I. (USA; KOR) Hwang, B. (KOR) Jong, S. (KOR)	
33	D2006-1089	Educational Testing Service (USA)	Hackers Language Institute / David Cho, Ph.D.	hackerstoefl.com hackerstoeic.com	Denied Denied	Wefers Bettink, W. (NED) Jong, S. (KOR) Li, Y. (CHN)	

34	D2006-1240	Groupe Canal+ Company (FRA)	Jinsoo Yoon	canalplus.com	Transfer	Lee, I. (KOR/USA) Bertrand, A. (FRA) Hwang, B. (KOR)	

	Case No.	Complainant	Respondent	Domain names	Decision	Panelists	Comments
35	D2006-1446	Chivas Brothers Limited, et al. (non-KOR)	Anyweb Co., Ltd.	chivas.net	Transfer	Pinansky, T. (USA; KOR) Gold, A. (GBR) Lee, I. (KOR/USA)	
36	D2007-0017	HSM Argentina S.A. (ARG)	Vertical Axis, Inc.	hsm.com	Denied	Barker, J. (AUS/GBR) Larus, C. (USA) Sorkin, D. (USA)	
37	D2007-0417	Nursefinders, Inc. (USA)	Vertical Axis, Inc.	nursefinder.com	Denied	Blackmer, W. (USA) Hines, P. (USA) Sorkin, D. (USA)	
38	D2007-0535	IFIL S.p.A (ITA)	Han Jin Go	ifil.com	Transfer	Pinansky, T. (USA; KOR) Barbero, L. (ITA) Cho, J. (KOR)	
39	D2007-0795	Bright Horizons Family Solutions Inc. et al. (USA (2), IRL, CAN)	Vertical Axis, Inc.	brighthorizon.com	Denied	Turner, J. (GBR) Johnson, C. (USA) Sorkin, D. (USA)	
40	D2007-0856	Esquire Innovations, Inc. (USA)	Vertical Axis, Inc.	isclub.com	Transfer (2-1)	Brown, N. (AUS/GBR) Sorkin, D. (USA)	Dissent by Sorkin

						Tatham, D. (GBR)	
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	Case No.	Complainant	Respondent	Domain names	Decision	Panelists	Comments
41	D2007-1120	Hertz System, Inc. (USA)	Jeff Park	herts.com	Transfer	Barker, J. (AUS/GBR) Blackmer, W. (USA) Sorkin, D. (USA)	
42	D2007-1513	IPGM Institution Mixte de Prévoyance du Groupe Mornay (FRA)	Sooyong Kim	mornay.com	Denied	Kim, G. (USA, KOR) Jong, S. (KOR) Le Stanc, C. (FRA)	
43	D2008-0091	Digital Overture Inc. (USA)	Chris Bradfield* (USA) & GoPets Ltd.	gopets.net	Denied & RDNH (2-1 on RDNH)	Barker, J. (AUS/GBR) Bernstein, D. (USA) Davis, G. (USA)	Respondent Bradfield is executive of GoPets Ltd. On RDNH finding, dissenter not identified
44	D2008-0531	Banco Itau S.A. (BRA)	Webmedia	itau.net	Transfer	Hwang, B. (KOR) Loureiro Oliveira, A. (BRA) Willoughby, T. (GBR)	
45	D2008-1390	Hisamitsu Pharmaceutical Co., Inc. (JPN)	Chang Il Min	hisamitsu.com	Transfer	Lee, I. (KOR/USA) Nahm, H. (KOR) Sato, K. (JPN)	
46	D2008-1407	Tokyu Corporation	Jeongyong Cho	capitoltokyu.com	Transfer	Choi, C. (KOR) Cho, J. (KOR)	

		(JPN)				Dogauchi, M. (JPN)	
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	Case No.	Complainant.	Respondent	Domain names	Decision	Panelists	Comments
47	DAU2008-0002	Topfield Co. Ltd. (KOR)	Jai Kemp (AUS) & Digital Products Group Pty Ltd. (AUS)	i-topfield.com.au i-topfield.net.au topfield-australia.com.au topfield.com.au topfield.net.au	Denied Transfer Denied Transfer Transfer	Limbury, A. (GBR/AUS) Argy, P. (AUS) Rothnie, W. (AUS)	
48	D2009-0239	Reckitt Benckiser Plc (GBR)	Eunsook Wi	rb.net	Denied	Joppich, B. (GER) Abbott, F. (USA) Bridgeman, J. (IRL)	
49	D2009-1630	Samsung Electronics Co., Ltd. (KOR)	Pimser Electronics Ltd. (Samsung Turkey) (TUR)	samsungturkey.com	Transfer	Samaras, H. (USA) Lee, D. (KOR) Tatham, D. (USA)	
50	DVE2010-0001	Samsung Networks Co., Ltd. (KOR)	SuperVirtualOffice Corp. (USA)	samsung.com.ve	Transfer	O'Farrell, M. (ARG) Erdozain, J. (ESP) Steinhardt, J. (GBR/USA)	Decision in Spanish
51	D2011-0075	Witmer Public Safety Group,	Kwang pyo Kim	firestore.com	Denied	Kennedy, G. (IRL; HKG) Hudis, J. (USA)	Concurring by Hudis; concurring in part, dissenting

		Inc. (USA)				Brown, N. (AUS/GBR)	in part by Brown
52	D2011-1005	The Knowland Group (USA)	Trademark Managements	knowland.com	Transfer	Park, A. (USA, KOR) Chang, M. (KOR) Lee, I. (KOR/USA)	

	Case No.	Complainant.	Respondent	Domain names	Decision	Panelists	Comments
53	D2011-1407	Heimbs Kaffee GmbH & Co. KG (GER)	Ho Kyoung Trading Co, Ltd., Heui-il Kang	allegretto.com	Denied	Rindforth, P. (SWE) Lodigiani, A. (ITA) Park, H. (KOR; USA)	
54	D2011-2293	UTV Limited (GBR)	Unitedeurope Consulting, Kwang Pyo Kim	utv.com	Denied	Meijboom, A. (NED) Brown, N. (AUS/GBR) Park, A. (USA, ROK)	
55	D2012-2184	Orion Corporation (KOR)	Jang, Dong (USA)*	chocopie.com	Transfer	Barbero, L. (ITA) Chang, M. (KOR) Dabney, J. (USA)	*Respondent has business experience in Korea.
56	D2013-1838	JJGC Industria E Comercio de Materiais Dentarios S.A. (BRA)	Yun-Ki Kim	neodent.com	Denied & RDNH	Lyon, R. (USA) Chang, M. (KOR) Pereira Dos Santos, M. (BRA)	

57	D2013-1844	Deutsche Lufthansa AG (GER)	Kwangpyo Kim	flynet.com	Transfer	Alexiev, A. (BUL) Hoeren, T. (GER) Brown, N. (AUS/GBR)	
58	D2014-0089	Mobile's Republic (FRA)	Kwangpyo Kim	newsrepubli c.com	Denied	Khasawneh, N. (GBR/JOR) Alexiev, A. (BUL) Brown, N. (AUS/GBR)	